

No. 15433

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United States  
Court of Appeals  
for the Ninth Circuit

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CONTAINER CORPORATION OF AMERICA,  
a corporation, Appellant,

vs.

M. C. S. CORPORATION, Appellee.

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Transcript of Record

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Appeal from the United States District Court for the  
Southern District of California,  
Central Division

FILED

APR 10 1957

PAUL P. O'BRIEN, CLERK



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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in *italic*; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in *italic* the two words between which the omission seems to occur.]

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## NAMES AND ADDRESSES OF ATTORNEYS

For Appellant:

J. CALVIN BROWN,

704 So. Spring St.,  
Los Angeles 14, California,

BROWN, JACKSON, BOETTCHER AND  
DIENNER,

53 W. Jackson Blvd.,  
Chicago 4, Illinois. [1]\*

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In The United States District Court, Southern  
District of California, Central Division

Civil Action No. 16413-T

CONTAINER CORPORATION OF AMERICA,  
Plaintiff,

v.

M. C. S. CORPORATION, Defendant.

COMPLAINT FOR INFRINGEMENT OF  
LETTERS PATENT NO. 2,638,261

Equitable Relief Sought

1. Container Corporation of America, a corporation organized and existing under and by virtue of the laws of the State of Delaware, having its corporate office at Wilmington, Delaware, and its general office at Chicago, Illinois, brings this, its Complaint, against the M.C.S. Corporation, a corporation organized and existing under and by virtue of the laws of the State of California, having its principal place of business at Los Angeles, California.

The jurisdiction of this Court is based upon the following:

(a) This is an action arising under the patent laws of the United States, in which [2] plaintiff seeks an injunction and an accounting.

(b) Defendant, M.C.S. Corporation, is an inhabitant of the Southern District of California, Central Division, has a regular and established place of

business within the Southern District of California, Central Division, and has committed acts of patent infringement, hereinafter complained of, within the Southern District of California, Central Division.

2. On May 12, 1953, United States Letters Patent No. 2,638,261 were duly and legally issued to plaintiff, Container Corporation of America, for an invention in Frozen Food Carton With Plastic Lid; and, since that date, plaintiff, Container Corporation of America, has been, and still is, the owner of said Letters Patent No. 2,638,261.

3. Defendant, M. C. S. Corporation, has been, and still is, infringing the aforesaid letters patent, by making, using, and/or selling plastic lids for frozen food cartons embodying the invention patented in and by said letters patent, and will continue to do so unless enjoined by this Court.

Wherefore, plaintiff demands an injunction against further such infringement by defendant and those controlled by defendant, an accounting for damages, and an assessment of costs against defendant.

CONTAINER CORPORATION OF  
AMERICA,

/s/ By J. CALVIN BROWN,  
Attorney for Plaintiff.

/s/ ARTHUR H. BOETTCHER,  
Of Counsel.

[Endorsed]: Filed Feb. 25, 1954. [3]

[Title of District Court and Cause.]

## ANSWER AND COUNTERCLAIM

Defendant, M.C.S. Corporation, for its answer to the complaint alleges, avers, and denies as follows:

### I.

Answering Paragraph 1 of the complaint, the defendant

(a) Admits that it is a California corporation having its principal place of business at Los Angeles, California;

(b) Admits that it is an inhabitant of the Southern District of California, Central Division, and has a regular and established place of business within the Southern District of California, Central Division; [4]

(c) Admits that the jurisdiction of this Court is based upon and arises under the Patent Laws of the United States;

(d) Denies that it has committed acts of patent infringement complained of in the complaint, within the Southern District of California, Central Division, or at any other place;

(e) Alleges that it is without knowledge or information sufficient to form a belief as to the truth of each and every remaining allegation of said Paragraph 1.

### II.

Answering Paragraph 2 of the complaint, the defendant admits that United States Letters Patent No. 2,638,261 was issued on May 12, 1953, to Con-

tainer Corporation of America; denies that said Letters Patent was duly or legally issued; denies that said Letters Patent was issued for an invention in Frozen Food Carton With Plastic Lid, or for any other invention; and alleges that it is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of said Paragraph 2.

### III.

Answering Paragraph 3 of the complaint, the defendant denies that it has, or at any time past has, been, and denies that it is now, infringing said Letters Patent by making, using, and/or selling plastic lids for frozen food cartons alleged to embody the invention alleged to be patented, or that it is otherwise infringing said Letters Patent, and denies that it will, unless enjoined by this Court, infringe said Letters Patent. [5]

Further Answering Plaintiff's Complaint With Respect to the Claim or Cause of Action For Patent Infringement Alleged In Paragraphs 1 through 3 Thereof, and For Separate, Alternate, and Further Defenses Thereto, The Defendant Avers As Follows:

### IV.

The defendant has not infringed Letters Patent No. 2,638,261 or any claim or claims thereof.

### V.

The alleged inventions or discoveries claimed in Letters Patent No. 2,638,261 were not patentable to the alleged inventor named therein, under the

provisions of Section 4886 of the Revised Statutes of the United States [35 U.S.C. (1952), Sections 101 and 102], and therefore said patent is, and each and every claim thereof is, invalid and void.

#### VI.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid and void, because the alleged inventions or discoveries described thereby were patented or described in certain printed publications and Letters Patent in this and foreign countries before the alleged invention or discovery thereof by the applicant for said Letters Patent, the Letters Patent, the numbers thereof, the names of the patentees thereof, and the dates of said Letters Patent or publications which are at this time unknown to the defendant, who prays leave to plead the same by amendment to this answer when they are ascertained.

#### VII.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because prior to any supposed [6] invention or discovery by the applicant for said Letters Patent, that which is alleged to be patented by said Letters Patent, and particularly that which is described and claimed therein, and all material and substantial parts thereof, had been known to, and used by, others in this country.

#### VIII.

All the claims of Letters Patent No. 2,638,261, and each of them is, invalid, because the applicant

for said Letters Patent was not the original or first inventor of any material or substantial part of that which is purported to be patented in said Letters Patent, and the same thing or things in all material and substantial respects had, prior to the alleged inventions or discoveries thereof by the applicant for said Letters Patent, been invented or discovered (if there be any patentable invention or discovery defined by any of said claims) by others.

## IX.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because the alleged invention and discoveries purportedly defined by the claims of said Letters Patent were in public use or on sale in this country for more than one (1) year prior to the application date of said Letters Patent.

## X.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because the alleged Letters Patent fails to comply with Section 4888 of the Revised Statutes of the United States [35 U.S.C. (1952), Sections 111 and 112], and in particular in failing to particularly point out and distinctly claim the parts, improvements or combinations alleged to constitute the invention or discovery of said Letters Patent. [7]

## XI.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because in view of the state of the art as it existed at the time of, and



long prior to, the date of the alleged invention or discovery claimed in said Letters Patent, said Letters Patent does not claim any invention or discovery, and does not involve any invention or discovery or contain any patentable novelty, but consists of the mere adoption of well-known devices for the required uses involving ordinary faculties of reasoning and the skill expected of one in the art to which said Letters Patent pertains, said state of the art including the prior patents and publications referred to in Paragraph VI herein and others for which this defendant is diligently searching, leave and permission of this Honorable Court being requested to set them forth herein by amendment when they are ascertained.

## XII.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because said Letters Patent was not granted or issued by the Commissioner of Patents regularly or within the authority granted him under due form of law or after due proceedings were had with respect to the application filed by or on behalf of the applicant therefor, and because the Commissioner of Patents did not cause a proper examination to be made as to the alleged invention or discovery purportedly defined by said Letters Patent, and had such an examination been made properly it would have appeared that the applicant for said Letters Patent was not entitled thereto, and that said Letters Patent would not have been issued, and that said Letters Patent was irregularly granted without proper or due con-

sideration of the application for the same and without fulfillment of the necessary requirements of the Patent Office Examiner in searching the Patent Office records [8] available to him prerequisite to granting of said Letters Patent.

### XIII.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because each of the claims defines merely an old combination of elements which operate in substantially the same way to produce substantially the same result as they did individually in the prior art.

### XIV.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because each of said claims includes more than that which was disclosed in said Letters Patent, and more than that which is purported to have been invented, and because in each of said claims the language thereof is too broad at the precise alleged point of novelty (if there be any novelty).

### XV.

All the claims of Letters Patent No. 2,638,261 are, and each of them is, invalid, because the alleged invention or discovery purportedly defined by said claims, and each of them, are not in fact inventions or discoveries but are the same aggregation of old and unpatentable elements not amounting to patentable combination.

### XVI.

In view of the state of the art at and before the

alleged invention or discovery of Letters Patent No. 2,638,261, or attempted to be defined in any claim of said Letters Patent, said claims, or any of them, cannot now be given an interpretation, meaning or scope to cover, include or bring within the purview thereof, any device made by the defendant.

### XVII.

While the application for Letters Patent No. 2,638,261 was pending in the Patent Office, the applicant therefor so limited and confined the disclosure and claims of said application under the requirement of the Commissioner of Patents, or otherwise, that the plaintiff cannot now seek or obtain a construction of any of the claims of said Letters Patent sufficiently broad to cover or embrace any devices made by the defendant.

For A Counterclaim Against The Plaintiff, Container Corporation of America, The Defendant Avers As Follows:

#### A.

Defendant-counterclaimant, M.C.S. Corporation, is a corporation organized and existing under the laws of the State of California and having its principal place of business in Los Angeles, California.

#### B.

Plaintiff-counterdefendant, Container Corporation of America, admits by Paragraph 1 of its complaint herein that it is a corporation organized and existing under and by virtue of the laws of the State of Delaware, having its corporate office at Wilmington, Delaware, and its general office at

Chicago, Illinois. This counterclaim arises under Section 2201 of Title 28 of the United States Code because there is an actual controversy now existing between the counterclaimant and the counterdefendant in respect of which the counterclaimant needs a declaration of its rights by this Court, which controversy arises over the question of validity and infringement of United States Letters Patent No. 2,638,261, and each and every of the claims thereof, alleged [10] to be owned by the plaintiff-counterdefendant, Container Corporation of America, in that plaintiff-counterdefendant has charged defendant-counterclaimant with infringement of said Letters Patent.

### C.

The alleged invention or discovery of United States Letters Patent No. 2,638,261 is, and each and every claim thereof is, invalid and void, irrespective of any alleged infringement thereof by defendant-counterclaimant, and defendant-counterclaimant needs a declaratory judgment of invalidity and unenforceability of said Letters Patent, and each and every of the claims thereof, on the grounds set forth herein as a means of relief to it and the public at large.

### D.

Defendant-counterclaimant adopts, repeats and realleges as Paragraphs D to Q, inclusive, of this counterclaim, each and every one of the allegations contained in Paragraphs IV to XVII, inclusive, of the foregoing answer with like effect as if fully repeated herein.

Wherefore, the defendant and counterclaimant prays as follows:

(1) That the complaint be dismissed with prejudice;

(2) That United States Letters Patent No. 2,638,261, and each and every of the claims thereof, be declared not infringed by any act of the defendant and counterclaimant;

(3) That United States Letters Patent No. 2,638,261, and each and every claim thereof, be declared and adjudged invalid, void and unenforceable;

(4) That the defendant and counterclaimant recover from the plaintiff and counterdefendant its costs and disbursements herein and reasonable attorneys' fees; and

(5) That the defendant and counterclaimant be granted such other and further relief as may be proper.

Dated: At Los Angeles, California, this 8th day of April, 1954.

HARRIS, KIECH, FOSTER &  
HARRIS,  
DONALD C. RUSSELL,  
WARREN L. KERN,

/s/ By DONALD C. RUSSELL,  
Attorneys for M.C.S. Corporation.

Acknowledgment of Service Attached. [13]

[Endorsed]: Filed April 8, 1954.

[Title of District Court and Cause.]

## REPLY TO COUNTERCLAIM

Now comes the plaintiff, Container Corporation of America, and, for its reply to defendant's Counterclaim, states:

A.

Plaintiff admits the allegations of Paragraph A of said Counterclaim.

B.

As to Paragraph B of said Counterclaim, plaintiff admits that it is a corporation organized and existing under and by virtue of the laws of the State of Delaware, having its corporate office at Wilmington, Delaware, and its general office at Chicago, Illinois; but it denies any need for the said [14] counterclaim because the issues presented by it are already joined by the Complaint and Answer.

C.

Plaintiff denies each and every allegation contained in Paragraph C of said Counterclaim.

D.

Plaintiff denies each and every allegation contained in Paragraph D of said Counterclaim, denying each and every allegation contained in Paragraphs IV to XVII, inclusive, of defendant's Answer, incorporated by said Paragraph D as Paragraphs D to Q, inclusive, of said Counterclaim.

Wherefore, plaintiff denies that there is any ground for any judgment, decree, declaration or

order as prayed by defendant, and prays that said Counterclaim be dismissed with costs to plaintiff.

CONTAINER CORPORATION OF  
AMERICA,

/s/ By J. CALVIN BROWN,  
Attorney for Plaintiff.

/s/ HENRY H. BABCOCK,  
/s/ ARTHUR H. BOETTCHER,  
Of Counsel. [15]

Acknowledgment of Service Attached. [16]

[Endorsed]: Filed April 24, 1954.

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[Title of District Court and Cause.]

NOTICE PURSUANT TO TITLE 35, U.S.C. § 282

To: Container Corporation of America, Plaintiff,  
and to Brown, Jackson, Boettcher & Dienner  
and J. Calvin Brown, Its Counsel:

Please Take Notice that the defendant, M.C.S. Corporation, will rely upon one or more of the following identified patents, publications, persons in support of the defenses pleaded and the allegations stated in the Answer and Counterclaim of M.C.S. Corporation. [127]

Patent No.	Date Issued	Patentee	Country
1,969,486	Aug. 7, 1934	Kurz	United States
2,399,241	Apr. 30, 1946	Merkle	United States
2,381,508	Aug. 7, 1945	Moore	United States
2,155,022	Apr. 18, 1939	Rutkowski	United States
1,325,930	Dec. 23, 1919	Drake	United States

Patent No.	Date Issued	Patentee	Country
2,392,959	Jan. 15, 1946	Van Saun	United States
2,623,685	Dec. 30, 1952	Hill	United States

Persons

William J. Poole, of Container Corporation of America.

Dated: At Los Angeles, California, this 10th day of October, 1955.

HARRIS, KIECH, FOSTER &  
HARRIS,

DONALD C. RUSSELL,

WARREN L. KERN,

/s/ By DONALD C. RUSSELL,

Attorneys for M.C.S. Corporation.

Affidavit of Service by Mail Attached. [129]

[Endorsed]: Filed Oct. 11, 1955.

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[Title of District Court and Cause.]

PLAINTIFF'S EXHIBIT No. 7

PLAINTIFF'S REQUESTS FOR ADMISSIONS  
OF FACT

Now comes plaintiff, Container Corporation of America, by its undersigned attorney, and, in accordance with the provisions of Rule 36 of the Federal Rules of Civil Procedure, requests that defendant, M S C Corporation, admit the following facts on or before April 9th, 1956.

No. 1

Since the issuance of the patent in suit, United



States Letters Patent No. 2,638,261, and prior to the filing of the Complaint herein, defendant manufactured or caused to be manufactured, and sold or caused to be sold, within and from the Southern District of California, lids for cartons for frozen foods, of which the following are specimens: Lid marked for identification "Plaintiff's [132] Exhibit Specimen of Accused Lid, Large Size", and lid, marked for identification "Plaintiff's Exhibit Specimen of Accused Lid, Small Size", which specimens are delivered to defendant's attorney herewith and are to be returned to plaintiff's attorney at the time of defendant's response to these Requests for Admissions, for custody until time of trial, available to defendant's attorney.

No. 2

That, since the issuance of the patent in suit, United States Letters Patent No. 2,638,261, and prior to the filing of the Complaint herein, defendant caused to be printed and issued, within and from the Southern District of California, literature of which the following are specimens: Sheets marked for identification "Plaintiff's Exhibit Specimen of Defendant's Literature #1" and "Plaintiff's Exhibit Specimen of Defendant's Literature #2", respectively, which specimens are delivered to defendant's attorney herewith and are to be returned to plaintiff's attorney at the time of defendant's response to these Requests for Admissions, for custody until time of trial, available to defendant's attorney.

## No. 3

That, since the issuance of the patent in suit, United States Letters Patent No. 2,638,261, and prior to the filing of the Complaint herein, defendant placed an advertisement in the periodical entitled "Locker Management" which appeared in the January, 1953, issue of said periodical, copy of which advertisement, marked for identification "Plaintiff's Exhibit Defendant's Advertisement", is delivered to defendant's attorney herewith and is to be returned to plaintiff's attorney at the time of defendant's response to these Requests for Admissions, for [133] custody until time of trial, available to defendant's attorney.

## No. 4

That "Ree-Seal" and "Ree Seal Company" are adopted names under which M C S Corporation, defendant herein, has been doing business with which this case is concerned.

## No. 5

That, on or about November 5, 1953, defendant received a letter of which the letter marked for identification "Plaintiff's Exhibit, Copy of Letter of Notification" is a copy, said copy being delivered to defendant's attorney herewith, to be returned to plaintiff's attorney at the time of defendant's response to these Requests for Admissions, for custody until time of trial, available to defendant's attorney.

Dated: Los Angeles, California, March 28, 1956.

/s/ J. CALVIN BROWN,  
Attorney for Plaintiff.

/s/ ARTHUR H. BOETTCHER,  
Of Counsel. [134]

Acknowledgment of Service Attached. [136]

[Endorsed]: Filed March 28, 1956.

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[Title of District Court and Cause.]

PLAINTIFF'S EXHIBIT No. 14

INTERROGATORIES BY PLAINTIFF

Now comes plaintiff, Container Corporation of America, by its undersigned attorney, and, in accordance with the provisions of Rule 33 of the Federal Rules of Civil Procedure, files the following interrogatories :

1.

Give the names and residence addresses of all officers, directors and managing agents of the defendant.

2.

Was one Donald Frederick ever an officer, director or managing agent of the defendant? [137]

3.

If the answer to preceding Interrogatory 2 is in the affirmative, state in what capacity he was connected with the defendant and the period of time

during which he acted in such capacity, and give his residence address.

4.

When did defendant begin to manufacture or cause to be manufactured lids for cartons for frozen foods such as the lids exemplified by the physical exhibits submitted with Plaintiff's Requests for Admissions of Fact filed concurrently herewith?

5.

Is defendant presently manufacturing or causing to be manufactured lids such as identified in preceding Interrogatory 4?

6.

If the answer to preceding Interrogatory 5 is in the negative, state when defendant ceased to manufacture or caused to be manufactured such lids.

7.

When did defendant begin selling or causing to be sold such lids such as identified in preceding Interrogatory 4?

8.

When, prior to the service of these interrogatories, did defendant last sell or cause to be sold any lids such as identified in preceding Interrogatory 4? [138]

9.

Give the name and address of the customer who purchased the lids referred to in the answer to preceding Interrogatory 8 and state the number of lids involved in the transaction.

10.

When, prior to the service of these interrogatories, did defendant last advertise to the trade lids such as identified in preceding Interrogatory 4?

11.

If the advertisement referred to in the answer to preceding Interrogatory 10 was in a periodical, state its name and date and the name and address of its publisher.

12.

Is the defendant at the present time actively engaged in the business of making or having made and selling or causing to be sold lids for cartons for frozen foods.

13.

What is the present address of defendant's place of business?

Dated: Los Angeles, California, March 28, 1956.

/s/ J. CALVIN BROWN,  
Attorney for Plaintiff.

/s/ ARTHUR H. BOETTCHER,  
Of Counsel. [139]

Acknowledgment of Receipt of Copy Attached.

[Endorsed]: Filed March 28, 1956.

[Title of District Court and Cause.]

PLAINTIFF'S EXHIBIT No. 15

ANSWER TO INTERROGATORIES  
BY PLAINTIFF

Now comes the defendant, M C S Corporation, and through one of its officers, Henry F. Bloomfield, Jr., answers the Interrogatories by Plaintiff as follows:

Interrogatory 1: "Give the names and residence addresses of all officers, directors and managing agents of the defendant."

Answer: Henry F. Bloomfield, Jr., 921 N. Rexford Drive, Beverly Hills, California; William A. Bloomfield, 1104 Tower Road, Beverly Hills, California; [143] Donald Frederick, Route #1, Box 240, Saugus, California.

Interrogatory 2: "Was one Donald Frederick ever an officer, director or managing agent of the defendant?"

Answer: Yes.

Interrogatory 3: "If the answer to preceding Interrogatory 2 is in the affirmative, state in what capacity he was connected with the defendant and the period of time during which he acted in such capacity, and give his residence address."

Answer: Since the incorporation of the defendant, M C S Corporation, Mr. Frederick has been vice president of the defendant corporation; and upon information and belief his residence address is Route #1, Box 240, Saugus, California.

Interrogatory 4: "When did defendant begin to manufacture or cause to be manufactured lids for cartons for frozen foods such as the lids exemplified by the physical exhibits submitted with Plaintiff's Requests for Admissions of Fact filed concurrently herewith?"

Answer: March 9, 1951.

Interrogatory 5: "Is defendant presently manufacturing or causing to be manufactured lids such as identified in preceding Interrogatory 4?" [144]

Answer: Yes.

Interrogatory 6: "If the answer to preceding Interrogatory 5 is in the negative, state when defendant ceased to manufacture or caused to be manufactured such lids."

Answer: No answer required.

Interrogatory 7: "When did defendant begin selling or causing to be sold lids such as identified in preceding Interrogatory 4?"

Answer: March 9, 1951.

Interrogatory 8: "When, prior to the service of these interrogatories, did defendant last sell or cause to be sold any lids such as identified in preceding Interrogatory 4?"

Answer: On or about March 26, 1956.

Interrogatory 9: "Give the name and address of the customer who purchased the lids referred to in the answer to preceding Interrogatory 8 and state the number of lids involved in the transactions."

Answer: Frances Abraham of Arkadelphia, Arkansas; 20 lids. [145]

Interrogatory 10: "When, prior to the service of

these interrogatories, did defendant last advertise to the trade lids such as identified in preceding Interrogatory 4?"

Answer: The defendant advertised in the January, 1953, issue of Locker Management, but is not presently advised of the date of its last advertisement to the trade.

Interrogatory 11: "If the advertisement referred to in the answer to preceding Interrogatory 10 was in a periodical, state its name and date and the name and address of its publisher.

Answer: Upon information and belief the last advertisement was in the publication Locker Management; and on information and belief the name and address of the publisher is Locker Management, Inc., St. Louis 2, Missouri.

Interrogatory 12: "Is the defendant at the present time actively engaged in the business of making or having made and selling or causing to be sold lids for cartons for frozen foods?"

Answer: Yes.

Interrogatory 13: "What is the present address of defendant's place of business?"

Answer: 1120 North La Brae Avenue, Los Angeles, California.

/s/ HENRY F. BLOOMFIELD,  
JR. [146]

Duly Verified. [147]

Acknowledgment of Receipt of Copy Attached.

[Endorsed]: Filed Apr. 17, 1956.



[Title of District Court and Cause.]

DEFENDANT'S SUBMISSION OF DOCUMENT PURSUANT TO PROFFER MADE DURING TRIAL

Pursuant to the proffer into evidence by counsel for the defendant during the time of trial of the above identified cause (on Friday, May 4, 1956; see Reporter's Transcript of Proceedings, pages 129-130) of the File Wrapper and Contents of United States Letters Patent to Hill No. 2,623,685, the defendant hereby submits to this Honorable Court the following identified documents respecting said patent which are filed concurrently herewith and marked Defendant's Exhibits H and I.

Defendant's Exhibit H

A Certified true copy from the records of the United States Patent Office of the File Wrapper and Contents of United States Letters Patent No. 2,623,685 to Donald W. Hill, for Plastic Cover for Waxed Paper Container. [203]

Defendant's Exhibit I

A Certified true copy from the records of the United States Patent Office of United States Letters Patent No. 2,623,685 to Donald W. Hill, for Plastic Cover for Waxed Paper Container.

Defendant's Exhibit I is a certified copy of United States Letters Patent to Donald W. Hill, an uncertified copy having been submitted during the trial as Tab 7 of Defendant's Exhibit B.

Respectfully submitted,

HARRIS, KIECH, FOSTER  
& HARRIS,

/s/ By DONALD C. RUSSELL [204]

Affidavit of Service by Mail Attached. [205]

[Endorsed]: Filed May 23, 1956.

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[Title of District Court and Cause.]

### NOTICE OF DECISION

In this action brought to redress a claim of infringement of United States Letters Patent to Poole (No. 2,638,261), the Court is asked first to determine validity of the patent and, second, to find that defendant's structure infringes.

There are six claims in the Poole patent, all of which are involved.

The patent discloses:

“—a paperboard open top carton (12) having a lap joint (17 and 13) extending to the upper edge of the carton, and

—a cover (11) having a peripheral [287] downwardly extending recess (18) for engagement with the open top of the carton, the recess being made twice as wide (18) at the lap joint to fit the double thickness of the carton wall due to the lap joint (See Fig. 4 of Poole).”

The paper bound carton is certainly not new nor does the lap joint have any novelty.

Plaintiff contends that there is a combination of

elements which co-related and viewed as a whole unit produce a different effect from the sum of that which is produced by their separate parts. As this is consistent with the applicable rule, it is not necessary that any one of the several elements in itself be new.

As has been said by the Court of Appeals for this Circuit:<sup>1</sup>

“A new combination of old elements, in which, by a different location of one or more of the elements, a new and useful result is attained, or an old result is produced in a better way, is patentable. \* \* \*”

This rule does not do away with the necessity that the effective combination perform some new or different function than the various elements performed in their prior public uses, and that the patentee has, by his new combination, created something new that has not existed before. The new thing must have been produced by [288] “invention” as distinguished from mere mechanical skill.

The Court is convinced that any reasonably competent person skilled in the art, if presented with the problem of providing a cover for a lap-jointed carton, could have produced what Poole produced and, in so doing, would not have gone beyond the simple skills known and practiced in the art.

The Court finds that the structure is wanting in invention. It is the result of the application of ordinary structural skill or, as the books put it, “mechanical skill.”

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<sup>1</sup>New York Scaffolding Co. v. Whitney, 224 F. 452, at 458.

As this finding makes it unnecessary to find further, the Court will not discuss the prior patents or the similarity of the accused structure.

Counsel for defendant will submit Findings, Conclusions and Judgment consonant with this Notice of Decision.

Dated: This 7th day of November, 1956.

/s/ ERNEST A. TOLIN,  
United States District Judge. [289]

[Endorsed]: Filed Nov. 7, 1956.

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In the United States District Court, Southern  
District of California, Central Division

Civil Action No. 16,413-T

CONTAINER CORPORATION OF AMERICA,  
Plaintiff,

v.

MCS CORPORATION,                      Defendant.

FINDINGS OF FACT, CONCLUSIONS OF  
LAW, AND JUDGMENT

Findings of Fact

1. The plaintiff, Container Corporation of America, is a corporation organized and existing under and by virtue of the laws of the State of Delaware, having its corporate office at Wilmington, Delaware, and its general office at Chicago, Illinois.

2. The defendant, M C S Corporation, is a California corporation having its principal place of business at Los Angeles, California.

3. This action is based upon the patent laws of the United States, and the counterclaim arises under the patent laws [291] of the United States and Section 2201 of Title 28 of the United States Code.

4. The plaintiff, Container Corporation of America, is the owner of the United States Letters Patent No. 2,638,261, in suit, said patent having been issued to the plaintiff on May 12, 1953, on an application, Serial No. 26,172, filed on May 10, 1948, by William J. Poole for the Frozen Food Carton With Plastic Lid.

5. The patent in suit, No. 2,638,261, discloses a paper board open top carton having a lap joint extending to the upper edge of the carton, and a cover having a peripheral downwardly extending recess for engagement with the open top of the carton, the recess being made twice as wide at the lap joint to fit the double thickness of the carton wall due to the lap joint.

6. The patent in suit and each and every claim thereof relates to a combination of old elements, which combination could have been produced by any reasonably competent person skilled in the art without going beyond the simple skills known and practiced in the art.

7. The structure as claimed in each and every claim of the patent in suit is wanting in invention.

### Conclusions of Law

1. The court has jurisdiction of the parties and over the subject matter set forth in the complaint, and the court has jurisdiction of the parties and over the subject matter set forth in the counterclaim. [292]

2. Each of the claims, 1, 2, 3, 4, 5 and 6 of the patent in suit, No. 2,638,261, in issue herein, is invalid and void for lack of invention.

3. The defendant, M C S Corporation, is entitled to judgment against the plaintiff, Container Corporation of America, dismissing the complaint with prejudice.

4. The defendant, M C S Corporation, is entitled to judgment on its counterclaim herein for declaratory relief, adjudging the patent in suit No. 2,638,261, and each and every of the claims thereof, invalid and void.

### Judgment

In accordance with the foregoing Findings of Fact and Conclusions of Law, it is ordered, adjudged and decreed that:

1. United States Letters Patent No. 2,638,261 and each and every claim thereof, is invalid and void in law.

2. The Complaint for Infringement of United States Letters Patent No. 2,638,261 is hereby dismissed with prejudice.

3. The Counterclaim for declaratory relief ad-

judging United States Letters Patent No. 2,638,261 and each and every of the claims thereof, invalid and void, is hereby sustained.

4. The defendant, M C S Corporation, is entitled to recover from the plaintiff, Container Corporation of America, [293] its costs herein in the amount of \$49.10.

Dated: This 20th day of November, 1956.

/s/ ERNEST A. TOLIN,

United States District Judge. [294]

Acknowledgment of Receipt of Copy attached. [295]

[Endorsed]: Lodged Nov. 13, 1956. Docketed, Entered and Filed Nov. 20, 1956.

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[Title of District Court and Cause.]

### NOTICE OF APPEAL

Notice is hereby given that Container Corporation of America, plaintiff above named, hereby appeals to the United States Court of Appeals for the Ninth Circuit from the judgment entered in this action on the 20th day of November, 1956.

Dated: December 17, 1956.

/s/ J. CALVIN BROWN,

Attorney for Plaintiff. [297]

[Endorsed]: Filed Dec. 17, 1956.

[Title of District Court and Cause.]

STIPULATION FOR COSTS ON APPEAL

Know All Men By These Presents, That Fidelity and Deposit Company of Maryland, a Corporation organized and existing under the laws of the State of Maryland, and duly licensed to transact business in the State of California, is held and firmly bound unto M.C.S. Corporation on the penal sum of Two Hundred and Fifty and No/100 (\$250.00) Dollars, to be paid to said Defendant, his successors, assigns or legal representatives, for which payment well and truly to be made, the Fidelity and Deposit Company of Maryland binds itself, its successors and assigns firmly by these presents.

The Condition of the Above Obligation Is Such, that whereas, Container Corporation of America is about to take an appeal to the United States Court of Appeals for the Ninth Circuit appealing from a decree dated November 20, 1956 finding non infringement of a certain patent by the United States District Court for the Southern District of California, Central Division, in the above entitled case.

Now, Therefore, if the above named appellant shall prosecute said appeal to effect and answer all costs which may be adjudged against it if it fails to make good its appeal, then this obligation shall be void; otherwise to remain in full force and effect. [298]

It Is Further Agreed by the Surety, that in case of default or contumacy on the part of the Principal or Surety, the Court may, upon notice to them



of not less than ten days, proceed summarily and render judgment against them, or either of them, in accordance with their obligation and award execution thereon.

Signed, Sealed, and dated this 13th day of December, 1956.

[Seal] FIDELITY AND DEPOSIT COMPANY OF MARYLAND,  
/s/ By ROBERT HECHT,  
Attorney in Fact.

Examined and recommended for approval as provided in Rule 8.

/s/ J. CALVIN BROWN,  
Attorney.

Approved this 17th day of December, 1956.

/s/ M. E. THOMPSON,  
Deputy.

Duly Verified. [299]

[Endorsed]: Filed Dec. 17, 1956.

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[Title of District Court and Cause.]

### STATEMENT OF POINTS

1. The District Court, weighing the subject matter of the patent in suit for invention, erred in taking into account only the lap joint of the open-top carton and the widening of the under-side peripheral recess of the cover to accommodate the double thickness of the lap.

2. The District Court, weighing the subject matter of the patent in suit for invention, erred in not taking into account all the recitations in each of the claims of the patent in suit.

3. The District Court, weighing the subject matter of the patent in suit for invention, erred in not treating the same as a patentable combination of the elements as specified in the claims.

4. The District Court erred in finding the structure [300] of the patent in suit wanting in invention and in finding that producing it involved no more than ordinary skill of the art.

5. The District Court erred in holding the patent in suit invalid and void, in dismissing the complaint, in sustaining defendant's counterclaim, and in awarding costs to defendant.

6. The District Court erred in not holding the patent in suit valid and infringed, in not granting the relief prayed for in the complaint, and in not dismissing the counterclaim, with costs to plaintiff.

Dated: December 31, 1956.

/s/ J. CALVIN BROWN,

Attorney for Plaintiff-Appellant.

BROWN, JACKSON, BOETTCHER  
& DIENNER,

/s/ ARTHUR H. BOETTCHER,

Counsel for Plaintiff-Appellant.

Acknowledgment of Service attached. [301]

[Endorsed]: Filed Jan. 2, 1957.

[Title of District Court and Cause.]

DESIGNATION OF CONTENTS OF  
RECORD ON APPEAL

Pursuant to Rule 75(a) of the Federal Rules of Civil Procedure, the plaintiff-appellant hereby designates for inclusion in the record on appeal the following:

1. Complaint.
2. Answer and Counterclaim.
3. Reply to Counterclaim.
4. Notice Pursuant to Title 35 U.S.C. 282.
5. Interrogatories by Plaintiff (Pl. Ex. 14).
6. Plaintiff's Requests for Admissions of Fact (Pl. Ex. 7).
7. Answer to Interrogatories by Plaintiff (Pl. Ex. 15).
8. Defendant's Submission of Document Pursuant to Proffer Made During Trial.
9. Transcript of Proceedings and Evidence at Trial. (Omitting Opening Statements, Page 2, line 8, — Page 23, line 8.) [302]
10. All of Plaintiff's Exhibits, said Exhibits being as follows: Plaintiff's Exhibits 1 to 23-A, inclusive, including 15-A, 22-A, 22-B and 23-A.
11. All of Defendant's Exhibits, said Exhibits being as follows: Defendant's Exhibits A to I, inclusive.
12. Order for Transmittal of Original Exhibits.
13. Notice of Decision.
14. Findings of Fact.
15. Conclusions of Law.

16. Judgment.
17. Notice of Appeal.
18. Appeal Bond.
19. Statement of Points.
20. This Designation of Contents of Record on Appeal.
21. Clerk's Certificate.

Dated: December 31, 1956.

/s/ J. CALVIN BROWN,  
Attorney for Plaintiff-Appellant.  
BROWN, JACKSON, BOETTCHER  
& DIENNER,

/s/ ARTHUR H. BOETTCHER,  
Counsel for Plaintiff-Appellant.

Acknowledgment of Service attached. [303]

[Endorsed]: Filed Jan. 2, 1957.

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[Title of District Court and Cause.]

### ORDER FOR TRANSMITTAL OF ORIGINAL EXHIBITS

Upon consent of the parties and it appearing to the Court that the original exhibits in this action should be inspected by the United States Court of Appeals for the Ninth Circuit:

It Is Ordered that the Clerk of this Court shall transmit to the United States Court of Appeals for the Ninth Circuit all of Plaintiff's Exhibits, namely Plaintiff's Exhibits 1 to 23-A, inclusive, including 15-A, 22-A, 22-B and 23-A and all of De-

fendant's Exhibits, namely Defendant's Exhibits A to I, inclusive, to be safely kept by the clerk of said Court of Appeals [304] for the use of that Court in the consideration of this action, and thereafter to be returned by him to this Court.

Dated: January 2, 1957.

/s/ ERNEST A. TOLIN,  
Judge of United States District  
Court.

The above order is consented to,

/s/ J. CALVIN BROWN,  
Attorney for Plaintiff-Appellant.

/s/ DONALD C. RUSSELL,  
Attorney for Defendant-  
Appellee. [305]

[Endorsed]: Filed Jan. 3, 1957.

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[Title of District Court and Cause.]

### CERTIFICATE OF CLERK

I, John A. Childress, Clerk of the United States District Court for the Southern District of California, do hereby certify that the foregoing pages, numbered 1 to 306, inclusive, contain the original—

Answer and Counterclaim; Answer to Plaintiff's Interrogatories; Bond on Appeal; Designation of Record on Appeal; Notice of Appeal; Order Extending Time to Docket Appeal; Order for Transmittal of Original Exhibits; Statement of Points on Appeal; Further Authorities Submitted by Plaintiff; Closing Brief for Defendant; Brief for Plain-

tiff; Reply Brief for Plaintiff; Complaint; Stipulation for Costs; Notice of Decision; Defendant's Reply to Plaintiff's Opposition to Motion for Summary Judgment; Findings of Fact and Conclusions of Law, Proposed; Findings of Fact and Conclusions of Law and Judgment; Interrogatories by Plaintiff; Defendant's Memorandum Prior to Trial; Motion and Notice of for Summary Judgment; Names and Addresses of Attorneys; Notice by Defendants, Pursuant to Title 35, Sec. 282; Opposition to Defendant's Motion for Summary Judgment; Order; Plaintiff's Comments on Defendant's Reply to Plaintiff's Opposition to Motion for Summary Judgment; Reply to Counterclaim; Request of Plaintiff for Admissions of Fact; Stipulation and Order Continuing Hearing on Motion for Summary Judgment; Stipulation and Order Correcting Reporter's Transcript; Submission of Documents by Defendants Pursuant to Proffer Made During Trial; Proposed Summary Judgment; Plaintiff's Trial Memorandum; and a full, true and correct copy of the Minutes of the Court on June 21, 1954; July 19, 1954; Sept. 29, 1954; May 2, 1955; October 21, 1955; Feb. 3, 1956; May 1, 1956; May 3, 1956; May 4, 1956; Oct. 12, 1956; and Nov. 5, 1956; which, together with the original of Plaintiff's Exhibits 1 through 23-A, inclusive, including 15-A, 22-A, 22-B, and Defendant's Exhibits A through G, inclusive and two volumes of Reporter's Transcript of Proceedings had on May 3, 1956 and May 4, 1956, in the above entitled cause, constitute the transcript of record on appeal to the United

States Court of Appeals for the Ninth Circuit, in said cause.

I further certify that my fees for preparing the foregoing record amount to \$1.60, which sum has been paid by appellants.

Witness my hand and the seal of said District Court, this 8th day of February, 1957.

[Seal] JOHN A. CHILDRESS,  
Clerk,

/s/ EDWARD F. DREW,  
Chief Deputy.

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In The United States District Court, Southern  
District of California, Central Division

No. 16,413-T

CONTAINER CORPORATION OF AMERICA,  
Plaintiff,

vs.

M.C.S. CORPORATION, Defendant.

REPORTER'S TRANSCRIPT OF  
PROCEEDINGS

Los Angeles, California  
May 3, 1956

Honorable Ernest T. Tolin, Judge Presiding.

Appearances: For the Plaintiff: Arthur H.  
Boettcher, 53 West Jackson Boulevard, Chicago,

Illinois, and J. Calvin Brown, 704 South Spring Street, Suite 804, Los Angeles, California.

For the Defendant: Harris, Keich, Foster & Harris, by: Donald C. Russell, 417 South Hill Street, Suite 321, Los Angeles, California. [1\*]

Thursday, May 3, 1956. 1:35 P.M.

The Court: Call our case, please.

The Clerk: 16,413 Container Corporation of America v. M.C.S. Corporation.

Mr. Boettcher: Plaintiff is ready.

Mr. Russell: Defendant is ready. [2]

\* \* \* \* \*

The Court: Are you ready to proceed with the evidence?

Mr. Boettcher: I desire, in the first instance, to offer in evidence a number of exhibits requiring no testimony, and I shall do that, if I may.

Mr. Russell: May I interrupt, Mr. Boettcher?

Mr. Boettcher: Surely.

Mr. Russell: So far as exhibits are concerned, we have several prior art patents here and I would be willing to stipulate with you, if you so desire, that soft copies of any patents may be introduced subject to any correction by certified copies, if, in fact, corrections need be made.

Mr. Boettcher: I will be very pleased to stipulate that, if it will facilitate your proofs. However, I have these organized, and I would like to introduce them.

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\* Page numbers appearing at top of page of original Reporter's Transcript of Record.



Mr. Russell: Very well.

The Court: All right.

Mr. Boettcher: If you can avoid duplication later, that [23] will be fine for the record.

Mr. Russell: Very well.

Mr. Boettcher: I offer in evidence a certificate of the Secretary of State of Delaware, evidencing the corporate capacity of the plaintiff.

The Court: Received.

(The document referred to was marked Plaintiff's Exhibit 1 and was received in evidence.)

Mr. Boettcher: And I offer this as Plaintiff's Exhibit 2, a certificate of the Secretary of State of the State of California, evidencing the corporate capacity of the defendant.

The Court: Received.

(The document referred to was marked Plaintiff's Exhibit 2 and was received in evidence.)

The Court: In the light of your remarks, I am going to receive each one, without waiting a minute or so to hear an objection,—

Mr. Russell: Yes.

The Court: —but if you have objection, let me know.

Mr. Russell: I certainly shall, your Honor.

Mr. Boettcher: As Plaintiff's Exhibit 3, I offer a certified copy of the Poole patent in suit, United States Letters Patent No. 2,638,261.

The Court: Received. [24]

(The document referred to was marked

Plaintiff's Exhibit 3 was received in evidence.)

Mr. Boettcher: As Plaintiff's Exhibit 4, I offer a certified copy of a portion of the Digest of the United States Patent Office, showing the title of the patent in suit to be in the plaintiff.

The Court: Received.

(The document referred to was marked Plaintiff's Exhibit 4 and was received in evidence.)

Mr. Boettcher: As Plaintiff's Exhibit 5, I offer a certified copy of a so-called file wrapper and contents of the patent in suit.

I might say at this point that Mr. Russell pointed out to me before this session that there is one already on file, which we used in connection with the motion for summary judgment.

The Court: Of course, you have to make a full record on the trial of the case,—

Mr. Boettcher: That is right.

The Court: —so the one you now offer is received. If you want to offer anything from the record on the motion for summary judgment and avoid duplication, you may offer it by reference.

Mr. Boettcher: If I may do it this way, by offering this, I think I would rather do it. [25]

The Court: You do it your way.

Mr. Boettcher: As I say, I have it in an orderly fashion.

The Court: You are proceeding very expeditiously.

The Clerk: Plaintiff's 5.

(The document referred to was marked Plaintiff's Exhibit 5 and was received in evidence.)

Mr. Boettcher: I offer as one exhibit, as Plaintiff's Exhibit 6, certified copies of the references which were cited by the Patent office in the file history of the patent in suit. That is in order to make that Patent office proceeding entirely complete.

The Court: Received.

(The documents referred to were marked Plaintiff's Exhibit 6 and were received in evidence.)

Mr. Boettcher: And I will offer in evidence plaintiff's requests for admissions of fact under Rule 36 of the Rules of Civil Procedure. They were filed on or about March 30, 1956, and should be made a part of the record.

The Court: Received.

(The documents referred to were marked Plaintiff's Exhibit 7 and were received in evidence.)

Mr. Boettcher: Mr. Russell, may we have the record show that these requests for admissions were not answered by the defendant, and, therefore, under the rule, are to be taken as [26] admitted?

Mr. Russell: The requests were not answered, your Honor.

The Court: Do you mean by that that they are admitted?

Mr. Russell: In accordance with the rule, they are deemed admitted.

The Court: It wasn't an inadvertence?

Mr. Russell: No, your Honor.

Mr. Boettcher: I might say that I spoke to Mr. Russell about that before the session, so there would be no question about inadvertency.

Now, in our requests for admissions of fact we made reference to certain exhibits, and I shall now proceed to offer those exhibits.

As I pointed out at the beginning, this really facilitates the introduction of evidence a great deal. So as Plaintiff's Exhibit 8 I introduce a specimen of the accused lid, large size.

The Court: Received.

(The lid referred to was marked Plaintiff's Exhibit 8 and was received in evidence.)

Mr. Boettcher: As Plaintiff's Exhibit 9, I introduce a specimen of the accused lid, small size.

The Court: Received.

(The lid referred to was marked Plaintiff's Exhibit 9 and was received in evidence.) [27]

Mr. Boettcher: As Plaintiff's Exhibit 10, I offer "Plaintiff's Exhibit Specimen of Defendant's Literature No. 1."

The Court: Received.

(The document referred to was marked Plaintiff's Exhibit 10 and was received in evidence.)

Mr. Boettcher: As Plaintiff's Exhibit 11, I offer "Plaintiff's Exhibit Specimen of Defendant's Literature No. 2."

The Court: Received.

(The document referred to was marked

Plaintiff's Exhibit 11 and was received in evidence.)

Mr. Boettcher: As Plaintiff's Exhibit 12, I offer "Plaintiff's Exhibit Defendant's Advertisement" appearing in the Locker Management for January, 1953.

The Court: Received.

(The document referred to was marked Plaintiff's Exhibit 12 and was received in evidence.)

Mr. Boettcher: As Plaintiff's Exhibit 13, I offer a copy of plaintiff's letter of notification to defendant, dated November 2, 1953. By "notification" I mean notice of infringement of the patent in suit.

The Court: Received.

(The letter referred to was marked Plaintiff's Exhibit 13 and was received in evidence.)

Mr. Boettcher: Plaintiff also filed interrogatories at the same time as the requests for admissions, that is, on or [28] about March 30, 1956. And in order to make them of record, as part of the evidence, I offer them.

The Court: Received.

The Clerk: Plaintiff's 14.

(The document referred to was marked Plaintiff's Exhibit 14 and was received in evidence.)

The Court: Do you offer the answers?

Mr. Boettcher: I am ready to do that now.

The Court: You are offering the interrogatories first.

Mr. Boettcher: Right.

The Court: All right. They merely are, of course, a set of questions. They are received in order that we will understand the next exhibit.

Mr. Russell: I believe, your Honor, the questions are fully set forth in the answers, as well, in accordance with the rule.

The Court: They should be.

Mr. Boettcher: May I introduce the answers, so as to be sure they are in the record?

The Court: Received.

Mr. Boettcher: As Plaintiff's Exhibit 15.

The Court: Yes.

(The document referred to was marked Plaintiff's Exhibit 15 and was received in evidence.)

Mr. Boettcher: May I ask Mr. William J. Poole to take [29] the witness stand?

The Court: Yes.

### WILLIAM J. POOLE

called as a witness on behalf of the plaintiff, having been first duly sworn, was examined and testified as follows:

The Clerk: Will you please be seated.

The Court: Mr. Poole, please keep your voice up. In this large room it tends to be dissipated before it reaches our ears.

The Witness: Yes, your Honor.

The Clerk: Your name, sir?

The Witness: William J. Poole.

### Direct Examination

Q. (By Mr. Boettcher): You have stated your

(Testimony of William J. Poole.)

name for the record?           A. Yes.

Q. What is your age?           A. 37.

Q. Where do you reside?

A. Evanston, Illinois.

Q. That is just outside of Chicago, is it not?

A. Yes, sir, it is.

Q. You are an employee of the Container Corporation of America, the plaintiff in this case, is that right?           A. Yes, sir. [30]

Q. Where do you headquarter with the company?

A. In Chicago, Illinois, at the 35th Street folding carton plant.

Q. What does "folding carton plant" mean in your lingo of the trade?

A. A folding carton is one which is die-cut and scored, assembled in a flat form and shipped to the user in a flat form, to be subsequently squared up and sealed.

Q. In other words, they are blanks?

A. That is right.

Q. Cut to size and scored, ready for folding, and somebody else does the folding later, to complete the carton, is that right?           A. That is correct.

Q. When did you first come with the Container Corporation?           A. May 1st, 1940.

Q. What did you do there?

A. I started in a production training course.

Q. And where was that done?

A. At the same 35th Street plant.

Q. How long did that production training last?

(Testimony of William J. Poole.)

A. For a period of about two months.

Q. What then?

A. I was transferred to a department known as a [31] package development laboratory.

Q. How long were you there?

A. Until about April 1st of 1942.

Q. In that package development laboratory, what kind of packaging were you there concerned with?

A. We were doing experimental work on frozen food packages.

Q. What happened on April 1st, 1942?

A. I left the employ of the company to go into the Service.

Q. You went into the Marine Corps, is that right?      A. Yes, sir.

Q. How long were you in that Service?

A. Until November 17, 1945.

Q. What then?

A. I returned immediately to the employ of Container Corporation, some eight days later, after discharge.

Q. Upon your return to Chicago?

A. That is right.

Q. When you came back at the end of 1945, latter part of 1945, in what capacity did you do so?

A. I was rehired specifically to take the place of the gentleman who was in charge of sales and development in this frozen food package department, since he had announced his intention to leave the company to take other employment about [32] the first of the year, of 1946.



(Testimony of William J. Poole.)

Q. Did he continue there until the first of the year, and were you there at the same time?

A. Yes, sir.

Q. Do I understand that you said that you succeeded him as head of the frozen food division?

A. That is correct, sir.

Q. And that was the 1st of January, 1946?

A. Yes, sir.

Q. At that time, January 1st, 1946, was plaintiff's frozen food division making and selling cartons for frozen foods?

A. Yes, sir, they were.

Q. Tell us about the kind or kinds of cartons they were selling for frozen foods at that time.

A. There were two basic types, one of which was a carton and cellophane bag combination. The other one was a rigid set up container of square cross section, which employed a round metal plug which was designed for inserting into a round opening in the top of the container for closure.

Q. In using the word "setup" there, you mean a blank had been forwarded to form an actual carton with volume, is that right?

A. That is correct, sir.

Q. Go back to the cellophane bag-and-carton combination [33] arrangement that you spoke of.

A. Basically the cellophane bag formed the protective container for the food to be frozen. The carton, folding carton, which it was placed in, acted primarily as a protection for the bag.

Q. To carry the bag?

(Testimony of William J. Poole.)

A. That is correct.

Q. Well, did the housewife prepare vegetables or fruit and pour it or get it into the bag somehow?

A. That is correct, sir.

Q. And then that was put into the container?

A. That was put into the folding carton, which had a locking device at the bottom and another one at the top.

Q. What kind of a device?

A. A mechanical locking device, a hook lock of some type.

Q. You mean to hold the bottom together?

A. That is right.

Q. And how was the top formed of that kind of carton?

A. Again the top was, top closure was completed with a similar type of lock.

Q. All right. Now, go to the other type you referred to that had a circular opening in the top. As I understand it, that was a prismatic shape?

A. That is correct. It was square in cross section. [34] If my memory serves me correctly, it was three and a quarter by three and a quarter inches. The quart size, I believe, was some five and a half to six inches high.

Q. How was that top formed?

A. The top consisted of four flaps, one coming off of each of the four side panels. Two of the flaps—four flaps had circular die-cut holes in them. The two flaps which were half flaps, which would meet in the center, had half-circle cut-outs in them,

(Testimony of William J. Poole.)

which, when all four were folded together, would register to form the end result, circular opening.

Q. That meant you had a laminated top of three layers, is that right?      A. That is correct.

Q. And it had a hole in the center of it?

A. That is right.

Q. You said it was square. What was the dimension horizontally?

A. About three and a quarter inches square.

Q. And how large was the opening?

A. Two and three-quarter inches in diameter.

Mr. Boettcher: Does your Honor understand that structure? I have here a metal container which might enable your Honor better to understand what the witness is talking about, although I don't care to put that in evidence. There is no objection to it, but I don't want to clutter up the evidence [35] in the record.

The Court: He may use it as an object to illustrate his testimony.

Mr. Boettcher: That is what I mean. Thank you.

The Court: You hold it up and show me whatever is necessary in order to illustrate your testimony.

Q. (By Mr. Boettcher): Does the container with a top, that has just been handed you, fairly illustrate the kind of a container you are talking about, except that this is metal and the other was paperboard?      A. Yes, it does.

(Testimony of William J. Poole.)

Q. Now, in that paperboard container structure, what was that top made of?

A. The top, of course, was of paper, an extension of the side panels of the carton.

Q. How about the closure for the opening in that top?

A. The closure was a stamped metal plug, substantially the same as this (indicating).

Q. About what was its height?

A. It had a recess depth of perhaps a quarter of an inch.

Q. And that fit into the circular opening at the top?      A. That is correct.

Mr. Boettcher: May I relieve the witness of that?

The Court: You just go ahead and present the case [36] according to your style, and I will try to follow it. If I feel confused, I will let you know.

Q. (By Mr. Boettcher): You are familiar with locker plants, are you not?      A. Yes, sir.

Q. When did you first become familiar with them?

A. I would say at the outset, when I first started working in this package development laboratory.

The Court: Are you speaking of frozen food locker plants?

The Witness: Yes, sir.

Q. (By Mr. Boettcher): Will you please explain the modus operandi of a locker plant and how it serves the public?

A. Well, the purpose is twofold. One, to furnish a means of sharp or quick freezing of the food prod-

(Testimony of William J. Poole.)

ucts which the housewife has previously prepared and packaged and brought into the locker plant. The sharp freezing is done in a range of minus 15 degrees Fahrenheit to perhaps as low as minus 30 degrees Fahrenheit. Subsequent to the sharp freezing it is normal procedure to transfer the food packages from the sharp freeze to a zero degree room which is usually compartmented with aisles and tiers of locker boxes, which are rented by the individual for the storage of this food. Usually they are rented on a monthly or annual rental basis.

The Court: Before we get to another question, I have a [37] jury deliberating and I have just received a note.

Mr. Bailiff, please hand the note to the attorneys so they will become familiar with it, and we will take the matter up at the recess time.

Q. (By Mr. Boettcher): I suppose these lockers, or what did you call them, lockers or lock boxes?

A. They are known as individual frozen food lockers.

Q. I suppose that space is a factor there?

A. Yes, it is, definitely.

Q. In other words, the rental is more or less proportionate to the size?      A. Yes, it is.

Q. Are you in a position to enlighten us somewhat on the matter of these cold compartments in ordinary domestic refrigerators?

A. They are not primarily for the freezing or long-period storage of food. They ordinarily run

(Testimony of William J. Poole.)

at a temperature slightly above zero. Their primary function is one of short-period storage.

Q. But they do freeze initially, do they not?

A. Oh, they can freeze, yes, sir.

Q. The idea being mainly that they can freeze fruits or vegetables or any other foods, but not to be kept at great length of time, is that right?

A. That is correct. [38]

Q. Do you know, as a matter of history, when such locker plants as you have described came into being or, at least, to popular knowledge?

A. To the best of my knowledge, around 1937, 1938.

Mr. Boettcher: I think I would like to introduce this sample of metallic container, after all, and I do so offer it as Plaintiff's Exhibit 16.

The Court: You are now referring, as I apprehend it, to the container which the witness used for illustration here a few minutes ago?

Mr. Boettcher: That is correct, your Honor.

The Court: It is received.

Mr. Boettcher: I would like to change the number of that exhibit to 15-A, if I may, please, in order to maintain my sequence.

The Court: All right. So ordered.

(The container referred to was marked Plaintiff's Exhibit 15-A and was received in evidence.)

Q. (By Mr. Boettcher: Have you knowledge of other types of frozen food containers? I am

(Testimony of William J. Poole.)

speaking of the industry, the practical side of it. That is, in 1946.      A. Yes, sir.

Q. Please state what they were.

A. Well, the box-and-cellophane-bag combination, to which we referred before, would be one category. [39]

The cylindrical type of container with a telescope lid, and as an example that type of container is used for bulk packing or hand-packing of ice cream, with which I think you are familiar.

Q. That has a pillbox cover?

A. That is right.

Then there was the round tapered wax cup, which used a snap-in paper disk as a lid. A good example of that would be the Dixie cup used for ice cream, also.

And then the rigid setup container with the round metal plug, which was just described.

Q. And of these various types, it was either Container or competitors of Container, is that right?      A. That is correct.

Q. Now, in order to keep the record clear as to these 1946 cartons of Container, that are like this Exhibit 15-A in form, the containers were shipped from the Container plant set up and ready to go, is that right?      A. That is correct, sir.

Q. As distinguished from these flat blanks.

A. That is right.

Q. Who made those stamped metal plugs that close the opening in the top of those containers?

(Testimony of William J. Poole.)

A. Those were manufactured by the Crown Cork Speciality Corporation at Decatur, Illinois. [40]

Q. They were sent on up to Container and Container put them into the cartons and sold the combinations that way, is that right?

A. That is correct.

Q. What came after the 1946 type? What happened after that?

A. Well, we decided, for reasons of requests from our consumers that came through our distributors, to attempt to improve the package by fabricating it with a full open top, and a tapered side wall.

Q. By "tapered" you mean that the carton as a whole, that is, the carton body, was flared slightly upwardly?      A. Yes, sir.

Q. What is that flare for?

A. It accomplishes several purposes. One was to facilitate stacking in the locker itself, the bottom of the carton being of a smaller dimension than the recess in the lid.

It also facilitated the saving of storage space, since the cartons could then be nested one inside the other. For that same reason it effected savings in freight.

Q. Why was the full open top carton body desirable?

A. From the standpoint of the user, it was of considerable importance, because it offered an ease of filling the package which had not been present in the carton with the [41] round or restricted open-



(Testimony of William J. Poole.)

ing. Perhaps even more important, it facilitated the emptying of the contents of the package without the need of prior defrosting, which in many cases is not desirable.

The Court: I think at this time we will take the afternoon recess, so far as this case is concerned, and have the jury in in the case in which the jury is deliberating. So you take about a 15 or 20-minute recess.

(A recess was taken from 3:00 p.m. to 3:35 p.m.)

Q. (By Mr. Boettcher): Mr. Poole, when was it, approximately, that you went to this full open top thinking regard to the carton body?

A. This was early in the year 1947.

Q. Just before recess you were explaining the desirability of that full open top. I think that you referred to the matter of filling the carton, to begin with, and emptying the carton of the frozen contents. A. Yes, sir.

Q. Will you go on with that, to explain any special advantages beyond the two you have mentioned, if there are any?

A. I think perhaps this was covered, I don't recall,—

Q. I want to be sure, that is the point.

A. The matter of filling, of course, was important. The matter of being able to empty the contents without having to defrost them or without having to cut or otherwise destroy the container, plus the fact that the full open top gave the—al-

(Testimony of William J. Poole.)

lowed the possibility of nesting the cartons to save [42] freight and to save storage space.

Q. Now, in respect of the thawing of the contents, what is the practice with reference to that? Begin with the point that the frozen package is taken from the locker.

A. In the instance of the carton with the restricted opening, it would be necessary to almost completely defrost or thaw in order to empty the contents. Either that or use some sharp implement to cut the carton open to empty the contents.

In some foods, particularly frozen vegetables, it is desirable to begin the cooking process without thawing at room temperature.

Q. Given that kind of a carton body that you have described, what was your thinking with reference to the top for it, the lid for it?

A. We experimented with various possibilities as to materials which might be used to fabricate such a lid or closure piece. We experimented with paperboard, with drawn or stamped metal, as well as molded materials, such as the plastic that we eventually determined was desirable.

Mr. Boettcher: I have here a carton body that I ask to have marked for identification as Plaintiff's Exhibit 16.

(The carton body referred to was marked Plaintiff's Exhibit 16 for identification.)

Q. (By Mr. Boettcher): Mr. Poole, I submit to you a [43] carton body that is marked for identi-

(Testimony of William J. Poole.)

fication as Plaintiff's Exhibit 16, and ask, if you will please, you to identify or tell us what it is.

Mr. Russell: May I see the body?

Mr. Boettcher: Surely. That is one I showed you a little while before the session opened.

Mr. Russell: Yes. Thank you.

The Witness: This carton was one of the initial experimental packages that was made in early 1947.

The Court: May I see that?

The Witness: Yes, sir.

The Court: Thank you.

Q. (By Mr. Boettcher): That is to your own knowledge? A. Yes, sir.

Mr. Boettcher: I offer the carton marked for identification as Plaintiff's Exhibit 16, as Plaintiff's Exhibit 16.

The Court: Received.

(The carton body heretofore marked Plaintiff's Exhibit 16 was received in evidence.)

Q. (By Mr. Boettcher): Proceed with what happened with reference to the top or lid after you considered these various materials from which to make it.

A. We discarded paper and also stamped or drawn sheet metal because we found it was impossible to obtain a liquid-tight closure, using those materials for the lids. [44]

Having determined that it followed that is would be necessary to use some form of a molded material, we discarded metal, of course, because of the expense.

(Testimony of William J. Poole.)

Q. And what molded material did you determine upon?

A. We determined upon a polystyrene plastic material which is molded under heat and pressure.

Q. What are its qualities that led you to choose that material for the lid?

A. Primarily its stability through the temperature range in which it would be used.

Q. You mean it has a very low coefficient of expansion and contraction, is that right?

A. That is correct.

Q. What about the ability to mold it into any desired form?

A. That, of course, is one of the basic characteristics of the material.

Secondary reasons were, of course, cost which appeared practical, and the fact that it was a transparent material also made it desirable, from the standpoint of being able to see the contents of the package.

Q. What did you do about having such lids made or making them yourself?

A. We contacted the Chicago representative of the Crown Cork Specialty Corporation, with whom we were at that [45] time doing business on the other type of cartons, and we brought to his attention samples of the package which we were developing, together with our ideas and sketches as to how we felt this mold should be made, what form we felt the mold should take to manufacture this lid.

(Testimony of William J. Poole.)

Q. By "package" there, do you mean the carton or what? You said you submitted it to him or you conveyed to him something.

A. I can refer to the exhibit just presented here as an example of the type of carton.

Q. You are referring to Plaintiff's Exhibit 16, is that right?           A. Yes, sir.

Q. And this was still early in 1947, is that right?

A. That is right.

Q. Did you do this personally?

A. Yes, I did, sir.

Q. What was the name of the man to whom you spoke in Chicago, the representative of the Crown Cork?           A. Mr. Ves Hoffman.

Q. What was the immediate upshot of that contact with him?

A. He and I made a trip to Decatur, which is the location of their manufacturing operation, to lay this problem out before their engineering and production people. [46]

Q. What happened?

A. We again presented these samples and sketches to the people who would have to build the molds and live with the production problems involved.

Q. By that you mean the carton samples?

A. The cartons.

Q. Where did the situation go from there?

A. We left with an understanding that they would investigate the production problems involved

(Testimony of William J. Poole.)

and report back to my company as to the feasibility of this lid.

Q. Did you order any lids such as had been discussed and determined upon?      A. Yes, we did.

Q. How many?

A. We ordered a quantity of 3,000.

Q. By what date was that done, the actual ordering of 3,000 lids, approximately?

A. We received initial samples, I believe, in June of 1947, and I believe placed the order in July of 1947.

Q. What were these 3,000 to be for?

A. They were to go along with some three thousand trial-run cartons, such as this—

Q. Exhibit 16?

A. Exhibit 16. They were not sold. They were distributed to various locker plants with whom we had previously [47] had contact and from whom we felt we could get cooperation in the form of a field test, with a request that they report back to us the consumer reaction.

Q. When was it that you distributed these 3,000.

A. To the best of my knowledge that occurred around in August. We started distributing these in August of 1947.

Q. When you received these 3,000 for that kind of distribution, did you try out these lids at the 35th Street plant where you were doing your business?

A. Yes, we did. Naturally, receiving a new item,

(Testimony of William J. Poole.)

we wanted to inspect it very carefully and check it up.

Q. What was the result of that?

A. Well, we immediately determined a flaw in our construction, because at that point there had been no allowance made for the double thickness of board at the manufacturer's joint of the carton.

Q. Now, by "manufacturer's joint" you mean what?

A. Well, that is the glued bond between, the glue flap on one panel of the carton, which is glued down to the corresponding meeting panel at the other end of the blank.

Q. By "manufacturer's joint" you mean that it is a joint that is necessarily there in the process of manufacturing, is that right?

A. That is correct.

Q. How did you discover that flaw to which you refer? [48]

A. By using the lid in the manner that the ultimate consumer would use it, by placing it on the carton body and pressing it down.

Q. What happened?

A. We found that we were unable to get a liquid-tight closure at the corner where the manufacturer's or lap joint is.

We also found that in some cases when enough pressure was exerted we would split or crack the material from which the lid was made at that point.

Q. That is the plastic?

A. The plastic.

(Testimony of William J. Poole.)

Q. What did you do about that?

A. We immediately contacted again Mr. Ves Hoffman, the Chicago representative of the Crown Cork Specialty Corporation, to acquaint him with the problem, and also to acquaint him with our thinking as to how this problem should be solved.

We asked him to transmit that information to his engineering and production people.

Q. How did you solve that particular item?

A. By incorporating a recess in the groove which was approximately the thickness of the additional piece of paperboard involved in the glue flap.

Q. That is, you augmented the recess width at that point, is that right? [49]

A. At that point and through that distance.

Q. When you decided on that, what did you do?

A. As I say, we transmitted this information to Mr. Hoffman. We had one visit together on it, at which time we requested him to submit this problem again to his engineering and production people, to see if such an accommodation could be built into the mold from which these lids are formed.

Q. Up to that time had they made a production mold of any kind?

A. No, sir, they had not. They had made a run-up, sample run mold.

Q. By that you mean a single cavity mold?

A. A single cavity, that is correct.

Q. And what did Mr. Hoffman report?

A. He reported back to us in a matters of a few



(Testimony of William J. Poole.)

days that it was entirely feasible to incorporate this feature and that upon our instruction it would be done.

Q. And what followed that?

A. Following that we placed an order with the Crown Cork Specialty Corporation for a production mold.

Q. And that mold would differ from the single cavity experimental mold, is that right?

A. Yes, sir.

Q. In what respect?

A. It would differ in the respect—well, [50] in several respects. One, it would incorporate the additional recess.

Also at that point it took the form of a gang mold, which involved several cavities.

Q. That is for production purposes?

A. For production purposes.

Q. Can you say approximately when you placed the order for the production mold?

A. To the best of my knowledge, that took place in September of 1947.

Q. Did you order lids to be made from that production mold?      A. Yes, we did.

Q. When did you do that, as nearly as you can say?

A. As nearly as I can say, that would fall in late October or November of 1947.

Q. How many did you order at that time of these lids, to be made from the production mold?

(Testimony of William J. Poole.)

A. 100,000.

Q. What about the complementary cartons themselves?

A. We issued production orders to our 35th Street plant to manufacture a corresponding number, 100,000 carton bodies.

Q. Was 100,000 regarded as a large number at that time?

A. No, it was a very small trial quantity.

Q. What was the idea?

A. The idea was to ship approximately 2,000 units to [51] each of 50 selected paper distributors over the country, and to use this as a complete field test, which was designed to either prove or disprove the merit of the package.

Q. When did these cartons and lids become available for delivery?

A. In the early spring of 1948.

Q. And did you start to make sales then?

A. Yes, we did.

Q. I show you a copy of the patent in suit, which is like the certified copy, Plaintiff's Exhibit 3, and ask you if you are the William J. Poole of that patent.       A. Yes, sir, I am.

Q. When did Container give its next order for lids, if you remember?

A. I would say about in August of 1948.

Mr. Boettcher: I have here a plastic lid, which I ask to be marked for identification as Plaintiff's Exhibit 17.

(Testimony of William J. Poole.)

(The lid referred to was marked Plaintiff's Exhibit 17 for identification.)

Q. (By Mr. Boettcher): Mr. Poole, I show you Plaintiff's Exhibit 17, and ask you if you can tell us what it is.

A. This is one of the early production models. It does contain in it the recess to correspond to the manufacturer's joint of the carton body.

Mr. Boettcher: I offer this plastic lid, [52] marked for identification Plaintiff's Exhibit 17, as Plaintiff's Exhibit 17.

The Court: Received.

(The lid heretofore marked Plaintiff's Exhibit 17 was received in evidence.)

Q. (By Mr. Boettcher): Is there anything on this Exhibit 17 to indicate where that enlargement of the peripheral groove or recess is?

A. Yes, there is.

Q. What is it?

A. It takes the form of an arrow which points to the corner at which the recess is.

Q. Now, showing you again the copy of the patent in suit, is that illustrated in the patent?

A. That is the same arrow which shows in Figure 1 on the patent.

Mr. Boettcher: I have another plastic lid I would like to have marked for identification as Plaintiff's Exhibit 18.

(The lid referred to was marked Plaintiff's Exhibit 18 for identification.)

(Testimony of William J. Poole.)

Q. (By Mr. Boettcher): Mr. Poole, I show you a plastic lid marked for identification as Plaintiff's Exhibit 18, and ask you if you can identify it.

A. Yes, sir.

Q. What is it? [53]

A. This is a slightly later model than Exhibit 17.

The Court: May I have 17, please?

The Witness: In that it contains the lettering which was added as the next step after the initial run, which is——

Q. (By Mr. Boettcher): Exhibit 17?

A. Exhibit 17.

The Court: In other respects is it the same as 17?

The Witness: Yes, it is, sir.

Mr. Boettcher: I offer the plastic lid, marked for identification as Plaintiff's Exhibit 18, as Plaintiff's Exhibit 18.

The Court: Received.

(The lid heretofore marked Plaintiff's Exhibit 18 was received in evidence.)

Mr. Boettcher: I have here a print that I ask to have marked for identification as Plaintiff's Exhibit 19.

(The print referred to was marked Plaintiff's Exhibit 19 for identification.)

Q. (By Mr. Boettcher): Mr. Poole, I now show you a print, a print of a shop drawing marked for identification Plaintiff's Exhibit 19, and I ask you if you will tell us what that is.

A. This is a print of a proposed change, that is, the next step beyond the style of molding which is

(Testimony of William J. Poole.)

shown in Exhibit 18. It is dated 10-27-49, and involves the use of [54] the enlarged recess at all four corners of the lid. This recess now taking a triangular shape instead of a rectangle.

Mr. Boettcher: I offer in evidence the print, marked for identification Plaintiff's Exhibit 19, as Plaintiff's Exhibit 19.

The Court: Received.

(The print heretofore marked Plaintiff's Exhibit 19 was received in evidence.)

Q. (By Mr. Boettcher): I observe, Mr. Poole, that this print, Plaintiff's Exhibit 19, is dated October 27, 1949. A. Yes, sir.

Q. And, as I understand it, this was a further idea, is that correct? A. Yes, sir.

Q. Now, have you any idea how many lids of the immediately preceding type were marketed in 1948?

A. Yes, I do.

Q. State what it is, to the best of your recollection.

A. In 1948, which was the year in which we conducted the more or less market survey, we sold only 100,000 units.

Q. And can you state approximately how many were sold of that type in 1949?

Mr. Boettcher: Let the record show that the witness has taken a paper from his pocket to refresh his recollection.

The Witness: Our sales figures for 1949 show approximately [55] 13,500,000.

Q. (By Mr. Boettcher): When you say "units"

(Testimony of William J. Poole.)

does that mean X number of cartons and Y number of lids and your thirteen million is the sum of those two, or what is it?

A. No. This indicates 13,500,000 cartons and 13,500,000 lids.

Q. That is 1949?            A. Yes, sir.

Q. Did that particular type that you began selling in 1948 continue in 1949?            A. Yes, it did.

Q. Can you tell us approximately how many cartons and lids were sold of that type in 1950?

A. Approximately 11,000,000.

Q. Then I take it that the type that had the triangular enlargement at each corner, as indicated in this print, Plaintiff's Exhibit 19, did not come into vogue until when?

A. We started selling that construction in 1950. All cartons and lids prior to shipments in 1950 were of the initial construction, which had the arrow recessed at only one corner and the rectangular rather than triangular recess.

Q. What is that figure for 1950?

A. 11,000,000.

Q. What is the figure for 1951?

A. 12,500,000. [56]

Q. What is the figure for 1952?

A. 16,600,000.

Q. What is the figure for 1953?

A. 15,100,000.

Mr. Boettcher: I now have a carton that I would like marked for identification as Plaintiff's Exhibit 20.

(Testimony of William J. Poole.)

(The carton referred to was marked Plaintiff's Exhibit 20 for identification.)

Q. (By Mr. Boettcher): Mr. Poole, I show you a carton marked for identification as Plaintiff's Exhibit 20, and I ask you if you will tell me what it is.

A. This is substantially the same as the carton which we started selling in 1950, with the glue flap cut off at a 45-degree angle to correspond to the triangular recess in the lid, which was developed at that time.

Q. I observe the patent number appears on the bottom of this particular carton, and the date is 1953. That is, the date of the patent is 1953, so that must be a carton that itself was as late as that or later? A. That is correct.

Q. But the cartons that were used in 1950 and '51 and '52 were the same, is that right?

A. Were substantially the same as that package.

Mr. Boettcher: I offer this carton, marked for identification Plaintiff's Exhibit 20, as Plaintiff's Exhibit 20. [57]

The Court: Received.

(The carton heretofore marked Plaintiff's Exhibit 20 was received in evidence.)

Q. (By Mr. Boettcher): Do you know when the Container Corporation began placing the patent number on the carton?

A. I believe that that started with the first of our production for 1954 sales.

Q. And that patent number is applied to the car-

(Testimony of William J. Poole.)

ton by the ordinary process of printing, is that right? A. Yes, it is.

Q. Up to that time you hadn't put the patent marking itself on the lids? A. No, sir.

Q. Why?

A. Well, up to that time—may I refresh my memory on the exact date of issue of the patent?

Q. The date of issue is in 1953.

A. Well, at the time of issue of the patent, of course, there was a substantial stock of already fabricated lids. Also, there were several sets of quite expensive molds which had been made to manufacture these lids in large quantities. And until the normal life of these molds was realized we did not wish to destroy them, because of the investment.

Mr. Boettcher: I have here another plastic lid which I ask to have marked for identification Plaintiff's Exhibit 21. [58]

(The lid referred to was marked Plaintiff's Exhibit 21 for identification.)

Q. (By Mr. Boettcher): Mr. Poole, I now show you a plastic lid marked for identification Plaintiff's Exhibit No. 21, and ask you if you will please tell us what that is.

A. This is a lid which was manufactured from the revised molds in which we had incorporated the triangular recess in each corner, as opposed to the single rectangular recess in one corner.

Q. That lid has no arrow on it?

A. This lid has no arrow, no, sir.



(Testimony of William J. Poole.)

Mr. Boettcher: I offer in evidence the plastic lid, marked for identification Plaintiff's Exhibit 21, as Plaintiff's Exhibit 21.

The Court: Received.

(The lid heretofore marked Plaintiff's Exhibit 21 was received in evidence.)

Q. (By Mr. Boettcher): Why is there no arrow on Exhibit 21?

A. Because of the fact that there is a recess in each of the four corners, which is triangular, and the fact that the glue flap at the top of the manufacturer's joint had been cut away at a 45-degree angle, thus eliminating the necessity for registering any particular corner of the lid with any particular corner of the carton body. [59]

Q. By cutting the flap away at a 45-degree angle at the top you were referring to the flap as shown in Exhibit 20, is that right?

A. That is correct.

Q. So that the housewife can have the lid relative to the carton either at zero or at 90 degrees or at 180 degrees or 270, is that correct?

A. That is correct.

Mr. Boettcher: Take the witness. Direct examination is closed.

The Court: Would you rather wait until tomorrow for your cross examination?

Mr. Russell: Yes, your Honor. In fact, what I may do, to simplify the matters, I would prefer to wait until tomorrow to cross examine.

For the benefit of counsel, I would like to intro-

duce what exhibits I have; for purposes of the record, I would like to use them in connection with the witness.

The Court: All right.

Mr. Russell: Heretofore, your Honor, we have already marked as Defendant's Exhibits A through D, inclusive, in connection with the motion for summary judgment, various patents.

I would like to include Defendant's Exhibit C in connection with the motion for summary judgment as Defendant's [60] Exhibit A. One moment, please.

The Court: C on the motion for summary judgment will become in this proceeding—

Mr. Russell: Perhaps I am in error. Perhaps you can advise me. Did you introduce in evidence the patent to Sidebotham, No. 2,139,626?

Mr. Boettcher: You mean on the motion—

Mr. Russell: No, as of today, as being one of the file wrappers in connection with the patent.

Mr. Boettcher: Yes, it is.

Mr. Russell: That will dispense with that. I would like to offer Defendant's Exhibit A marked for identification, the file wrapper and contents of Patent No. 2,392,959, granted January 15, 1946, to Raymond H. Van Saun.

Mr. Boettcher: I object to the exhibit as immaterial to this case.

Mr. Russell: I believe the exhibit is material, your Honor, because we intend to use the file history of the patents to Van Saun.

The Court: What is the foundation for these

exhibits? I think it is material if it is properly authenticated.

Mr. Russell: It is a certified copy, your Honor, of the file wrapper and contents of the United States Patent Office in connection with the Van Saun patent.

The Court: You are contending it is prior art?

Mr. Russell: Yes, your Honor.

Mr. Boettcher: I don't see how——

The Court: We will have to examine it to see if it is.

Mr. Boettcher: The Sidebotham patent may be of the prior art, but the file history of the application which led to the patent is certainly not prior art.

Mr. Russell: I may add, your Honor, the patent to Van Saun was a very pertinent reference, in our opinion, that was not cited by the Patent Office Examiner.

The Court: Counsel's point, as I get it, is that while the patent would be evidence, the file wrapper itself is simply relating the history of the proceedings in the Patent Office.

Mr. Russell: Which is very important on the question of whether Mr. Poole is, in fact, the original inventor of the concept of the patent now in issue.

The Court: I will take that one under advisement and sleep on it overnight.

Mr. Boettcher: Shall I say any more on it for the moment? The point is the date of the Side-

botham patent is adequate so far as what it represents is concerned. Is that not right?

Mr. Russell: Perhaps Mr. Boettcher or I may be mistaken. This is not the Sidebotham file history. This is the Van Saun file history. [62]

Mr. Boettcher: I probably misspoke the word. What is the date of the Van Saun patent?

Mr. Russell: The Van Saun patent was issued January 15, 1946.

The Court: This point as to whether the history is contained in that file wrapper is admissible. What is the literature on it? I have never had that question raised here, but it certainly must have come up in some court. What have they been holding?

Mr. Boettcher: The point, your Honor, is that the Van Saun patent issued on January 15, 1946; the patent in suit was filed on May 10, 1948.

Now, this Van Saun issue date is more than two years prior to the Poole patent in suit, filing date. Therefore, Van Saun is of the prior art,—

Mr. Russell: Certainly is.

Mr. Boettcher: —standing *my* itself. Its pertinency is another story. And it speaks for itself on its face as to that. As to that, apparently, my adversary and I are going to disagree. I don't see that the file history, that which preceded the issue of the Van Saun patent can possibly make any contribution material here.

The Court: What do Walker and the other writers on this subject say about it?

Mr. Boettcher: I never heard it suggested before. [63]

The Court: Have you?

Mr. Russell: Not in Walker, your Honor.

The Court: Anyone else?

Mr. Russell: Well, no.

The Court: Tenth Circuit or some such?

Mr. Russell: No. It is a matter of procedure, I believe, to be well recognized, that anything that would tend to show that the alleged inventor is not, in fact, the original inventor is admissible as evidence. And this is well set forth in the file history of the patent to Van Saun, the application, of course, which was handled by patent counsel for the plaintiff in this case.

It is very important. It goes to knowledge of the plaintiff as to who was the inventor, and also the fact that Mr. Van Saun was the inventor. That is our position, and that is what we intend to prove by use of that file history.

Mr. Boettcher: If it is your contention that Van Saun is a prior inventor, prior to Poole, of the subject matter of the patent in suit, firstly you have to plead it in order to present it in the evidence.

Mr. Russell: The patent to Van Saun was noticed under Title 35.

Mr. Boettcher: But that is as a publication, that is as a patent,—

Mr. Russell: I submit—— [64]

Mr. Boettcher: —and not evidence of prior invention. That is another story.

Mr. Russell: I submit the file history is part and parcel of the patent issued. It is a public record.

The Court: Unless you are able to cite me to

some authority which I can read here in a matter of a few moments, I will have to do individual research and give further consideration to it.

So if that is the state of the case, we might as well recess it until tomorrow.

Mr. Russell: May I mark a few other items for identification, your Honor?

The Court: Oh, yes. I will take the offer of that file wrapper under advisement. What is its number?

The Clerk: Defendant's A.

Mr. Russell: Defendant's A marked for identification.

(The document referred to was marked Defendant's Exhibit A for identification.)

Mr. Russell: Next in order, your Honor, is a prior art book which was lodged with your Honor in chambers, together with a memorandum pursuant to the local Rule 12. This prior art book contains the seven prior art patents that we noticed under Title 35.

I would like to have that marked for identification as Defendant's Exhibit B, and I would like to offer the prior art [65] book in evidence at this time.

The Court: Any objection to it?

Mr. Boettcher: What is the number? I have a copy of it.

Mr. Russell: I submitted a copy to Mr. Boettcher, your Honor, before the trial.

Mr. Boettcher: Yes, I have a copy.

The Court: Received.

Mr. Boettcher: No objection.

(The document referred to was marked Defendant's Exhibit B and was received in evidence.)

Mr. Russell: I also have——

Mr. Boettcher: Just a moment. I haven't looked at it. If it is prior art, that is all right. But let me look over the patents in it.

The Court: Are you referring to B?

Mr. Russell: Yes, Defendant's Exhibit B, your Honor. I may state that the patents as set forth in Defendant's Exhibit B are soft copies of each and every one of the patents noticed, pursuant to Title 35.

Mr. Boettcher: I have no objection, from the standpoint of their not being certified. But I do object to this being called prior art patents, because the Hill patent which issued in 1952, after the application for the patent in suit was filed, is not prior art.

Mr. Russell: To accommodate them, your Honor, may the [66] clerk delete the words "Prior Art" and leave the title as "Patents?"

The Court: Yes, do that, Mr. Clerk.

Mr. Boettcher: I have no objection to that, so long as we don't forget that this one is not a prior art patent.

Mr. Russell: That is a point to be taken care of——

The Court: That is something to be handled in your argument.

Mr. Russell: ——in due course. I have here a piece of paper with a drawing marked "Sketch 1,"

a copy of which was submitted in our memorandum, pursuant to local Rule 12.

I would like to mark this as Defendant's Exhibit C for identification.

Mr. Boettcher: No objection.

The Court: Received.

(The document referred to was marked Defendant's Exhibit C and was received in evidence.)

Mr. Russell: And also Defendant's Exhibit D for identification, which is marked "Sketch No. 2," which is very comparable in nature to Sketch No. 1.

Mr. Boettcher: No objection, assuming it is part of argument.

Mr. Russell: Very well.

The Clerk: Defendant's D.

(The document referred to was marked Defendant's Exhibit D for identification.) [67]

Mr. Russell: I would like to offer them into evidence, if I may.

The Court: Received.

(The document heretofore marked Defendant's Exhibit D was received in evidence.)

Mr. Russell: I have here the cover folder of a publication entitled "Locker Management", issue of June 1951, comprising two sheets, folded one upon the other. I would like to mark that as Defendant's Exhibit E.

(The document referred to was marked Defendant's Exhibit E for identification.)

Mr. Boettcher: No objection.



The Court: It is simply being marked for identification.

Mr. Russell: I would like to offer it, if I may, if counsel has no objection.

The Court: Received into evidence.

(The document heretofore marked Defendant's Exhibit E was received in evidence.)

Mr. Russell: The next defendant's exhibit purports to be an advertisement by Container Corporation of America advertising Vapocan. I would like to mark that as Defendant's Exhibit F.

(The advertisement referred to was marked Defendant's Exhibit F for identification.)

Mr. Boettcher: I don't know anything about that one. [68]

Mr. Russell: I don't either, your Honor.

The Court: Well, it is just being marked for identification now.

Mr. Boettcher: You are not offering it now?

Mr. Russell: Not at this time.

Mr. Boettcher: That has been offered, has it not (indicating)?

Mr. Russell: Yes, it has.

Thank you, your Honor.

The Court: The further trial of this case is recessed until tomorrow morning at 10:00 o'clock. The court until tomorrow at 9:00.

(Whereupon, at 4:40 o'clock p.m., Thursday, May 3, 1956, an adjournment was taken to Friday, May 4, 1956, at 10:00 o'clock a.m.) [69]

Friday, May 4, 1956. 10:40 a.m.

The Court: Since we were unable to convene at 10:00 because of the jury trial, if counsel desire a recess let me know. Otherwise, I will sit through until exactly 12:30 because I know you wish to get back to your bailiwick.

Mr. Boettcher: I would like to, but I will stay as long as necessary.

The Court: If we can finish today, well and good. I would take a short noon recess except I made a luncheon engagement some time ago and I want to keep it. If you want a recess, let me know. Otherwise, we will sit until 12:30.

Mr. Russell: Yesterday you recall, your Honor, we discussed the propriety of admitting the file wrapper of the patent to Van Saun into evidence. I have researched the subject, and I would like to present the matter to the court, if you so desire, at this time.

The Court: Yes.

Mr. Russell: Initially, your Honor, the Answer by the defendant sets forth various affirmative defenses directed to showing invalidity of the patent in suit. And I call your attention particularly to affirmative defense Paragraph V of the Answer, which states that:

“The alleged inventions or discoveries claimed in Letters Patent No. 2,638,261 were not patentable [71] to the alleged inventor named therein, under the provisions of Section 4886 of the Revised Statutes,” and also subject to Title 35, United States Code 1952, Section 102.

Now, Section 102, your Honor, Title 35, provides conditions for patentability, novelty and loss of right to a patent. Section 102 states, and I am quoting now in part:

“A person shall be entitled to a patent unless:

“(a) The invention was known or used by others in this country.”

Now, referring to the Van Saun file wrapper, it is my position here to show, by means of that file wrapper, it was known to Mr. Van Saun or known to others before it was conceived of by Mr. Poole.

Secondly, Section 102 of Title 35 states:

“The invention was described in a patent granted on an application for patent by another filed in the United States Patent Office before the invention thereof by the applicant for patents.”

Now, note this is section (e) from Section 102 of Title 35:

“\* \* \* was described in a patent granted on an application for patent.”

Subsection (f) of Title 35, 102, further provides:

“He did not himself invent the subject matter [72] sought to be patented.”

It is our position that Mr. Poole did not invent the subject matter sought to be patented because Mr. Van Saun did.

And subsection (g):

“Before applicant’s invention thereof, the invention was made in this country by another who had not abandoned, suppressed or concealed it.”

Mr. Van Saun didn’t abandon it. He may have abandoned his claims, but he didn’t abandon the

subject matter. He didn't suppress it. He didn't conceal it because the file wrapper is a public record in the United States Patent Office.

Further, in our affirmative defenses, Paragraph VII, we assert all the claims are invalid because prior to any invention or discovery by——

The Court: Are you asserting a motion to dismiss now?

Mr. Russell: No, your Honor. I am setting up the reasons that—our Answer sets forth reasons why we believe the Poole patent to be invalid. I can shorten this.

The Court: But this is not the time for argument of the case, so I don't think we should argue further unless something has occurred in the case which necessitates or makes appropriate an immediate dismissal without any question.

So let's get on with the evidence. I took under submission yesterday the question of whether Defendant's A should be admitted. [73]

Mr. Russell: Yes, your Honor.

The Court: I have decided that patents are not the invention. Of course, it wasn't me that decided that. That is old law. I have become reapprised of the consciousness of it. The patent is not the invention. The letters patent create a monopoly in the inventor, and the letters patent don't just spring into existence. They are the culmination of a process which begins long before the Patent Office hears of it, and it is prosecuted through the Patent Office, and I believe when the letters patent are received into evidence that, in view of the public interest in these matters, inasmuch as a patent does

create a monopoly, that the file wrapper which is the official government history of that patent is admissible.

Defendant's A is admitted.

(The document heretofore marked Defendant's Exhibit A was received in evidence.)

The Court: I don't want to have the case argued now. I want to get in the evidence, and to do so without undue delay, so that counsel who has a commitment in the East the first of the week can get to it. And then you may either brief it or you may return at a subsequent date for argument.

Mr. Russell: Thank you, your Honor.

Mr. Boettcher: May I be heard on this point for just a moment? [74]

The Court: Well, I would rather take evidence. I am not going to decide the point now.

Mr. Boettcher: The question before us, as I understand it, your Honor, is whether or not this Van Saun file history shall be received in evidence.

The Court: I have received it. Now, if I was in error on that, you make a motion to strike and I will consider that during this period the case is under submission.

Mr. Boettcher: I understand it isn't necessary to take exceptions.

The Court: I understand it is not, either. But I recognize your action here as an exception and the exception is noted.

Mr. Boettcher: And I shall be entitled to argue at the final hearing whether or not this is acceptable?

The Court: You certainly will. And you can brief it, too, if you want to.

Mr. Boettcher: Yes, your Honor.

Mr. Russell: I believe, your Honor, that Mr. Poole is now available for cross examination.

The Court: Yes. Unless counsel who called him had found something he overlooked?

Had you finished your direct?

Mr. Boettcher: Yes, your Honor.

Mr. Russell: Perhaps, in the interest of saving time, [75] if we may consider my interrogation of Mr. Poole as cross examination, as well as that of an adverse witness, under Rule 43(b)?

The Court: It serves the same purpose, doesn't it?

Mr. Russell: Yes, your Honor.

Mr. Boettcher: In the event that he asks questions not founded on the direct examination, he is making the witness his own, and I trust it will not be necessary for me to make objections or make any remarks to see that it falls in one category or the other.

The Court: Let's see. He says he wants to call him as an adverse witness. I first saw no objection to his doing that, even if he went beyond the scope of your questioning.

However, you are not agreeable to it and that brings to mind the query, is this man an adverse witness within the meaning of the Rule? Is he?

Mr. Russell: I sincerely believe he is, your Honor.

The Court: Why?

Mr. Russell: He is an employee of the plain-

tiff corporation. He is also the inventor, alleged inventor of the patent in suit.

Mr. Boettcher: I accept that statement. I think that he has a right to call him as an adverse witness——

The Court: All right.

Mr. Boettcher: ——and to examine him as such. I simply [76] don't want to make objections as he goes along. I want to facilitate the examination and if a question is beyond the scope of the direct, I want either now or later to be able to so regard it and to have him bound by the answer.

The Court: All right. In the light of that, you had better call him as an adverse witness for your additional matter when you are presenting your own case.

Mr. Russell: Very well, your Honor.

WILLIAM J. POOLE

called as a witness on behalf of the plaintiff, having been previously duly sworn, resumed the stand and testified further as follows:

Cross Examination

Q. (By Mr. Russell): Mr. Poole, you became the head of the frozen food division of the plaintiff corporation January 1946, is that correct?

A. That is correct.

Q. And you have maintained that capacity to this time?           A. No, sir, I have not.

Q. You had an interim where you were not employed by the plaintiff?           A. No, sir.

(Testimony of William J. Poole.)

Q. Would you then explain to me, please, your capacity with the corporation at this time? [77]

A. I am manager of beer package sales, 35th Street plant, folding carton plant in Chicago.

Q. That is not the frozen food division then?

A. No, sir, it is not.

Q. However, you have been employed continuously by the plaintiff since 1946?      A. Yes.

Q. Now, Mr. Poole, although you believe yourself to be the first and original inventor of the patent in suit, which is Plaintiff's Exhibit 3, if you were presented with evidence and facts to show to the contrary, would you admit that you were not the inventor?

Mr. Boettcher: I object to that.

The Court: That is argumentative. Sustained.

Q. (By Mr. Russell): Referring, Mr. Poole, to Plaintiff's Exhibit 16, which I hand to you, on what date—and be as accurate as you can—did that physical embodiment, Plaintiff's Exhibit 16, come into existence?

A. This particular carton, may I ask?

Q. Yes.

A. I wouldn't be able to pin down an exact date, as to when this particular sample carton was manufactured. I can give you a general date. This carton was produced during our experimental work on this type of package early in 1947.

Q. Now, let's not refer to the particular Exhibit [78] No. 16 in front of you. Let's say the first carton of that type, when did it come into existence?

A. To my knowledge?



(Testimony of William J. Poole.)

Q. Yes.

A. That was again early in 1947.

Q. Now, early 1947, could you say March of 1947?

A. I don't think I could pin down an exact date. I can say it was prior to May of 1947.

Mr. Russell: May I mark for identification, your Honor, what appears to be a large milk container, and this was produced by Mr. Boettcher, counsel for the plaintiff. I would like to mark it Plaintiff's Exhibit 22-B for identification.

Mr. Boettcher: This is as arranged between us?

Mr. Russell: That is correct, counsel.

Clerk: 22-B.

(The container referred to was marked Plaintiff's Exhibit 22-B for identification.)

Q. (By Mr. Russell): I hand you, Mr. Poole, Plaintiff's Exhibit 22-B for identification, and ask you if you have been at some time prior to conception of your invention familiar with that construction.

A. No, not this construction.

Q. You had never seen a construction such as that before May of 1948? [79]

A. No, not this complete construction (indicating).

Q. Did you ever see a construction similar to it?

A. Yes.

Q. Will you explain the construction?

A. Well, I can liken it to the bottom of a shoe box, since it is basically a setup container.

(Testimony of William J. Poole.)

The Court: Let's see what you mean by "shoe box". Are you referring to the type in which shoes are contained in the retail stores?

The Witness: That is right. It basically has an open top. It is formed of four sides and a solid bottom.

Q. (By Mr. Russell): And the shoe box you refer to likewise has a lap joint joining the sides together?      A. Not necessarily.

Q. Did you know of a particular shoe box that did have a lap joint?

A. I would say that is possible as a construction, yes.

The Court: Lap joints as such are old, aren't they?

The Witness: Oh, yes.

The Court: It isn't claimed that the lap joint is the essence of the invention here?

Mr. Russell: I am not certain of that fact, your Honor.

Mr. Boettcher: I pointed out in my opening statement, if the court please, that the carton in and of itself is old, that is, the carton of the patent in suit; that is, the [80] carton body.

The Court: You are claiming a combination of old elements?

Mr. Boettcher: I am claiming the newness of the cover and the newness of the combination between that new cover and the carton body.

The Court: Then the antiquity of lap joints need not be inquired into.

(Testimony of William J. Poole.)

Mr. Russell: Thank you, your Honor.

Q. (By Mr. Russell): Let us refer, Mr. Poole, to Plaintiff's Exhibit No. 17, which I understand to be the first embodiment of the plastic lid construction of the plaintiff.

How many of those particular plastic lids were made?

A. I can only give you an estimate based on the figures which were brought out in yesterday's questioning. At that time I indicated that we had purchased and sold in 1948 100,000, and in 1949 13,500,000.

Q. Referring now, Mr. Poole, to plaintiff's carton, Plaintiff's Exhibit No. 20, that is a commercial embodiment of the plaintiff at the present time, is it not?

A. That is correct.

Q. Now, note the lap joint, that is, where the tab extends inside and is adhesively secured to the adjacent side wall. Does that lap joint extend to the upper edge of the box?

A. Only at the corner. [81]

Q. Just at the point, isn't that correct?

A. That is correct.

Q. So the entire lap joint does not extend to the upper edge of the container.

A. No, sir, the entire lap joint does not.

Q. Now, referring to your patent, Plaintiff's Exhibit 3,—

Mr. Boettcher: You can use my copy if you like.

Mr. Russell: Very well. Counsel has provided me with a soft copy of the patent in suit, which I

(Testimony of William J. Poole.)

will hand to Mr. Poole in lieu of the certified copy of the original.

Q. (By Mr. Russell): Referring to your patent, Mr. Poole, does the lap joint as shown in its entirety extend to the upper edge of the container?

A. Actually, studying the drawing, it depends upon where the cross section is taken.

Q. I draw your attention to the fact the cross section of Fig. 4 is taken along the line 4—4 of Figure 1.

Would you not say, Mr. Poole, that the construction as shown in your patent, carton construction, is substantially identical to the structure of Plaintiff's Exhibit 16?

A. Definitely it is. I was only trying to ascertain from the drawing itself a correct answer to your question.

Q. Thank you. I now hand you Defendant's Exhibit C, which is identified as "Sketch 1", and ask you if the [82] construction of the carton illustrated in Fig. A is a fair representation of your carton construction.

Mr. Boettcher: I object to that.

The Court: Overruled. The witness will look it over.

You look it over and I will read what my secretary has handed me. You don't have to answer it right off.

Mr. Boettcher: May I be heard?

The Court: Yes.

Mr. Boettcher: I made a point yesterday after-

(Testimony of William J. Poole.)

noon, when this particular drawing was submitted, now submitted to the witness, when it was offered, that I understood this was to be only for the purposes of argument.

Now, I am perfectly willing to have Mr. Poole answer that question, but as my adversary's witness.

The Court: Do you want to accept that condition?

Mr. Russell: Yes, your Honor.

The Court: All right. I don't think it is embraced within cross examination, as such.

Mr. Russell: Very well, your Honor.

The Court: Answer the question.

The Witness: May I have the question?

Mr. Russell: Will the reporter please read the question?

(The question was read.)

The Court: If it isn't, you may point out wherein it differs. [83]

The Witness: In general, yes. However, the illustration doesn't go far enough to describe the entire carton. This could be a cut-away end of any glued sleeve. However, the method of gluing or the method of forming the manufacturer's joint, having an essentially square cross section and a glue lap which is adhered to the fourth side, is in general the same.

Q. (By Mr. Russell): Now, referring, Mr. Poole, to the physical embodiments of Plaintiff's Exhibit No. 16, which is a carton, and Plaintiff's

(Testimony of William J. Poole.)

Exhibit No. 20, which is the commercial embodiment, there is a difference between the two constructions, is there not?      A. Yes, there is.

The Court: You are referring to more than the difference in color, aren't you?

The Witness: Oh, definitely.

The Court: What is the difference?

The Witness: There are minor differences of construction, your Honor. The carton, Exhibit 20, has a slightly greater taper, and in Exhibit 20 you will notice that the glue lap has been cut away at approximately a 45-degree angle, where in this carton, Exhibit 16, the glue lap is full to the top of the container.

The Court: Does that make any difference in the function of the containers? [84]

The Witness: It makes a difference in the ability to effect a proper seal with a given construction of cover.

Q. (By Mr. Russell): I hand you, Mr. Poole, Plaintiff's Exhibit No. 21, and do I understand correctly that that is the commercial embodiment of the plastic lid manufactured by Container Corporation of America?      A. That is, today?

Q. Yes.      A. Yes, it is.

Q. Now, the plastic lid, Exhibit 21, has a peripheral and tapering groove or recess, does it not?

A. Yes, it does, around the entire peripheral length.

Q. It has an offset or increased width in all four corners, does it not?      A. That is correct.

(Testimony of William J. Poole.)

Q. Now, you may at this time apply that particular lid, Exhibit No. 21, which is a commercial embodiment, the lid, to the commercial embodiment of the lid, Plaintiff's No. 20, which is before you, and you would have the small point of the lap joint of the carton extending into only one of those offsets, isn't that correct?

A. That is correct.

Q. What extends into the other offsets where there is no lap joint, if anything?

A. Nothing. [85]

Q. So at the other three corners there is nothing at all to fill in the increased width of the groove?

A. That is correct.

Q. Now, without the double thickness wall at the three corners referred to there cannot be any frictional engagement between the lid and the carton wall, is that correct?

A. No, I would say that is not correct.

Q. Will you kindly explain that, Mr. Poole, in view of your earlier statement there was nothing in the offset or the increased groove?

A. Perhaps I should qualify the previous answer, that there was no element of the carton, the paperboard carton, in the groove. However, this lid was so constructed as to come up to a very fine point of contact with the corner, with each—

Q. Then it is a point of contact that effects the seal, isn't that true?

A. Yes, that is right.

Q. It makes no difference then whether your

(Testimony of William J. Poole.)

container has a lap joint or not, it will still seal, isn't that true?      A. No, sir, it is not.

Q. Then in the three corners where you have no lap joint and yet the lid has offsets or increased width, why does it seal?

A. Well, perhaps I mistook your question. [86] You said without a lap joint——

Q. Yes.

A. ——it can be sealed. Without a lap joint we do not have a four-sided carton which is joined.

The Court: You might under some of these processes where things are cast?

The Witness: That is possible, yes.

Q. (By Mr. Russell): So actually, then, if you had a carton that did not have a lap joint at all, perfectly equal width around the entire periphery of the carton, the commercial embodiment of the plaintiff's lid, Exhibit 21, would seal such a carton?

A. If it were possible to make such a paperboard carton, yes.

The Court: The carton wouldn't necessarily be paperboard, would it?

The Witness: Folding cartons of this nature are not ordinarily made out of other materials, your Honor. I mean, it would be impractical to make up such a container as this from metal, for instance.

The Court: Do I take it that the necessity of having, or, the advantages of having collapsible cartons is so they may be shipped flat? Is that an important factor here?

The Witness: It is an important factor in the



(Testimony of William J. Poole.)

general folding carton industry. However, in this case this carton is [87] shipped—it takes the form of what we call a setup or assembled container.

The Court: I have seen cartons—they were not for frozen foods—but I have seen cartons similar to these made apparently of a plastic of some kind, in which there was no lap joint, but it appeared the whole thing had perhaps been sprayed on a mold or poured over a mold of some kind so it came out without any lap joint and without any irregularity or greater density at one point than at another.

The Witness: That is correct. Such containers are available commercially. And where there is no lap joint, of course there is no necessity to provide a recess to accommodate it.

Mr. Russell: Your Honor please, your interrogation has raised a point respecting the particular configuration of shape of the carton commercially manufactured and sold by the plaintiff.

Q. (By Mr. Russell): Now, Mr. Poole, is there anything in the shape of your carton that is covered by your patent?

Mr. Boettcher: I object to that. The witness is not here as a patent expert. I don't know that he has ever read the claims.

The Court: Sustained. I shouldn't ask so many questions. My function is to resolve disputes, rather than create them. [88]

Mr. Russell: Very well, your Honor.

Q. (By Mr. Russell): Did you believe, Mr.

(Testimony of William J. Poole.)

Poole, or do you still believe that the feature of nesting of your cartons is an invention of yours?

A. Oh, no. Cartons have been nested for, I guess, as long as there have been setup packages.

Q. Now, referring to your lid, Mr. Poole,—correction. I would like to refer to your patent.

Mr. Boettcher: Here is a copy.

Q. (By Mr. Russell): The patent in suit.

Now, in the construction shown in your patent you show only one overset or increased width in the lid, isn't that correct?

A. That is correct.

Q: Now, it is true in the construction of your lid, as shown in your patent, that the rest of the groove is of uniform width for the remainder of its length?

A. That is correct.

Q. Now, referring to Plaintiff's Exhibit 21, which is the commercial embodiment of the plaintiff's lid, the groove is widened at more than one point, is it not?

A. Yes, it is.

Q. Now, if the commercial embodiment of Plaintiff's Exhibit No. 21 had only one offset, and then the remainder of the groove would have uniform width, would it not? [89]

A. If there was an offset in only one corner, yes, that is true.

Q. And the fact it has an offset in all four corners, the remainder of the groove is not of uniform width?

A. That is correct.

Mr. Russell: I would like to use these examples produced by the plaintiff, your Honor, and I would

(Testimony of William J. Poole.)

like to have Mr. Poole—it is impossible in this case, as they have holes in them.

May I produce some samples of the plaintiff's commercial embodiment? I would like to demonstrate something.

Mr. Boettcher: Certainly.

The Court: Look them over, counsel, and be sure they are what they purport to be.

Mr. Boettcher: I don't think there is any necessity, but I have done so, anyway.

The Court: We have to guard against inadvertence. We trust our friend, but we must guard against inadvertence.

Mr. Russell: I have here, your Honor, which I have had for some time, three containers and a lid. Here are two more.

Mr. Boettcher: You want to put water in those?

Mr. Russell: Yes. I want Mr. Poole to select any two—I want to put some water in the container and have Mr. Poole demonstrate the function of a housewife in sealing the two parts together.

The Court: The function of the device is the important thing.

Mr. Russell: And it functions properly, yes, your Honor.

The Witness: I would suggest these two (indicating). This one here has a damaged corner (indicating).

Q. (By Mr. Russell): Select any of those two.

A. These two (indicating).

(Testimony of William J. Poole.)

Q. Any one and any lid. There are several to choose from.

I have filled this container not quite halfway. I ask you, Mr. Poole, to kindly apply any of the lids you have before you to the container which contains the water.

The Court: By "lids" you mean lids embodying the structure——

Mr. Russell: Which we are talking about at the present time.

The Court: Yes.

Mr. Russell: I believe the lids before Mr. Poole do contain the offset in each corner, all four.

The Court: We all see that, but the record doesn't.

Mr. Russell: Thank you, your Honor.

The Witness: This lid is equivalent to Exhibit No. 21 (indicating).

Mr. Boettcher: Plaintiff's Exhibit 21.

The Witness: Plaintiff's Exhibit No. 21. [91]

Mr. Russell: May I approach the witness, your Honor?

The Court: Surely.

Q. (By Mr. Russell): Now, Mr. Poole, would you turn the carton on its side?

A. Just lay it on its side?

Q. As a normal housewife would when she places it into the freezer.

A. Well, I will turn it on its side, but that is not normal procedure, to stack this type of package in a freezer or locker in such a manner.

(Testimony of William J. Poole.)

Q. Will you kindly turn it on its side, in any event?      A. Yes.

Mr. Russell: Now, the witness has turned the container on its side.

Q. (By Mr. Russell): Now, I have taken a piece of yellow paper, Mr. Poole, and I have slipped it between the container lid and the wall of the container.

How far does the piece of yellow paper extend into that groove?

The Witness: He is using ordinary foolscap.

Q. (By Mr. Russell): It is more than halfway?

A. Yes, it is more than halfway.

Q. Is it three-quarters of the way?

A. I would say it probably is three-quarters of the way. Perhaps even—— [92]

Q. Let's do it again. The same is true just about of any position?      A. Yes.

Q. Close to the edge, the center and the other edge?      A. That is correct.

Mr. Boettcher: I think we ought to have the record show that you are putting this corner of the foolscap between the wall of the carton and the rim, let us say, of the lid, that being the top wall, right?

Mr. Russell: I didn't follow your statement there, Mr. Boettcher.

Mr. Boettcher: You just put the paper between the side wall of the——

Mr. Russell: The outer side wall of the container and into the groove of the lid.

(Testimony of William J. Poole.)

Mr. Boettcher: Yes. But now that side wall that you refer to is horizontal and at the top, is it not? In other words, the carton is lying on its side.

Mr. Russell: Yes.

Mr. Boettcher: And the wall you are now referring to is horizontal, is that not right?

Mr. Russell: Well, the wall is horizontal. The point I am getting at, and I believe Mr. Poole testified the paper went into the groove a substantial distance.

Mr. Boettcher: I am not arguing the point. I [93] simply want the record to show the fact, that is, that the wall you are referring to is a side wall, but it is now in horizontal position.

Mr. Russell: Yes.

Mr. Boettcher: That is all I want to know.

The Court: The container containing the water and with the embodiment of plaintiff's claimed invention, as I understand it, is lying on its side on a table before the witness.

Mr. Russell: That is correct, your Honor.

The Court: And so far as I can see no water is coming out.

Mr. Russell: Very well.

Q. (By Mr. Russell): Now, Mr. Poole, will you turn the container 90 degrees?

A. So it is upside down?

Q. Rotate it by its horizontal axis.

A. (Witness complies.)

Q. That is correct. I will use the same test I did before, taking a piece of yellow paper, and I

(Testimony of William J. Poole.)

slip it into the groove. It goes into the groove between the wall of the carton and the lid more than halfway, does it not?      A. Yes, it does.

Q. That is, at the center of the carton?

A. That is right.

Q. Over to the side of the carton? [94]

A. That is right.

Q. It goes in more than three-quarters of the way.

A. I would say about, perhaps a little more.

The Court: That is near the side, not at the exact——

Mr. Russell: Not at the exact side, no. Approximately halfway in from the corner of the carton.

The Court: Yes.

Mr. Russell: And the same thing on the opposite side.

Q. (By Mr. Russell): We are now approximately three-eighths of an inch from the corner of the carton?      A. Yes.

Q. And does it not extend more than halfway into the groove?      A. Yes, it does.

The Court: The court's observation—now, I am at a different angle than you are——

Mr. Russell: Yes.

The Court: ——*is* it appeared to me it went almost all the way.

Mr. Russell: Very well, your Honor.

The Court: If that isn't so, you might have him turn it the other way, so I can see better.

Mr. Russell: Well, I would like the witness then

(Testimony of William J. Poole.)

to rotate the carton 90 degrees more in the same direction.

The Witness: Almost lost our water. [95]

Mr. Russell: I will use the same test, your Honor.

Will the witness kindly turn the carton 90 degrees on its vertical axis, so the court may view the test I am about to make?

The Court: I don't know what you might be going into in the future, and since I made an observation and the water came out, I should make the observation at this juncture that some water has escaped, but not all of it.

Q. (By Mr. Russell): Using the yellow paper again, Mr. Poole, I will put it along the side of the container and into the groove. How far does it go in?

A. Oh, I would say approximately three-quarters of the way.

Q. And on one side, approximately one-half inch from the side of the carton, how far does it go in?

A. About the same, perhaps even a little more.

Q. On the other side, approximately one-half inch from the edge of the container?

A. Perhaps a little less, but roughly three-quarters of the way.

The Court: At some point you might have that paper you are using made a part of the record.

Mr. Russell: Yes, your Honor. In fact, I will do it at this time. I would like to mark it for identification as Defendant's exhibit. [96]



(Testimony of William J. Poole.)

The Clerk: G.

(The paper referred to was marked Defendant's Exhibit G for identification.)

The Court: That is the paper used in the demonstration.

Mr. Russell: That is correct, your Honor. If I may, your Honor, I would just as leave offer it in evidence.

The Court: Received.

(The paper heretofore marked Defendant's Exhibit G was received in evidence.)

Q. (By Mr. Russell): Now, in view of the demonstration, Mr. Poole, the wall of the carton, that is, Plaintiff's Exhibit No. 20, does not contact the side of the groove of the container lid for more than the depth of the groove, isn't that correct?

Mr. Russell: I perhaps had better rephrase that question, to put it positively, your Honor, if I may.

The Court: Yes.

Q. (By Mr. Russell): The container wall does not contact the side of the groove for a distance greater than the depth of the groove?

A. Which side of the groove, the inner surface of the outer flange, or is it the—

Q. The inner surface of the outer flange, yes.

A. The question is, it does not contact the carton, does not contact that inner surface of the outer flange of the [97] cover for a depth greater than the groove itself?

Q. Yes. A. That is correct.

Q. And the contact is less than the—let's say

(Testimony of William J. Poole.)

less than one-half of the depth of the groove, isn't that correct?

A. We have only proved that it is less than one-half of the depth of the outer flange, by your demonstration.

Q. Very well. To complete, Mr. Poole, would you again rotate the carton in the same direction, 90 degrees, still on its side? I note that the carton is leaking considerably at this time, is that correct?

A. It has lost water, yes, sir.

Mr. Boettcher: In order that this may be visualized by reading the record, let us say that the carton is lying on its side and that it is about a third full of water.

The Court: And the water which has leaked out has, in each instance, so far as I could observe, leaked out at the time it was being rotated, while in motion.

Mr. Russell: In order that your Honor's observation may be further confirmed, may I suggest that Mr. Poole lift the carton and place it in a position on the table where there is no water?

The Court: Mr. Bailiff, let's wipe such water as we have.

Mr. Russell: I note for the purposes of the record that Mr. Poole has again reaffirmed or compressed the lid onto the carton. [98]

Q. (By Mr. Russell): Now, would you kindly place it on the side? A. (Witness complies.)

Q. Again, Mr. Poole, using Defendant's Exhibit

(Testimony of William J. Poole.)

G, I have slipped the paper into the groove adjacent the side wall of the container.

Now, Mr. Poole, how far in does the paper go into the groove?

A. Well, from this demonstration it is impossible to tell, because you can't see the actual depth of the groove. You can only see the depth of the length of the outer flange, the groove being comprised of a shallower depth, as you can see.

Q. I am taking another corner of Defendant's Exhibit G. One corner has become rather damp. I will apply it once more between the wall and the groove.

You still say you cannot tell how far it goes into the groove?

A. I can only tell how far it penetrates under the flange, but that flange is deeper than the actual two-sided groove itself.

Q. The fact is you cannot ascertain because you can't see the groove?      A. That is right. [99]

Q. But you can see the groove in the embodiment in your hand, is that correct?

A. That is correct.

Q. Now, Mr. Poole, let us refer again to Plaintiff's Exhibit No. 21, which is the commercial embodiment of the plaintiff's lid. This is the embodiment with the offset in all four corners, is that correct?      A. That is correct.

Q. Is that construction your original conception?      A. Yes.

(Testimony of William J. Poole.)

Q. Did you conceive of the four-corner offset construction?      A. Yes.

Q. Did you ever file an application for patent covering a four-corner offset construction?

A. I don't believe so.

Q. Do you know whether anybody connected with the plaintiff has filed an application on that four-cornered offset construction?

A. No, I do not.

Mr. Russell: I would like to refer, your Honor, now to the art book entitled "Patents", Defendant's Exhibit B. Copy is in the hands of Mr. Boettcher, counsel for the plaintiff. And I hand Defendant's Exhibit B to Mr. Poole.

Mr. Boettcher: I might give warning, I am going to [100] object to this, but he hasn't opened it yet, so——

The Court: So you don't know what question he is going to ask.

Mr. Boettcher: I don't know what question he is going to ask.

The Court: Let's see. It might not be objectionable.

Q. (By Mr. Russell): Referring to tab 1, Mr. Poole, inside of Defendant's Exhibit B, turning to tab 1——

Mr. Boettcher: I object. That wasn't referred to on direct examination. He is not here as a patent expert. I don't know that he knows anything about that.

The Court: There is no question pending. I

(Testimony of William J. Poole.)

appreciate your being diligent, but I think you jumped the gun.

Mr. Boettcher: I am sorry.

Mr. Russell: Perhaps Mr. Boettcher is anticipating.

Q. (By Mr. Russell): Have you seen the patent to Drake before, identified in tab 1, the Drake Patent No. 1,325,930?

Mr. Boettcher: I say that is outside the scope of the direct.

The Court: Sustained. I will treat it as an objection, although the word "object" isn't in it.

Mr. Russell: In view of the objection, your Honor, I will have to go on to other subject matter, reserving the right to recall Mr. Poole in presentation of the defendant's case. [101]

The Court: All right. Of course, you can't make him an adverse witness, treat him as an adverse witness and an expert at the same time, as your expert.

If he comes on as an expert he would come on as your witness,—

Mr. Russell: I understand that.

The Court: —because he hasn't taken on the character of an expert in the testimony he has thus far given.

Q. (By Mr. Russell): Mr. Poole, you have testified concerning the number of commercial embodiments sold by the plaintiff in connection with various samples before you.

Mr. Poole, how much money has Container Cor-

(Testimony of William J. Poole.)

poration of America spent in advertising the so-called Vapocan?

A. I would have no idea, since I have nothing to do with the advertising department or their budgets or their appropriations.

Q. You wouldn't say they did not advertise considerably, would you?

A. No, sir. Advertising was done. As to the extent of it, however, it would only be a guess and I don't think that is what you are after here.

Q. Have you ever seen any advertisements of the Container Corporation of America respecting Vapocans? A. Oh, yes.

Q. In what publications or periodicals? [102]

A. Well, Locker Management is one. I believe you have an exhibit there (indicating).

Q. You are referring to Defendant's Exhibit E, which I hand you, noting page 2 on the inside?

A. Yes, sir.

Q. Is page 2 a full-page ad of Vapocan, covering the structure which is now in suit?

Mr. Boettcher: It is not for this witness—I object to that question. It is not for this witness to pass upon that which is covered by the patent in suit. So there is no misunderstanding, I thought I had better point that out.

In other words, it isn't for this witness to say what does or does not come under the patent. That is for us—on direct examination I confined myself to the facts as he knows them.

Mr. Russell: He is the inventor, your Honor.

(Testimony of William J. Poole.)

The Court: The objection is sustained. It appears to the court from this Exhibit E that this question and the questions which would follow a natural sequence, if this one be allowed, would call for this witness to interpret Exhibit E, which is an advertising brochure.

Mr. Russell: It is an advertisement brochure, your Honor, of the plaintiff, of which he is an employee.

The Court: Yes, but it has depictions of things other than the particular structure involved here. And I think that [103] it is for counsel to argue the contents of the documentary literature, rather than for the witness to do so.

Mr. Russell: Very well, your Honor.

Q. (By Mr. Russell): Mr. Poole, would you kindly lift the joined Plaintiff's Exhibits 20 and 21, which has been resting on its side for approximately ten minutes? Would you kindly lift it?

A. (Witness complies.)

Mr. Russell: I note considerable water dripping on the side. We shall now wipe it up with a rag.

The Court: It appears to be about two or three centimeters, cubic centimeters of water which had escaped during the time interval.

Mr. Russell: Very well.

The Court: If anyone disagrees with my estimates — they are only rough estimates — you may state it.

Mr. Russell: Well, perhaps we can look at the inside of the container, which I indicated, your

(Testimony of William J. Poole.)

Honor, was filled approximately halfway. It is slightly below the halfway mark at this time. I would say approximately three-eighths full, counsel?

Mr. Boettcher: I don't think I want to make an estimate. The point is that it was about a third full when it was lying on its side, and as you put it on its side now it is about the same. I don't think it is fair to you or to myself to ask me [104] to make an estimate.

Mr. Russell: Very well. I apologize.

Q. (By Mr. Russell): Do you know, Mr. Poole, whether or not the plaintiff Container Corporation of America makes display racks for the invention, subject matter here in suit?

A. We have built some display material, yes.

The Court: What do you mean by "display material"?

The Witness: Retail display stands for displaying the cartons for sale.

The Court: For sale to retail customers?

The Witness: In the locker plants, yes, sir.

Mr. Russell: If I may refer, your Honor, Mr. Poole to Defendant's Exhibit F for identification.

Mr. Boettcher: I am going to object to your even showing that to the witness. It has absolutely no authentication here.

Mr. Russell: Perhaps the witness can authenticate it.

Q. (By Mr. Russell): I will ask you——

Mr. Boettcher: For that purpose, I will withdraw my objection.



(Testimony of William J. Poole.)

Q. (By Mr. Russell): Have you ever seen a piece of paper such as that before (indicating)?

A. No, sir, frankly, I have not. None of the advertising that is done by my company is done in this crude a form.

Q. Have you ever seen a display rack of the type [105] exemplified on the right-hand side of that piece of paper, Defendant's Exhibit F for identification?

A. Yes, a display rack of that general nature. I couldn't actually identify this particular one, however.

Q. That is, would you say that could be or is a display rack manufactured by your company?

A. It could be, but I would have no way of identifying it positively.

Q. Do you know what the policy is with your company with respect to the sale, if any, of such display racks?      A. No, sir, I don't.

Q. You wouldn't know if they give them away, would you?      A. No, sir, I do not.

Q. They may give them away, isn't that true?

A. It is possible, but I am unable to answer in an affirmative or negative manner your direct question.

Q. I draw your attention to the statement on Defendant's Exhibit F, which states, "New Floor Merchandiser Free to the Retail Dealer". Does that refresh your recollection?

A. No, it does not. As I pointed out before, I

(Testimony of William J. Poole.)

cannot identify this as a Container Corporation of America advertisement.

Q. You recognize——

A. I would identify it as not being a product of our advertising department or of our advertising agency. [106]

Q. You would recognize, however, the display rack as depicted on Defendant's Exhibit F as a product of your company?

Mr. Boettcher: I think I will have to object——

The Witness: I would say a possible product.

Mr. Boettcher: ——to this line of examination. This is an utterly unauthenticated piece of paper being submitted to the witness, and he is carrying on an extensive examination of it with him.

The Court: I take it he is attacking commercial success.

Mr. Russell: Yes.

The Court: It is not contended that this is a Container Corporation of America publication, but he is asking him regarding the type of display rack there and the extent to which it is used. This is merely an orienting piece of literature. Objection overruled.

Q. (By Mr. Russell): Will you answer the question?

The Reporter: He answered the question. Just a minute, I will read the record.

(The record was read.)

Q. (By Mr. Russell): Would you have any

(Testimony of William J. Poole.)

idea, Mr. Poole, how much the plaintiff spends each year in manufacturing these display racks?

A. No, sir.

Q. Did you ever work in the plant where the [107] display racks were manufactured?

A. No, sir. Those are fabricated from corrugated box board which is manufactured at a different plant from which I make my headquarters.

Q. Have you ever seen any display racks made by your company?           A. Yes, sir.

Q. Where?

A. Samples of them at the 35th Street plant, where I do make my headquarters.

Q. Any quantity of them?           A. No, sir.

Q. You have no idea how many might have been made?

A. I have no idea. They may have been used extensively or not; I do not know.

Q. Have you ever seen them in retail stores?

A. No, sir, I have not.

The Court: Of course, the extent of offering is not a measure of the extent of acceptance, and the big factor in commercial success is that the object has achieved immediate acceptance by the consumer or user of it.

Mr. Russell: As a result, your Honor, of the invention, not as a result—

The Court: That is right.

Mr. Russell: —of judicious advertising. [108]

The Court: Yes, but whether or not—I had better not say any more.

(Testimony of William J. Poole.)

Q. (By Mr. Russell): Mr. Poole, what is the approximate ratio of sales of cartons to lids of your company?

A. To the best of my knowledge, it would be in a ratio of approximately 10 to 9.

Q. You sell more cartons than you do lids?

A. That is correct.

Q. Do you have any idea, Mr. Poole, what the profit is to the plaintiff on the sale of its cartons?

A. I would say, in answer to that, that the profits of Container Corporation of America on any given item, information about that is the property of my company and I am not in a position of policy which would permit me to divulge that information.

Mr. Russell: I believe it is of importance, your Honor.

The Court: I don't think that profit is important. An item might be commercially successful and a great number of them are vended, but still the profit would be quite small.

Mr. Russell: Perhaps I can rephrase the question then, your Honor, to keep it in terms of comparison rather than monetary figures.

The Court: All right.

Q. (By Mr. Russell): Mr. Poole, respecting the profit made by your company on cartons and the profit made on lids, [109] let's say carton as compared to lid, which item do you make the most profit on?

A. I would say that they were comparable.

(Testimony of William J. Poole.)

Q. You make no more profit on the carton than you do on the lid?

A. To the best of my knowledge, they are in the same general percentage area.

Q. This is based upon your knowledge at the present time of figures which apparently you do have, monetary figures of the profits of your company respecting both items?

A. I do not have monetary figures of my company respecting the profits on both items at this time. I do have figures on total unit sales.

Q. What is the retail price of lids sold by your company?

A. To the best of my knowledge, the combined unit sells at retail for nine and a half to ten cents.

The cost of each separate component being approximately one-half of that total figure.

Q. You sell lids separately, however, do you not?

A. Yes, when they are ordered as such.

Q. They are sold in quantities of four each, twenty each?

A. The retail unit packing happens to be either 10 or 20. [110]

Q. For a package of 10, what is the retail price?

A. I am not too sure what it is currently.

Q. What was it in 1953, '52?

A. About 50 cents, 49 cents, in that area.

Q. Has it ever been lower than 49 cents for a package of 10?

A. I don't believe so. However, there will be variations in different markets. Different types of

(Testimony of William J. Poole.)

outlets will require a lesser or greater profit markup. But I would say that figure was a fairly good general average.

Q. So, based upon that figure, Mr. Poole, each lid sells for about 4.9 cents?

A. I think it would be better to say approximately 5 cents, because there are, as I say, variations in the different markets; that should be close.

The Court: Container Corporation does not sell at retail, does it?

The Witness: No, sir, we do not.

Q. (By Mr. Russell): I refer now, Mr. Poole, to Plaintiff's Exhibit No. 12 in evidence, which purports to be an advertisement of Ree-Seal respecting plastic lids.

Are you familiar with the type of plastic lid illustrated in that advertisement?

Mr. Boettcher: I object. It is outside the scope of the direct. I didn't examine him about the accused lids. [111]

The Court: Sustained.

Q. (By Mr. Russell): Mr. Poole, do you know of any other concern that manufactures a plastic lid which you believe to be comparable to yours?

Mr. Boettcher: I object to that; outside of the scope of the direct.

The Court: Sustained.

Q. (By Mr. Russell): In the paperboard industry, Mr. Poole, is it unusual to make a run of, say, for example, a million boxes? A. Not at all.

Q. That is ordinary?

(Testimony of William J. Poole.)

A. That is common practice, yes.

Q. What would be an average run? I say "average". Let's say a continuous run, from start to stop.

A. An average run of what?

Q. Well, let's take a Meelie machine or a Sperry machine, where the fiberboard is fed in in stock form on one end and it feeds out on the other end cut and scored. What is an average run in quantity?

A. It is very difficult to answer the question categorically. It is not uncommon to see runs of 50,000 cartons and it is also not too uncommon to see runs of five million cartons. It depends on the item and the size of the cut.

Mr. Russell: I believe I will have to reserve the [112] rest, your Honor, for Mr. Poole, for putting on our case. So cross examination, I will release the witness.

The Court: How long do you think the presentation of your case will require, the defendant's case, exclusive of argument?

Mr. Russell: I believe, your Honor, that approximately half or three-quarters of an hour with Mr. Poole, if there are no ostensible objections. And for Mr. Comstock perhaps an hour, an hour and fifteen minutes.

The Court: Is that your evidentiary case?

Mr. Russell: Yes, your Honor.

The Court: How long will it take you to complete the evidence in your case?

Mr. Boettcher: First of all, let me say that there

is no redirect examination now, which, therefore, concludes Mr. Poole's testimony on prima facie.

(Witness excused.)

Mr. Boettcher: I have a few exhibits I would like to introduce, and that will take a few moments and then I expect to rest.

The Court: Then I would take it it is not necessary for me to work into the lunch hour in order to complete this case by a reasonable time this afternoon.

Mr. Russell: I sincerely believe, your Honor, it can be done. [113]

Mr. Boettcher: I take it that we shall not try this afternoon to go beyond the introduction of evidence.

The Court: That is my understanding. Usually in cases of this character I have found it to be the preference of counsel to write a brief or a memorandum of some kind, at least, to cite to the court the literature which the court should read. That has been done to some extent in this case by virtue of a motion for summary judgment.

But, in any event, if counsel would like to take a little time to analyze the evidence and return for argument, or treat it by factual briefs, that is all right.

We will take the recess until 2:00 o'clock. We will sit this afternoon until the evidence is finished.

Mr. Russell: Thank you.

Mr. Boettcher: Thank you.

(Whereupon, at 12:00 o'clock noon, a recess



was taken until 2:00 o'clock p.m. of the same day.) [114]

Friday, May 4, 1956. 2:10 P.M.

Mr. Boettcher: May it please the court, I think the record shows that just before the recess I announced that there would be no redirect examination of Mr. Poole.

The Court: Yes.

Mr. Boettcher: Now, I have a few exhibits that I would like to offer.

Firstly, I offer the exhibit that the counsel for the defendant had marked for identification, Plaintiff's Exhibit 22-B, as Plaintiff's Exhibit 22-B.

The Court: Received.

(The container heretofore marked Plaintiff's Exhibit 22-B was received in evidence.)

Mr. Boettcher: Then I have a plastic cover, which is a duplicate of Plaintiff's Exhibit 8, which with the exhibit tag so attached that it can be used with the carton, and I offer that as Plaintiff's Exhibit 22.

The Court: Is that acceptable?

Mr. Russell: Yes. I would like to examine it.

The Court: I don't think there is any foundation.

Mr. Russell: I do not believe so, your Honor.

Mr. Boettcher: The reason for it is simply that the other exhibit, the corresponding exhibit, was used on the motion for summary judgment and it has tags on it in connection [115] with the requests for admissions of fact. It is identical with this, but

it is so cluttered up with tags that it cannot be used with this.

Mr. Russell: Is not this structure already in evidence, however, Mr. Boettcher?

Mr. Boettcher: The structure is in evidence by way of the requests for admissions of fact, having subsequent introduction in evidence. This is a duplicate.

The Court: I take it this is being offered now so the court will have one that is not encumbered with labels and the like, so the court can make full observation.

Mr. Boettcher: That is correct.

The Court: Any objection?

Mr. Russell: No objection, your Honor.

The Court: Received.

The Clerk: 22.

(The cover referred to was marked Plaintiff's Exhibit 22 and was received in evidence.)

Mr. Boettcher: Now, I have here a drawing of that particular defendant's lid, which I should like to introduce as Plaintiff's Exhibit 22-A. Now, that drawing is the original of the print that was used for that purpose on the motion for summary judgment, so counsel is already familiar with it.

Mr. Russell: I am familiar with the subject matter, but [116] I believe, your Honor, the print itself is objectionable for the reason the accused device speaks for itself and needs no representation such as this.

The Court: Overruled and admitted.

The Clerk: 22-A.

(The drawing referred to was marked Plaintiff's Exhibit 22-A and was received in evidence.)

Mr. Boettcher: Now, Plaintiff's Exhibit 9 is the other type of defendant's lid, and that too is encumbered with tags in such a way it cannot be used with this carton, which I am also going to ask to introduce.

I would like to introduce this quart size duplicate of Plaintiff's Exhibit 8 as Plaintiff's Exhibit 23.

Mr. Russell: No objection.

The Court: Received.

(The container referred to was marked Plaintiff's Exhibit 23 and was received in evidence.)

Mr. Boettcher: And then a final exhibit is the quart size milk carton, which I offer as Plaintiff's Exhibit 23-A.

Mr. Russell: No objection.

The Court: Received.

(The carton referred to was marked Plaintiff's Exhibit 23-A and was received in evidence.)

Mr. Boettcher: Plaintiff rests.

Mr. Russell: I would like to recall Mr. Poole to the stand, your Honor. [117]

The Court: As an adverse witness?

Mr. Russell: As an adverse witness, yes, your Honor, under Rule 43(b).

The Court: All right, take the stand. You have been sworn once.

## WILLIAM J. POOLE

recalled as a witness on behalf of the defendant, under the provisions of Rule 43(b) of the Federal Rules of Civil Procedure, having been previously duly sworn, was examined and testified further as follows:

The Court: Now, while you are called by the defendant, being called as an adverse witness, which means in legal theory there is hostility between you and he, and if you don't understand a question you had better make it known, because when you have an adverse witness most lawyers undertake to get the witness to fall into some kind of a trap. I don't know what you have in mind, Mr. Russell.

And it is perfectly legal, you understand, Mr. Witness, but still be on guard. You are being questioned by someone who is on the other side. If you don't understand the question that is put to you, if you will let that be known I am sure Mr. Russell will rephrase it.

Mr. Russell: I would like to re-enter the territory, your Honor, of Defendant's Exhibit B. That is the art book [118] to which we referred before, comprising the group of patents that have been noticed heretofore in this case.

## Direct Examination

Q. (By Mr. Russell): Now, Mr. Poole, referring again to tab 1 of Defendant's Exhibit B,—

The Court: Do I have one of those?

Mr. Russell: I am sorry, your Honor.

Mr. Boettcher, do you have a copy?

(Testimony of William J. Poole.)

Mr. Boettcher: Certainly.

The Court: It seems to me one was provided me yesterday, but I don't find it on the bench.

Mr. Russell: I believe that is the original. Perhaps you would like to have the court copy and Mr. Poole could use Mr. Boettcher's copy. They are identical in all respects.

The Court: Then I can look at it at the bench here,——

Mr. Russell: Very well. Thank you, your Honor.

The Court: ——without having to look over the witness' shoulder.

Mr. Boettcher: I may have to do the same, if I may.

The Court: Yes.

Mr. Boettcher: That is my only copy.

Q. (By Mr. Russell): Are you familiar with the patent to Drake in Defendant's Exhibit B, that is, Patent No. 1,325,930? [119]

A. No, sir, I am not.

Q. You have never seen that patent before?

A. No, sir.

Q. Looking through the group of patents comprising Defendant's Exhibit B, Mr. Poole, I wish you would thumb through them.

Have you seen any of those patents before?

A. To your tab 2, under the name J. D. Kurz, no.

To your tab 3, W. L. Rutkowski, no.

To your tab 4, G. A. Moore, no.

To your tab 5, R. H. Van Saun, I have not seen

(Testimony of William J. Poole.)

this patent before. I have heard it referred to for the first time in court today.

To your tab 6, A. Merkle, no.

To your tab 7, D. W. Hill, I was shown a copy of this patent earlier this week by Mr. Boettcher. I have not read the specifications nor the claims.

Q. You are, of course, Mr. Poole, familiar with your own patent? You have read it several times, have you not?

A. I am familiar with the specifications. I don't qualify myself as a legal expert, able to read the technical language in the claims or understand it fully.

Q. Very well. Then limiting ourselves to the specifications as set forth in your patent, just what did you contribute to this structure that was new?

Mr. Boettcher: I object to that. In order to answer that intelligently one really has to know what the prior art is and to be able to measure the differences between what the patent shows and what the prior art is.

Mr. Russell: If I may add, your Honor, let's say new to this witness, not—

The Court: As amended, it is a different question. But he is asked a different question. He says new to this witness. The prior question referred to a specific art which was mentioned, and he then now has limited it to new to this witness' understanding.

The Witness: To my knowledge the feature of this development which was new and useful was

(Testimony of William J. Poole.)

the incorporation of a rigid setup, full open top, paperboard container, in combination with a molded cover, specifically designed for the domestic packaging of foods for freezing.

The Court: What do you mean by "domestic" in that connotation?

The Witness: I mean the carton was designed primarily for use by the housewife in the home freezing or locker freezing of foods, much as in the same light as home-canned foods.

Q. (By Mr. Russell): Referring then specifically, Mr. Poole, to tab 7 in the art book, Defendant's Exhibit B before you, the patent to Hill which you indicated you have read before, [121] does not——

A. Pardon me. Did I understand you right, that I indicated I had read before?

Q. You indicated you had seen the patent before. A. I have seen the drawing only.

Q. Let me finish the question.

The Court: I understood he testified he had seen the patent, which had been shown him by counsel last week. But he had not read the specifications or the claims.

Mr. Boettcher: This week. That is correct.

Q. (By Mr. Russell): With reference to the patent to Hill, is there anything in your structure just described that is not in Mr. Hill's disclosure?

Mr. Boettcher: I object to the question. The Hill patent is not prior art and it is not a proper question, to compare the Poole disclosure, patent dis-

(Testimony of William J. Poole.)

closure, with something that is not prior art, in the respect of the question of validity.

Mr. Russell: I submit, your Honor, the Hill patent is prior art in this case, and if you desire us to brief it we shall.

The Court: What is it that makes it prior art?

Mr. Russell: The Hill patent, you will note, your Honor, was filed on October 3, 1947, as is clearly indicated on page 1 of the specifications. Whereas the patent in suit to Poole was filed May 10, 1948; nearly seven or eight months later. [122]

The Court: Does the filing date control or is it the issuance date of the patent?

Mr. Russell: Actually, your Honor, the filing date is presumably, the filing date of Hill being ahead of Mr. Poole's, presumably the Hill patent was prior art.

The Court: Well, it would have brought them into interference if they were in the Patent Office at the same time.

Mr. Russell: If the Patent Office had functioned properly, yes, your Honor. We submit perhaps they erred in not declaring interference. We will get to that point shortly.

Mr. Boettcher: May I speak to that?

The Court: Yes.

Mr. Boettcher: I am looking for a citation I had. This is in handwriting. I will do the best to read it as rapidly as I can.

The Court: Take your time. If you try to go too fast you will stumble. Don't rush. If you have



(Testimony of William J. Poole.)

to stay after the regular court hours, I will stay with you.

Mr. Boettcher: "A patent cannot properly be cited as an anticipation of a later patent granted on an application filed before the issuance of such earlier patent."

That is *Johns Pratt Company v. E. H. Freeman Electric Company*, 201 Fed. 356, on page 360.

I think that went to the Supreme Court, 345 U.S. 976. [123] And that is also consistent with the statutes, part of which Mr. Russell read a little earlier. He read from Section 102 of Title 35, which states, "That a person shall be entitled to a patent unless" this, that and the other thing. In other words, unless there had been public use prior to the invention or more than a year prior to the filing date, and so on.

I shan't go over all that at this moment, because I am leading up to Section 103.

"A patent may not be obtained, though the invention is not identically disclosed or described as set forth in Section 102 of this Title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject pertains."

Thus Section 103 makes it quite clear that Section 102 has to do with an anticipation, something earlier that is the same construction.

(Testimony of William J. Poole.)

But when the question is one of patentable quality of a difference between an invention and something that came before, then the prior art is referred to. And the prior art means knowledge, common knowledge. It doesn't mean by one person or by a file wrapper in the Patent Office, indeed.

The prior art, the words "prior art" aren't used in 102 at all. That has to do, I say again, with when the earlier thing is submitted as the same invention and earlier. But when it becomes, in order to measure the patentable quality of something that arrives later over something that existed earlier, that is the prior art. And the prior art is that which is known.

From this, your Honor, you can see why in this Johns Pratt case it should have been said:

"A patent cannot properly be cited as an anticipation of a later patent granted on an application filed before the issuance of such earlier patent."

Now, in this case we have this Hill patent. True, it was filed earlier than Mr. Poole's patent. If the inventions were the same, as your Honor indicated a little while ago, then there should have been an interference. But the inventions, so far as the issued patents are concerned—and that is about as much as I know about the Hill patent—weren't the same. And therefore the Patent Office didn't declare an interference.

I can read a claim of the Hill patent and I can tell your Honor, if it were in point, what that claim

(Testimony of William J. Poole.)

were directed to. The six claims of the Poole patent are directed to something different. [125]

Now, if, as a matter of fact, Hill made the invention, at least prima facie, on the day that he filed the application, it has no bearing whatever on the Poole patent because they are different inventions; the claims are different.

I have to go back again to say why this is as it is. The philosophy of the statutes I just read and the philosophy of this case, when you measure an advance you have got to measure the advance from something that exists. And something that exists, to be prior art, must be available to all, so far as the knowledge of it is concerned. That is the base line from which any invention is made.

Now, there was no such base line at the time of the issue of the Hill patent. I submit that the Hill patent is not prior art, and I will meet that now or at any time in this case.

Mr. Russell: May I be heard briefly?

The Court: Yes.

Mr. Russell: I have located a case in point. *Lemley v. Dobson-Evans Co.*, 243 Federal Reporter, page 391. This was a patent infringement case and it involved substantially the same subject matter we have here, as to whether or not a patent having an earlier filing date may be considered. I will quote at page 395:

“This court held, in *Drewson v. Hartje Co.*, supra, 131 Fed. at page 739, \* \* \*” I will omit [126] \* \* \* that a patent, the filing date of which ante-

(Testimony of William J. Poole.)

dated the filing date of the patent in suit, was, prima facie, anticipatory; and we have repeatedly accepted and applied that rule.”

Citing many cases.

Then continuing in that case on page 396: “Hence, it assuredly follows that if a patent in suit was applied for January 15th, and there is nothing to carry the patentee’s invention back of that date, and if a patent disclosing the same invention was issued to another in July upon an application filed January 1st, \* \* \*”

that is just 15 days’ difference——

“\* \* \* this tends to show that the patentee of the patent in suit was not the first inventor.”

The court continues:

“This has been distinctly held not only in *Drewson v. Hartje*, supra, but by the Seventh Circuit \* \* \*”

and many cases are cited.

The court continues:

“\* \* \* and it has been expressly recognized and applied by the Supreme Court (*Pope Co. v. Gormully Co.*, 144 U.S. 238, \* \* \*)”

Mr. Boettcher: May I reply?

The Court: Yes. [127]

Mr. Boettcher: Two words that were used in what has been read demonstrate my point.

The first one was “anticipatory”. An anticipation is an earlier thing of the same thing that someone produced later. That is an anticipation.

“The same invention” is in that language that

(Testimony of William J. Poole.)

Mr. Russell read; "the same invention" granted. Hill's filing date would be a factor if it were the same invention.

Anticipation is one thing. Inventive quality over something, that is something else.

When you measure the contribution or the value—the inventive quality, is the best way I can put it, over something that went before—does it or does it not contain, does it or does it not amount to an invention? That is over the prior art. That isn't what Mr. Russell's authority has to do with that. That has to do with an anticipation, and that means the same invention.

I might also say, in passing, if this were proposed here as the same invention, then it should have been pleaded. You have to plead a prior invention by someone else.

I think I will say no more, after I have said we are measuring here the contribution over the prior art, which is something else.

Mr. Russell: It is immaterial to us, your Honor, what you call it. The point we are trying to get over is that [128] Mr. Hill was earlier in time, and being earlier in time, regardless of whether it is drawn on the wall or drawn on a piece of paper, Mr. Hill had an earlier conception of the subject matter. Perhaps Mr. Hill failed to claim it, but he disclosed it and it is, in our opinion, prior art. We think it is very pertinent.

The Court: Is your Exhibit B in evidence?

Mr. Russell: Yes, your Honor.

(Testimony of William J. Poole.)

The Court: Well, the court will have to consider it along with the other evidence. I don't know which side of this question I will ultimately come to, but I am not going to precipitantly undertake to do so now.

I do think that the question put to this witness is argumentative in quality, and the objection is sustained.

Mr. Russell: In connection with the patent to Hill, your Honor, I may add that I have ordered by telephone, through our associates in Washington, a certified copy of the file wrapper and contents of the Hill patent, which I proffer to the court at this time. As soon as it is received I certainly shall appreciate the privilege of filing the same in evidence in this case.

The Court: I take it there is an objection on the same ground——

Mr. Boettcher: Yes.

The Court: ——as heretofore made? My suggestion would [129] be that it be deemed offered, and the court will rule on that offer when we next meet.

Mr. Boettcher: I was going to say, I am objecting to it on the same ground, but I think it is best that the court have everything before it.

The Court: Of course, I have had cases here, and we had a case concerning an improved machine for leveling cement sidewalks and things of that kind, a troweling device. They brought in as prior art a rather crude machine which embodied the

(Testimony of William J. Poole.)

same principle, which was used by some illiterate, semi-illiterate Mexican workman who was doing working of that character and had developed the machine for his own use. He never thought of patenting it or vending it to others. After using it for a number of years he had reached the age of retirement and he retired and left it in his garage.

They dug it out and brought it in here as prior art. There was a lot of evidence to the extent to which it had been used and disclosure had been made. I can't recall there was an objection to that as prior art. Everyone took the position that whether it was prior art or not depended upon whether it had that quality and there had been disclosure of it to someone, either the Patent Office or the public, competitors or someone. And the point they went at was it was not the same invention.

Now, either some very capable lawyers missed the point [130] in that case or you are arguing something which is not valid in this one; I don't know which. And I just can't decide it here at 20 minutes to 3:00 on Friday afternoon, when it comes to me cold.

Mr. Russell: May I continue, your Honor.

The Court: Yes.

Q. (By Mr. Russell): Mr. Poole, again referring to your structure, what is it that produces any unusual and surprising consequences, up and over older types of containers and closures thereof?

(Testimony of William J. Poole.)

Mr. Boettcher: I object to that kind of a question to a lay witness. "Surprising, unusual". That is lingo from the patent decisions, and we are not—why not just talk about the facts?

The Court: The objection is overruled. But I will not consider the words used by the witness as words of art. I think it is a proper question to put to an inventor, and the words will be understood in their usual meaning, rather than any specialized meaning which they might have acquired in the language of decisions.

Mr. Russell: Prevail upon the witness to use his own words, your Honor.

The Witness: Your question was what was unusual or surprising in this construction? Did I understand you correctly? [131]

Mr. Russell: Miss Reporter, will you read the question?

(The question was read.)

The Court: Do you understand the question?

The Witness: Yes.

The Court: All right. Just take your time and think about it and give your answer.

The Witness: Well, first of all, as to previous containers for this purpose, I don't claim to have any complete background of knowledge of all types of containers.

So perhaps I don't qualify as an expert on this. But I am sure that is not what I am up here for.

This container was developed to serve a definite requirement, which I believe was brought out in the



(Testimony of William J. Poole.)

testimony yesterday. That requirement having been brought to our attention by the comments and some objections from the users of the package that preceded it. And I know, or, I should say I knew at that time of no such container as this, which would accomplish the desired purpose of storing and properly freezing—I should reverse that—freezing and properly storing food products, and which would also offer the advantages of a rigid setup container with a full top opening that was simple to fill, simple to form a suitable closure and easy to empty after thawing, which could be nested to effect a saving in storage space and the freight.

At the time this idea was conceived and developed there [132] was no such container that answered those requirements.

Q. (By Mr. Russell): That is in sum and substance summarizing the unusual or surprising consequences arising out of the creation of your construction, is that correct?

A. Well, let me say that those things were the inspiration for developing this combination carton and plastic lid.

The Court: What he is getting at is what did you get when you started to develop it? What did you develop, from the standpoint of consequences that were not consequences of use of the earlier structures?

The Witness: May I say this carton, as such,—(indicating)—

The Court: You are referring to Exhibit 20?

(Testimony of William J. Poole.)

The Witness: Exhibit 20. Or this carton, Exhibit 16, which are essentially functionally the same. A carton of that nature, suitable for the packaging and storing of frozen foods, did not exist prior to the conception and development of this idea.

Q. (By Mr. Russell): The carton itself, however, is not patented, per se?

A. Well, let me say I don't know that, because again I am not a patent expert, sir.

Q. Getting to essentials, Mr. Poole, so far as you were concerned at the date of issuance of your patent, the [133] only point of novelty that you had, if any, was in the widening of that groove in the lid, isn't that correct?

A. Again I don't think I can give you a factual answer to that, because I am not able to interpret the legal language of the six claims.

Q. Apart from what the claims say, you created something, something that apparently or purportedly is new.

Now, as far as you were concerned, the only thing that was new was merely opening up the groove in the lid?

A. So far as I am concerned, still the specification as it reads, which is a combination or the creation of a new article for manufacture,—

Q. The box is old, isn't it?

The Court: Let the witness finish his answer.

Q. (By Mr. Russell): I beg your pardon.

A. —the creation of a new article for manufacture, to serve a given desired purpose. That

(Testimony of William J. Poole.)

situation had not changed between the filing date and the issuance date of the patent.

Q. Wasn't it essentially your problem to develop a plastic lid to fit an old conventional type of container, such as the milk container referred to before?

A. No, essentially the problem was to devise a combination of carton and lid which would perform this specific function, which combination did not exist prior to the [134] development of this idea.

Q. You testified that Plaintiff's Exhibit No. 16—that is the old carton body in front of you—was originally designed by you or put together by you, and then you designed the lid to go on top of it. It didn't work for some reason or other and thereafter you opened up the groove in the lid. Is not that the point of novelty or what you believe to be the invention, your contribution?

A. I still go back to the thought that the basic contribution was a workable combination of two elements of the patent.

Q. It was just to put the two parts together so they would fit?

A. So that they would—yes, so that they would fit and make a suitable, usable package.

Q. Now, just what does the opening of the groove, or providing an offset, as the case may be, do that wasn't accomplished before you conceived of it, as far as you know?

(Testimony of William J. Poole.)

A. Well, maybe I had better understand that question a little bit better, sir.

Q. I will rephrase it. When you widen the groove in the lid, what does it do?

A. Well, I believe it was brought out in the direct examination yesterday our first 3,000 trial lids——

Q. You are not answering the question. What does the [135] widening of the groove do? Isn't it a fact that it merely is widened to accommodate the lap joint?      A. That is correct.

Q. Very well. Do you personally know Mr. Hill, the patentee of the Hill patent referred to in Defendant's Exhibit B?

A. I have met him, yes, sir.

Q. When did you meet him?

A. To the best of my knowledge, my first meeting with Mr. Hill was on the visit referred to in the direct examination.

Q. Did he show you one of his lids?

A. No, sir.

Q. He didn't acknowledge to you he had invented a plastic lid?      A. No, sir.

Q. I didn't quite hear you?      A. No.

Q. Was he involved at all in connection with your negotiations with Crown Cork respecting the manufacture of your lids?

A. Yes, he was. As president of that company, he was definitely involved.

Q. At the time you conceived of your invention, Mr. Poole, did you believe that you originated the

(Testimony of William J. Poole.)

broad concept [136] of widening the groove in a lid to make it fit the lap joint of a container?

A. Could I have that clarified to this extent: Do you mean the time when, that I started to develop the idea of the combination of the two items, the necessity for a full open top plus a lid?

Q. Let's go to the time when you found out that the first type of lid wouldn't fit, and you had to widen the groove to make it fit. At that time, when you conceived the alleged invention, did you believe that the broad concept of widening that groove was original with you?

A. I am afraid I can't answer that, either, because I don't have complete knowledge of what may have gone on before.

Q. What you believe. This is your own subjective mind. Did you yourself believe that you were the inventor?

A. Well, let me answer it this way: I didn't know of no other.

Q. You didn't know of Mr. Van Saun's construction?

A. No. The first reference I have heard to the Van Saun patent was made by yourself here in this courtroom.

Q. Do you know Mr. Van Saun?

A. I have met Mr. Van Saun.

Q. Have you worked with him?

A. No, sir, I have not.

Q. Have you seen any of the structures he has created? [137]

(Testimony of William J. Poole.)

A. No, sir, I have not. He works for a different division of my company.

Q. Have you ever discussed patents with Mr. Van Saun? A. No, sir, I have not.

Mr. Russell: I am attempting to hurry this as fast as I can, your Honor.

The Court: You don't have to turn the pages that fast. I am not rushing you.

Q. (By Mr. Russell): Mr. Poole, why doesn't Container Corporation, the plaintiff here, suggest the use of old cut-off milk cartons for the storage of foods and merely sell the lids?

Mr. Boettcher: I suggest that that is entirely speculative.

The Court: Irrelevant and immaterial. This witness is not qualified to give an answer.

Mr. Russell: I believe he is, your Honor. He was in that capacity, frozen food division of the Container Corporation.

The Court: The Court holds, in the present posture of the case, he is not qualified to determine corporate policy. Objection sustained.

Q. (By Mr. Russell): Is there any reason, to your knowledge, why the plaintiff, Container Corporation, does not make its commercial cartons and lids precisely as in accordance [138] with your patent? A. Would you restate that, please?

(The question was read.)

The Witness: I presume that you refer to the change that was made in the 1950 version of this carton and lid, whereby we incorporated a 45-degree

(Testimony of William J. Poole.)

taper from the corner on the glue lap and the triangular recess in all four corners, as opposed to the previous or 1949 version. Is that correct?

Q. (By Mr. Russell): Yes.

A. The reason for that change and the reason we continued to manufacture the later style which was introduced in 1950 is because we feel it is a definite improvement. It makes for a simpler, easier closure operation by the housewife who uses the package.

Q. Handing to you, Mr. Poole, Plaintiff's Exhibit 23 in evidence, do you recognize that plastic lid?

A. Yes. Samples similar to this were shown to me by Mr. Boettcher a matter of about ten days ago.

Q. You had not seen a sample prior to that time? A. No, sir, I had not.

Mr. Boettcher: May I have the question and answer there, please?

(The record was read.)

Q. (By Mr. Russell): Since you first were advised of the existence of that particular lid referred to, that is, [139] Plaintiff's Exhibit 23, do you have any idea what they sell for?

A. No, I do not.

Q. What does the plaintiff, Container Corporation, sell its lid for to wholesalers?

Mr. Boettcher: I object to that. I don't see any reason for prying into the financial affairs.

The Court: Sustained.

(Testimony of William J. Poole.)

Q. (By Mr. Russell): Mr. Poole, what is the gross business done by the plaintiff, Container Corporation, in the manufacture and sale of plastic lids, the type here in suit?

A. Are you asking for an average annual gross? Is that what—

Q. Yes. Pick any year as exemplary.

A. Assuming the value at resale, which we established it, approximately five cents—

Q. Just a minute. You are not answering the question.

The Court: He is giving an explanation of terms, apparently, from which we will understand the answer he is about to give.

Mr. Russell: Very well, your Honor.

The Court: So he may continue to do that.

The Witness: Assuming the retail value at approximately five cents, it is a matter of arithmetic to establish the annual gross business at the retail level on these lids. And [140] we have already, I think, been told that we were not to disclose the wholesale price these are sold to the distributors at, by the sustaining of the objection of Mr. Boettcher.

The Court: The question doesn't require you to do that. I take it the question could be answered if you told the approximate number that were placed into commerce in a year's period of time or in some other unit of measurement.

Mr. Russell: The monetary value is important, your Honor.

The Court: Why?



(Testimony of William J. Poole.)

Mr. Russell: Commercial success. What is commercial success, which is an important issue in this case.

The Court: I don't think the percentage of profit and so on—that is the sort of thing you are beginning to get at. You haven't asked exactly that, but you have asked a question which would lead readily into that field, and that I don't think the Court should inquire into. It is beginning to get into the private, confidential information of the litigant.

Mr. Russell: I submit, your Honor, that I could manufacture and distribute these items myself. I could give them away. I could give away millions of them, perhaps, and not be commercially successful.

The Court: I think commercial success, used in the language of patent laws, does not refer so much to commercial [141] economic success as it does to acceptance by a using public, or using segment of the public, a large number of the devices which are vended and which embody the invention or claimed invention.

Mr. Russell: Very well, your Honor. And the same, of course, would be true of the structures of the defendant's. If they infringed the patent in suit they should likewise be as commercially successful; I would presume the same would be true.

The Court: Commercial success is greatly overworked in these cases.

Mr. Russell: May I proceed, your Honor?

The Court: Yes.

Mr. Russell: Thank you.

(Testimony of William J. Poole.)

Q. (By Mr. Russell): To your knowledge, Mr. Poole, has a Dun & Bradstreet report been secured on the defendant in this case?

A. I would have no idea.

Q. You have before you, Mr. Poole, the Locker Management publication that, I believe, is Defendant's E, the two-sheet outside cover of the magazine or publication.

A. Yes, I do.

Q. Referring to page 2, will you kindly tell the Court wherein the patented feature is made known to the public in that advertisement of the plaintiff's? [142]

A. Well, I am not too sure I understand that question, either.

The Court: He wants to know where the salient features of the patent are illustrated or pointed out in that exhibit.

The Witness: Not necessarily the fact it is patented, however, is that right?

The Court: No. He is referring to structural or functional characteristics, as distinguished from sales language or claim of title to a patent.

The Witness: I can't say that specifically there is any language used in the copy of this page——

Q. (By Mr. Russell): Nothing to show the widening of the groove?

A. ——which refers specifically to a patented container.

Q. Isn't it a fact, Mr. Poole, that cartons of the type of Plaintiff's Exhibit 20 before you, the commercial embodiment, may be used for other pur-

(Testimony of William J. Poole.)

poses besides in conjunction with the plastic lid of the Plaintiff's Exhibit 21?

A. By that do you mean that—

Q. Couldn't a housewife put a piece of aluminum foil around it and wrap a rubber band around it to store food in a refrigerator?

A. That is possible. That could be done, yes. I doubt it would be as efficient.

Q. It can be done without the lid? [143]

A. I don't think there is any question about it.

Q. Does the amount of advertising done by the plaintiff, in advertising its Vapocan—and I refer to both of them—have any effect on the sales of the item, to your knowledge?

A. I am afraid that is something I wouldn't be able to judge. I don't have access to any market survey figures. I don't have access to the amount of moneys that are spent on advertising, so I am afraid I can't answer that.

Q. Have you ever read the file history of your patent?      A. No, sir, I have not.

Q. In fact, you don't know what you invented?

Mr. Boettcher: Oh, I think this argument with the witness is wrong.

The Court: Are you objecting?

Mr. Boettcher: I am objecting.

The Court: Sustained.

Q. (By Mr. Russell): Do you or your company, Mr. Poole, claim to have any right to prohibit other people from making or using a plastic lid having a

(Testimony of William J. Poole.)

peripheral groove such as any before you, without the widening of the groove?

A. I am afraid that is something I would have to refer to our legal department for an answer.

Q. The same thing would be true as to prohibiting other people making or using a lap-jointed carton? [144]

A. If it were a question of whether I felt that my company could prevent any other manufacturer from making a given carton or lid, or anything else, I would not feel I could judge that. It again would be referred to my legal department for an answer.

Q. Without disclosing, Mr. Poole, any monetary figures which might be confidential, what is the percentage of the gross volume of business done by the plaintiff, Container Corporation, as compared to the gross volume of business on the lids and cartons now in issue, percentagewise?

A. Oh, I am afraid that would be grabbing in the air for a figure, if you would like to have me guess.

The Court: No, we don't want guesses.

The Witness: I am afraid I couldn't answer it then.

The Court: Estimate, yes. If you can estimate, all right. But an estimate is an educated guess, and we don't want wild guesses.

Q. (By Mr. Russell): Could you make an estimate?

A. I am afraid it would fall in the category of a guess, so perhaps I better not.

(Testimony of William J. Poole.)

Mr. Russell: I believe that is all, your Honor, for this witness.

Mr. Boettcher: I would like to ask a few questions on cross.

The Court: Yes. [145]

### Cross Examination

Q. (By Mr. Boettcher): Referring to Defendant's Exhibit E, I notice the first few words on that page, that is, the inner cover page, about the Vapocan are as follows:

“Only Vapocan Has All These Fine Features \* \* \* Full-Top Opening For Easy Filling And Emptying.”

You mentioned that some time ago, didn't you, yesterday, for instance?

A. That is right.

Q. “Plastic lid can be used year after year, a thrifty long-range investment.”

You have read the specification of your patent?

A. Yes.

Q. It says something about reusable covers, does it not? A. Yes, it does.

Q. “Sure, efficient seal in one quick motion.”

Didn't you speak about that yesterday?

A. Yes, sir, that is also in the specifications.

Q. You are talking about the pressure of the housewife's hand on the cover? A. Yes.

Q. “Squared body saves locker and storage space.”

You mentioned that yesterday? [146]

(Testimony of William J. Poole.)

A. Yes.

Q. "Plastic lid rimmed for firm stacking."

That is another way of saying it? You talked about stacking yesterday?

A. That is right, yes, we did.

Q. What are your present responsibilities with the Container Corporation?

A. I am manager of beer package sales of the Chicago carton division.

Q. Beer package sales of a particular division?

A. That is right.

The Court: What kind of package?

The Witness: Beer.

The Court: Beverage?

The Witness: Yes.

Q. (By Mr. Boettcher): It means cartons for six bottles of beer or something of the sort, is that right? A. That is correct.

Q. How long have you been manager of that particular division or section?

A. I believe the date I took over that responsibility and title officially was April 23, 1953.

I have been working, however, partially on beer packaging somewhat prior to that, starting in about 1951.

Q. In other words, you moved gradually from the frozen [147] food packaging into the beer packaging, is that right?

A. That is correct. And I carried responsibility in both for that change-over period.

Mr. Boettcher: Nothing further.

(Testimony of William J. Poole.)

Mr. Russell: A question, your Honor, if I may.

The Court: Yes.

Redirect Examination

Q. (By Mr. Russell): You brought out the fact you are connected with the beer packaging division of the plaintiff.

A. That is correct.

Q. The last fiscal year, how many beer cartons were delivered out of the beer packaging division?

Mr. Boettcher: I object to that as utterly immaterial.

The Court: Sustained.

Mr. Russell: I submit it is not.

The Court: What makes it material?

Mr. Russell: Trying to establish what constitutes commercial success with something to compare it with. He has testified that they sell millions of these cartons that are here in issue.

I believe it is material to show what other products are sold in tremendous mass quantities. Not because they are patented, but just because they happen to be a paper box.

The Court: You are getting then into the realm of [148] common knowledge, aren't you?

We know that a tremendous number of items enjoy huge commercial success. Many of them that are not the subject of patent and never have been.

Mr. Russell: Are you going to rule on the question, your Honor?

The Court: The objection has been sustained.

Mr. Russell: Thank you.

(Testimony of William J. Poole.)

Mr. Boettcher: I concluded my cross examination.

Mr. Russell: Very well, Mr. Boettcher. The witness may be excused, so far as the defense is concerned, your Honor.

(Witness excused.)

Mr. Russell: I would like to call Mr. Comstock to the stand, if I may. If your Honor desires a very short recess, why, we may enjoy it and Mr. Boettcher may enjoy it.

The Court: All right. We will take a short recess.

(Recess taken from 3:17 o'clock p.m. to 3:32 o'clock p.m.)

Mr. Russell: I would like to offer in evidence Defendant's Exhibit F for identification.

Mr. Boettcher: I object. There is no foundation.

The Court: I do not recall the foundation.

Mr. Russell: Beg your pardon, your Honor?

The Court: I do not recall the foundation.

Mr. Russell: The witness, your Honor, was interrogated and he did indicate that he recognized the subject of the [149] display, but not the particular piece of paper.

The Court: Well, is it offered then as illustrative of the witness' testimony concerning the structure that is shown there, or is it offered for something else?

Mr. Russell: Yes, your Honor.

Mr. Boettcher: I don't understand the testimony he is talking about.



Mr. Russell: The testimony of Mr. Poole. The fact display stands are made and distributed by the plaintiff.

Mr. Boettcher: I think it could be submitted only for the purpose of identifying the picture in the right-hand corner here, or something of that sort.

The Court: That is what he is doing. And if this were a jury case I would have the clerk paste some tape over the rest of it. Since it isn't, I will just not bother to read the rest of it myself. It is received.

(The document heretofore marked Defendant's Exhibit F was received in evidence.)

Mr. Boettcher: I think the record will show its pertinency or its lack of it here.

Mr. Russell: Mr. Comstock, your Honor, has approached the witness stand. I would like to have him sworn as a witness. [150]

### ROBERT C. COMSTOCK

called as a witness on behalf of the defendant, having been first duly sworn, was examined and testified as follows:

The Clerk: Will you please be seated.

Your name, sir?

The Witness: Robert C. Comstock.

#### Direct Examination

Q. (By Mr. Russell): What is your occupation, Mr. Comstock?

A. I am a patent lawyer.

Q. And your business address?

(Testimony of Robert C. Comstock.)

A. 4055 Wilshire Boulevard, Los Angeles.

Q. Are you admitted to the State Bar of California? A. Yes, I am.

Q. Any other state bars?

A. Yes, I was admitted in Illinois in 1941.

Q. Admitted to practice before the Patent Office? A. Yes, I am.

Q. How long have you practiced patent law?

A. Since 1941, except for time in the Service.

Q. And you in your practice of patent law have prepared patent applications?

A. Yes, I have, many of them.

Q. And prosecuted patent applications before the Patent Office? [151] A. Yes, I have.

Q. And has this been on various and sundry mechanical patent applications? A. Yes.

Q. You are, therefore, familiar with Patent Office procedures and actions made by Patent Office Examiners? A. Yes, I am.

Q. Have you rendered legal opinions relative to the validity of patents and infringement of patents?

A. Yes, I have quite frequently.

Q. Have you appeared before the Patent Commissioner on various patent matters?

A. Yes, I have.

Q. Have you testified as an expert before any patent cases? A. Yes, I have.

Q. Have you studied the patent in suit to Poole, No. 2,638,261?

A. Yes, I have studied that patent.

Q. Have you studied all of the patents in the

(Testimony of Robert C. Comstock.)

Defendant's Exhibit B, the seven patents heretofore referred to?

A. Yes, I have studied all of those.

Mr. Russell: I believe, your Honor, you have been advised of the subject matter of the patent in suit. I would like to proceed directly to the art book, and particularly the [152] patent to Drake, which is identified as tab No. 1. I believe your Honor has your copy.

The Court: Yes. Referring to Defendant's B?

Mr. Russell: Defendant's B, your Honor, yes.

Q. (By Mr. Russell): You are familiar, Mr. Comstock, with the contents of the Drake patent?

A. Yes, I am.

Q. Do you find any similarity between the disclosure of the Drake patent and the disclosure of the Poole patent in suit?

A. Yes, the Drake patent shows a container which it states is made of fibrous material, which would include paperboard of the type described in the Poole patent, and the lid, which is described here as being circular rather than square as in the Poole patent. But the lid is similar in the way it fits on the container. The lid in the Drake patent—the patent states that it is

“preferably tapered so that by reason of such taper the ring 11 wedges to the exterior of the neck surface or tightens as it is forced on.”

I was reading from around line 105 in column 2 on the first page of the patent.

(Testimony of Robert C. Comstock.)

And a little later on, around line 110, it refers to "a very acute V-shaped groove", and that structure is shown in Figure 2 of the patent, in which it shows that the top of [153] the container is wedged into a narrowing or tapering groove that is defined by a pair of flanges of the container.

Q. Do you find anything to the effect that there is a sealing action between the container and the closure illustrated in Drake?

A. Yes; referring to the next page of the patent, page 2, line 7, and continuing on, he states:

"a continued forcing of the closure will cause the yielding material of the receptacle to be compressed into the V-shaped groove thereby forming an absolutely air and liquid tight joint between the closure and the receptacle."

Q. That is comparable, or, let's say identical to the type of closure represented by the Poole patent in suit?

Mr. Boettcher: Here we have an expert on the stand, your Honor please. I don't think we should ask leading questions of the expert.

The Court: Well, experts of this character in testifying are lawyers themselves, and you get an advocate's answer just the same as if he were asking the questions in leading form.

I don't mean to disparage patent experts, but they have one of their lawyers on the stand, is what it amounts to.

Mr. Boettcher: I understand. I thought I would

(Testimony of Robert C. Comstock.)

raise this objection at the first instance and then forever hold my [154] peace on that kind of an objection.

The Court: The testimony does have its limitations for that reason, but still I think it is an almost indispensable type of procedure for defendants in this type of case. We always have it, so the objection is overruled.

The Witness: Will you read the question?

(The question was read.)

The Witness: Yes, the sealing or closure action described in the Drake patent is the same as that described in the Poole patent. That is, the carton, top edge of the carton is sealed or compressed within the tapering groove.

Q. (By Mr. Russell): If I may refer, Mr. Comstock, now to Claim 1 of the Poole patent, I will quote in part:

“a plastic friction cover having a downwardly opening peripheral recess tapering upwardly,”

Do you find such construction in the Drake Patent, tab No. 1?

A. Yes, the recess there is downwardly directed and it tapers upwardly.

Q. Also further quoting from Claim No. 1:

“fitting tightly over the upper edge portion of the wall of said body with the opposed surfaces of said recess contacting the inner and the outer surfaces of said wall for the major portion of the depth of said recess and compressing said wall between said

(Testimony of Robert C. Comstock.)

opposed surfaces thereby providing a tight friction [155] seal between said cover and said body.”

Do you find that construction in the Drake patent?

A. Yes. Taking the first part of that first, you find the first part of it shown in Figure 2 where you see that the top of the container is tightly fitted, and that that continues for the major portion of the depth of the recess.

And then the later part about the tight fitting or compressing is set forth in the specification where it states that the top of the container is compressed into the V-shaped groove to form an air and liquid tight joint.

So that I find all of the structure which you read from Claim 1 of the Poole patent is shown and described in the Drake patent.

Q. Let's skip then to Claim No. 5, and quoting from a portion of it, it says:

“having a peripheral member comprising an inner flange and an outer flange, said flanges diverging downwardly and defining between them an upwardly tapering recess for frictional engagement over the upper edge portion of the wall of the carton body,”

Do you find such a construction in the Drake patent?

A. Yes, all of that structure is shown. We have the recess which is defined between elements 11 and 13. I believe 11 is referred to as a ring and 13 is re-

(Testimony of Robert C. Comstock.)

ferred to as a sleeve. Between them they form the downwardly directed recess. The [156] specification says it is tapered and the drawings show that it is tapered, particularly in Figure 2, which is larger than Figure 1.

Mr. Russell: In view of the similarity of these claims, your Honor, and in view of the interest of progressing with the trial, we will skip reference to the other claims which your Honor may desire to evaluate while the subject matter is under submission.

Q. (By Mr. Russell): Do you find any particular material that Mr. Drake used in the construction of his lid?

A. He states:

“The closure comprises a disk of any convenient or desired material such for instance as very light weight sheet metal die-stamped to form a ring 11”, so that he states it can be any material, but he specifically mentions metal.

Q. Let's refer, Mr. Comstock, to the tab No. 2, the patent to Kurz — K-u-r-z — identified as No. 1,969,486. What does the patent to Kurz disclose in general?

A. Kurz shows a shaker, which is formed of a synthetic molded plastic material and a cover or lid which is also formed of a molded plastic material.

Q. Do the claims of the patent to Kurz refer to the material employed?

A. Yes, Claim 1 of the Kurz patent states: [157]

(Testimony of Robert C. Comstock.)

“a closure therefor of convex dome shape, also of molded synthetic resinous material”.

Q. So the cover of the patent to Kurz is made of a molded plastic material? A. Yes.

Q. Referring to the next patent, Mr. Comstock, the patent to Rutkowski, No. 2,155,022, is there any similarity in the construction disclosed by Mr. Rutkowski and that of the Poole patent in suit?

A. Rutkowski shows a container which is designated by the reference character 1, which it states may be any

“suitable such, for instance, as cylindrical, oval, oblong, square,”

and then there is a cover which fits on the container, and he states that he provides

“a slip closure embodying two cover portions having spaced depending flanges adapted to frictionally engage the outer and inner walls of a tubular paper container body”.

The structure that is similar to Poole's or closest to Poole's is shown in Figure 7 of the patent, in which it shows the top of the container, paper container, being wedged or compressed within a tapering recess.

Q. Wedged in the same manner as described in the claim of the patent to Poole? [158]

A. Yes; the inventor states, referring to page 2 of the specification, around lines 49 and 50:

“a substantially wedge-shaped recess or can body



(Testimony of Robert C. Comstock.)

wall receiving space 15' between the closure flanges 5 and 7''.

And a little later on, at the end of that paragraph he states:

“that the wall material of the can body is compressed when forcing the closure onto the end of a paper can body 1.”

This type of fit and compressing is the same as that shown and described in the Poole patent.

Q. So that the Rutkowski recess, for example, in Figure 7 referred to, the recess is a downwardly opening, tapering recess, is that correct?

A. That is right, the recess is directed downwardly and the tapering is directed upwardly to wedge the top of the container.

Q. Was the patent to Rutkowski cited by the Patent Office Examiner during the prosecution of the Poole application?           A. No, it was not.

Q. What class——

The Court: Was the Drake patent cited?

The Witness: Yes, your Honor, the Drake and the Kurz [159] patents were cited, and the Rutkowski patent was not.

Q. (By Mr. Russell): What class and subclass in the patent office is Rutkowski classified?

A. That is, 229 is the class and 5.5 is the subclass.

Q. And what is the class and subclass of the patent to Poole in suit?

A. That is the same class and subclass.

Q. Same identical class?           A. Yes, it is.

(Testimony of Robert C. Comstock.)

Q. In your opinion, Mr. Comstock, should not the Patent Office Examiner have cited the patent to Rutkowski against the Poole application?

Mr. Boettcher: I object to that.

The Court: Sustained.

Q. (By Mr. Russell): In your opinion, Mr. Comstock, the Rutkowski patent is a very pertinent prior art, is it not?      A. Yes, it is.

Q. As against the Poole patent in suit.

A. Yes.

Q. Is it much more pertinent, in your opinion, than the patent to Drake?

A. I would not say much more. It is somewhat more pertinent, but they show very similar structures and similar action. It is a little closer in structure, because the Rutkowski refers to his container as being square and he [160] definitely defines it as being paper, and there are other points like that that are somewhat closer.

Q. Referring now to the Moore patent, No. 2,381,508, which I believe is tab No. 4, do you find any subject matter in the Moore patent in tab No. 4 similar to that of the Poole patent in suit?

A. Moore shows two types of containers. Referring first to the front page of drawings at the bottom, he shows a container in which there is a full overlap for one entire side of the container. And then he shows a second construction, that is on the following page in Figure 5, in which there is a lap joint which only extends for a part of the fourth side of the container. And then he shows a

(Testimony of Robert C. Comstock.)

cover which fits over the double thickness or the lap joint, as the case may be.

Q. Then there is a double wall thickness lap joint which is received into an increased width groove on the lid?

A. That is right. Referring to Figure 3 on the second page of the drawings, on the left side the recess is twice the width of that shown on the right side, the reason being that the recess on the left side accommodates a double wall thickness, where on the right side it accommodates only a single wall thickness.

Q. Does the left joint referred to extend to the upper edge of the container? [161]

A. Yes, it does.

Q. So Mr. Moore, therefore, discloses a concept of providing an angular groove for a lid, wherein the groove is widened to accommodate a double wall thickness carton due to a lap joint?

A. That is correct. The recess is shown most clearly in Figure 3, and the widening is shown in the left side of Figure 3.

Q. Let's refer to the Claim No. 1 of the Poole patent, wherein it states, and I quote:

“said recess being of increased width for a portion of its length corresponding to said lap joint and of uniform width for the remainder of its length.”

Do you find such structure in the patent to Moore?

A. Yes, that is true of Moore. He has a recess which is of increased width only sufficiently to fit around the lap joint, whether the lap joint is the

(Testimony of Robert C. Comstock.)

full side of the container or part of the side of the container, and then it is a uniform width for the remainder.

Q. Was the Moore patent, Mr. Comstock, cited by the Patent Office Examiner against the Poole application?      A. No, it was not.

Q. Was there any other patent or other reference cited by the Patent Office Examiner that showed a cover for a container, the cover having a peripheral recess and the recess [162] being widened to accommodate a container lap joint?

A. No, there was not.

Mr. Boettcher: Please read the question.

(The record was read.)

Mr. Boettcher: Other than what?

Read it again, please.

Mr. Russell: Refer back to the previous question.

(The record was read.)

The Court: We will recess *Container Corporation of America v. M.C.S. Corporation* for ten minutes, while we take a verdict in the *Keltz v. Ringling Bros.* case.

(Recess taken from 3:58 o'clock p.m. to 4:00 o'clock p.m.)

Q. (By Mr. Russell): Mr. Comstock, we were referring to the patent to Moore, tab No. 4, is that correct, in Defendant's Exhibit B?

A. Yes, that is right.

Q. What Patent Office class was the Moore patent classified?      A. Class 229, subclass 43.

(Testimony of Robert C. Comstock.)

Q. Now, referring to Class 229, is that the same class that the Poole patent in suit was classified?

A. Yes, it is.

Q. Do you consider the Moore patent as pertinent prior art against the Poole Patent in suit?

A. Very definitely pertinent. [163]

Q. In what respect?

A. Not only in the respect that it provides a downwardly directed recess, but more particularly because it shows a widening of that recess to accommodate a lap joint in a container, with the lap joint coming up to the top edge of the container and the lap joint fitting within the widened part of the recess.

Q. Was there any other reference cited by the Patent Office Examiner that shows the concept of widening a groove in a lid to receive a double thickness lap joint?

A. No, there was not.

Q. Let's refer now to the patent to Van Saun, tab No. 5, in Defendant's Exhibit B.

Do you find any similarity in the Van Saun patent as compared to the Poole patent in suit?

A. Yes, the Van Saun shows a body member 20, which comprises a rectangular sheet of strong paperboard or similar fibrous material, having its ends brought together in overlapping relation, and secured together.

Q. That is a lap joint?

A. That is a lap joint. That is referred to in the first page of the specification in the middle of

(Testimony of Robert C. Comstock.)

the second column and it is also shown in the drawings of the patent.

Q. Do you find any similarity in the construction of the closure of Mr. Van Saun respecting the closure of the [164] Poole patent in suit?

A. Yes, there is. Referring now to the first full paragraph at the top of page 2 in the first column, it states:

“The auxiliary disc 25 is intended to be secured centrally on the disc 24 and is so dimensioned as to provide an annular recess between the edge of the disc 25 and the down-turned tabs 27, 27. As shown in Fig. 1, this recess indicated at 30, is adapted to receive the end of the body member 20.”

So that we have the top edge of the body member 20 fitting into a recess 30, and then it states in the next paragraph:

“The disc 25 is suitably cut away at 31 so as to provide a slightly enlarged part in the annular recess 30, indicated at 32 so as to accommodate the extra thickness of the body member due to the overlapping of the ends of the body member. (See Fig. 6.)”

And then Figure 6, which is in the lower left-hand corner of the first page of drawings, shows there is a recess which is indicated by 32, which accommodates the lap joint which is not indicated by, but is actually at the end of the lead line of the references numeral No. 23. .

Q. So the broad concept of providing a widened portion in a groove of a lid to accommodate a lap

(Testimony of Robert C. Comstock.)

joint of a container is disclosed by Mr. Van Saun?

A. Yes, it is.

Q. And Van Saun's patent issued on what date?

A. It was issued on January 15, 1946.

Q. That was more than one year prior to the filing date of Mr. Poole's application?

A. The Poole application was filed on May 10, 1948,——

Q. More than one year——

A. A little over two years later.

Q. Do you find any claim in Mr. Van Saun's patent that claims the feature of widening the groove of a recess of a cover to accommodate a lap joint container?

A. The only claim which I found that might be considered to cover that structure would be Claim 13, which states:

“A drum according to Claim 9 including a second disc secured to the inner surface of said closure disc and so dimensioned as to provide an annular recess adjacent the periphery thereof adapted to receive one end of said body member.”

Referring back to Claim 9, the first words of Claim 9 state:

“A drum of paperboard or similar sheet material comprising a body blank having oppositely disposed edge portions secured together,”

If that were construed that they are fitted together to provide a lap joint, then the term “so dimensioned” there in [166] Claim 13 would necessarily mean that the cover would have to be dimen-

(Testimony of Robert C. Comstock.)

sioned to accommodate that. That is as close as this patent comes to claiming that feature.

Q. Have you examined the file wrapper of the patent to Van Saun? A. Yes, I have.

Mr. Boettcher: I am registering an objection to that, so that the record will show I am objecting to it.

Mr. Russell: The file wrapper of the patent to Van Saun, your Honor, is identified as Exhibit A.

Q. (By Mr. Russell): I hand you a certified copy of the file wrapper and contents of the Van Saun patent, Mr. Comstock, and ask you to point out in that file wrapper, if you can, wherein Mr. Van Saun attempted to claim the feature of widening the groove of a lid to accommodate the lap joint of an open-ended container.

Mr. Boettcher: Objection——

The Court: I am not sure about this. I see you are about to object, which would just be the logical sequel to the objection made this morning. And the objection is deemed made and overruled, but subject to a motion to strike, because if, when I finally rule upon whether to admit this wrapper, if I should decide to admit it, this witness might not be currently available. He is on the stand now, so let's let him answer so we will have a record of it. [167]

Mr. Boettcher: Well, I will make a motion to strike the exhibit from the case.

The Court: It hasn't been admitted yet, has it?

Mr. Russell: Yes, it has, your Honor.



(Testimony of Robert C. Comstock.)

Mr. Boettcher: Yes, that is what I understood this morning.

The Court: Yes, I recall it was admitted subject—

Mr. Russell: Subject to a motion to strike.

The Court: —to a motion to strike. We will admit this testimony subject to a motion to strike. I am inclined to think it is actually admissible, but I am not just absolutely sure about it, so I am not going to pay too much attention to the file wrapper or to these answers until I have read a bit on that.

Mr. Russell: I have a number of legal authorities here, your Honor, which I can adequately include in a brief.

The Court: I trust you are not going to read them to me this afternoon.

Mr. Russell: I understand that.

Mr. Boettcher: I think I would like to have the pending question read now.

The Court: Yes, read it, please.

(The question was read.)

Mr. Boettcher: My point is, what has that got to do with this case? [168]

The Court: I suppose it is an attempt to show prior art, in that he made a disclosure of such a concept to the Patent Office, and there was some—well, he made that disclosure. What they did with it might not be material here, but the fact he made the discloser, if it was of the same claim, would be evidence of prior art, wouldn't it?

Mr. Boettcher: Well, of course, the matter of

(Testimony of Robert C. Comstock.)

prior art would be a matter of disclosure, rather than what is being claimed. But I——

The Court: Well, isn't the claim as submitted to the Patent Office, either in the application for letters patent, where I don't suppose it would be a claim in the strict sense of a claim, but it is a proposal of a claim to be allowed, isn't that evidence of a disclosure, evidence of a concept as of the time that that was filed with the Patent Office?

Mr. Boettcher: If there is something disclosed in a prior art patent, it doesn't make any difference whether it is claimed or not. I would like——

The Court: He is not using the word "claim" in the technical sense.

Mr. Boettcher: Oh.

The Court: I take it that he means sought to obtain letters patent upon.

Mr. Russell: That is very good, your Honor.

Mr. Boettcher: Perhaps it would clarify my objection a [169] bit more if I referred to the fact that in my adversary's trial memorandum he refers to this file wrapper and contents of Van Saun and does so under the heading of estoppel. I don't understand it.

And if there is a particular purpose in using this file history as distinguished from the mere issued Van Saun patent, I would like to know what it is and I think the court should be apprised of that.

The Court: What is it?

Mr. Russell: I brought that out before, your

(Testimony of Robert C. Comstock.)

Honor. The primary reason for employing the file wrapper of the Van Saun patent is to show that the subject matter of the patent in suit, at least a part of the subject matter, was known to others before Mr. Poole conceived of his invention. And I paraphrased Title 35, I believe, Section 102 of the United States Code. That is affirmatively pleaded in our Answer.

The Court: I think this is admissible for that purpose.

Mr. Boettcher: Anything that Van Saun invented and disclosed, that wasn't stricken from the application, is represented by the issued patent on January 15, 1946.

Now, he either has something there in the way of anticipatory material or prior art, against which to weigh inventive quality, or he hasn't.

Why go back of the issue date of that patent? Anything that Van Saun contributed is apparently in that patent. [170]

The Court: Well, it might not have been deemed patentable material. Prior art doesn't consist only of issued patents.

Mr. Boettcher: Right.

The Court: If Van Saun made some disclosure in his application, I think that is admissible.

Mr. Boettcher: Perhaps. Of course, I haven't compared the Van Saun file wrapper with the Van Saun patent, but I should be a little bit surprised if there is any disclosure in the Van Saun application, the file history, that is not in the issued patent.

(Testimony of Robert C. Comstock.)

The Court: I am not weighing the evidence. I am just channeling it and admitting it at this time.

You might be right. It might be totally dissimilar, when we get down to an analysis of it.

Mr. Boettcher: I should be pleased to have this alleged estoppel explained to me. I don't understand it.

The Court: I can see some theories, but it would take a lot more evidence in order to piece them out.

The Witness: Claim 5 of the Van Saun application, as originally filed, stated:

“A drum according to Claim 4, wherein said second disc is provided with a cut-away portion adapted to form a slightly enlarged section of said recess for the reception of the overlapped portions of said body [171] member.”

Q. (By Mr. Russell): What disposition was made by the Patent Office Examiner respecting proposed Claim 5, referred to?

A. In an office action dated November 18, 1943, the Examiner stated:

“Claims 4 and 5 are rejected as unpatentable over Cody in view of Wright, who discloses a slip type closure having a disc secured to the inner surface to provide an annular recess. To form Cody's closure with a similar disc would lack invention. Such disc wouldn't obviously be shaped to conform to the cross sectional shape of the container end.”

Q. The Patent Office Examiner then deemed it as obvious to widen the groove in the construction presented by Mr. Van Saun?

(Testimony of Robert C. Comstock.)

Mr. Boettcher: I object to that.

The Court: Sustained.

Q. (By Mr. Russell): After the Examiner's action referred to, Mr. Comstock, did Mr. Van Saun argue that he should be allowed to Claim 5 as having the inventive concept set forth in Claim 5?

A. Yes. And in an amendment filed May 16, 1944, an argument was made with regard to Claims 4 and 5, and with [172] regard to Claim 5 in particular, it was argued:

"Claim 5 which is dependant upon Claim 4, should obviously be allowed along with the latter, and it should also be allowed for the reason that it requires that a portion of the second or inner disc be cut away so as to form a slightly enlarged section of the annular recess for the reception of the overlapped portions of the body member. The Examiner has attempted to dismiss this feature with the statement that the disc would obviously be shaped to conform to the cross sectional shape of the container end. It is submitted that the arrangement defined in Claim 5 is not at all obvious and that the most obvious procedure would be to make the recess sufficiently wide at all points to accommodate the overlapped portion of the body wall. If Applicant's arrangement were as apparent as the Examiner has stated, he should be able to find some reference which would illustrate it. It is believed that upon reconsideration, the Examiner will agree that the subject matter of Claim 5 is clearly and patentably distinct from the prior art."

(Testimony of Robert C. Comstock.)

Q. That was the argument of Mr. Van Saun, as you read it from the file wrapper?

A. That is right. That is the argument for reconsideration [173] as presented to the Patent Office.

Q. What was the subsequent action taken by the Examiner?

A. In an office action dated August 24, 1944, Claim 5 was again rejected. The Examiner stated:

“Claims 1, 2, 4, 5 and 6 are rejected on Cody in view of Eggers and Wright all of record and Roch et al. There would be no invention in providing staples for each of the tabs of Cody and in clinching them against the inner surface of the body member as taught at 8 and 9, respectively, Figs. 1 and 2 of Eggers, in securing a second disc to the inner surface of the closure disc as taught at 16, Fig. 4 of Wright, and in introducing a sealing compound into the recess as taught at 19, Fig. 3 of Roch et al. There would also be no invention in cutting away a portion of the second disc.”

Q. Then what action did Mr. Van Saun take?

A. In an amendment filed February 17, 1945, Claim 5 was canceled from the application.

Q. Did Mr. Van Saun personally prosecute his own application for patent? A. No, he did not.

Q. Who did?

Mr. Boettcher: I think that is immaterial, too. I object [174] to it.

The Court: Sustained.

(Testimony of Robert C. Comstock.)

Mr. Russell: I believe it is material, your Honor, if I may proceed.

The Court: The court holds it is immaterial.

Mr. Russell: Beg your pardon, your Honor?

The Court: The court holds it is immaterial.

Q. (By Mr. Russell): Does the file wrapper show, Mr. Comstock, to whom the Van Saun patent was assigned?

A. It was assigned to the Container Corporation of America.

Mr. Russell: Will you stipulate, Mr. Boettcher, that is the same Container Corporation of America as the plaintiff here in suit?

Mr. Boettcher: Certainly.

The Court: It would seem to indicate that they thought they were getting something new and additional.

Mr. Russell: At that time.

Q. (By Mr. Russell): From the foregoing facts, Mr. Comstock, is it indicated that the Container Corporation of America had knowledge of the subject matter of Van Saun at the time of the preparation of the Poole application for patent?

Mr. Boettcher: Oh, I object to this.

The Court: Sustained. [175]

Q. (By Mr. Russell): Was the patent of Van Saun considered by the Patent Office Examiner during the Poole application for patent?

A. No, it was not.

Q. What class was the Van Saun patent classified in the Patent Office?

(Testimony of Robert C. Comstock.)

A. That was Class 229, subclass 5.5.

Q. How does that compare with the class of the Poole patent?

A. I believe that is the identical class. Yes, it is.

Q. In your opinion is the Van Saun patent pertinent prior art as against the Poole patent in suit?

A. Very definitely pertinent.

Q. In your opinion you believe there had been inadvertence, error or mistake on the part of the Patent Office in failing to cite the Van Saun patent against the Poole?

Mr. Boettcher: I object.

The Court: Sustained.

Q. (By Mr. Russell): What was the feature shown in the Van Saun patent—now, not the file wrapper referred to, Mr. Comstock, but the patent itself in Defendant's Exhibit B—what feature is shown by Van Saun that was not shown in any of the patents cited by the Examiner during prosecution of the Poole application for patent?

A. Well, that is the concept of the cut-away portion [176] or the enlarged recess to accommodate a lap joint. That was shown in Van Saun. It was not shown in any of the references which were cited by the Examiner.

Q. You consider Van Saun as more pertinent than any of the other references used by the Patent Office against the Poole patent?

A. Very definitely. Much more pertinent than any of them before the Examiner.



(Testimony of Robert C. Comstock.)

Q. Let's refer to the last patent, the patent to Hill in Defendant's Exhibit B.

Mr. Boettcher: I would like to have the record show I have a standing objection to the consideration of that as prior art.

Q. (By Mr. Russell): Do you find any resemblance between the patent to Hill and the patent in suit, Mr. Comstock?

A. Yes. The Hill shows a square container, the identical shape of the Poole patent, and the title of the patent is "Plastic Cover For Waxed Paper Containers." So you have the same combination of the plastic cover and the wax paper container that you have in the Poole patent.

In fact, the Hill patent refers to a transparent plastic material preferably polystyrene. And I believe the Poole patent—yes, Poole also states that his cover is formed preferably of a transparent plastic such as polystyrene.

With regard to the relationship between the top of the [177] container and the container itself, that is, the cover, we have a recess which is downwardly directed and which is tapering, and there is a wedging or compressing action when the top of the container fits into the recess.

There is no lap joint structure in the Hill patent. That is the only difference between the structures shown in Hill and that shown in the Poole patent.

The Court: Before you go on, do I understand correctly that the standing objection to this Hill patent and the questions relating to it is based upon

(Testimony of Robert C. Comstock.)

the fact that the letters patent were issued on December 30, 1952?

Mr. Boettcher: Yes, while our application was pending, while the Poole application was pending.

The Court: All right.

Q. (By Mr. Russell): Referring to all of the patents, Mr. Comstock, in Defendant's Exhibit B, do you find a complete disclosure of the Poole structure in any one of the patents? A. No, I do not.

Q. Now, referring to Claims 1 and 2, for example, of the Poole patent, do you find any complete disclosure in any two of the patents in Defendant's Exhibit B that would be described generally—let's say specifically by the structures claimed in Claims 1 and 2 of the Poole patent?

Mr. Boettcher: You mean two taken together?

Mr. Russell: 1 or 2. [178]

The Witness: Yes, I would say the structure in 1 and 2 or in both of those claims would be found by combining any of a number of pairs of references. For example, combining the Hill patent with Van Saun, since Hill shows the wax paper container and the plastic cover and the downwardly directed recess, and Van Saun shows the cut-away portion or enlargement to receive the lap joint.

Likewise, you could combine Hill with Moore, since Moore also shows a recess which is enlarged to receive a lap joint.

You could also combine either the Van Saun or the Moore patents, which show the recesses, with the Drake patent, for example, which shows the

(Testimony of Robert C. Comstock.)

tapering recess and the compression of the cover. Or with Rutkowski, that is, you could combine Drake with Rutkowski, you could combine Drake with Moore or you could combine Rutkowski with Van Saun or Rutkowski with Moore, and you would find all of the structures and elements set forth in Claims 1 and 2 of the Poole patent.

Q. (By Mr. Russell): It is your opinion, Mr. Comstock, that the combination of any of the six combinations you just referred to would be obvious to anyone skilled in the art? A. Yes.

Q. Is there any substantial difference between Claims 1 and 2 of Poole and the remaining claims of the Poole patent?

A. Well, the remaining claims, some of them recite the fact that the cover is plastic and some of them refer to [179] it being square in shape. And they also define the location of the lap joint and the recesses being in a corner of the cover.

There are only these minor differences between the remaining claims and Claims 1 and 2.

Q. Do I understand, then, if Claims 1 and 2 were invalid, or, let's say in the public domain, that there would not be any patentable novelty in any of the remaining claims?

Mr. Boettcher: I object.

The Court: Sustained.

Q. (By Mr. Russell): Let us refer, Mr. Comstock, to the plaintiff's commercial embodiment, the carton, Plaintiff's Exhibit 20, and the lid therefor, Plaintiff's Exhibit 21. You have seen structures of

(Testimony of Robert C. Comstock.)

that type before?       A. Yes, I have.

Q. In your opinion, Mr. Comstock, do any of the claims of the Poole patent in suit read upon the structure of the two components now before you?       A. In my opinion they do not.

Q. Are you familiar with the concept of mechanical skill in connection with inventions?

A. Yes, I am.

Mr. Boettcher: That is a big order. I object to that question. The concepts——

The Court: It is a preliminary question. But I think [180] the one that it is preliminary to is probably objectionable, so the immediate objection is overruled.

Q. (By Mr. Russell): In your opinion, Mr. Comstock, do you find anything more than a mere mechanical skill in widening the groove of a cover to accommodate a lap joint?

Mr. Boettcher: I object to it.

The Court: Sustained. That is invading the province of the court. It is the ultimate fact in issue. He can't express an opinion.

Q. (By Mr. Russell): Referring to the patent in suit, Mr. Comstock, considering all the elements claimed, does the container do anything different than the containers disclosed in the prior art you referred to?       A. No.

Q. Does the groove in the lid do anything different than the prior art disclosures?

A. No, it doesn't.

Q. Does the widening of the groove do anything

(Testimony of Robert C. Comstock.)

different than it did before, as illustrated in, for example, the patent to Moore of Defendant's B and the patent to Van Saun?      A. No, it does not.

Q. Each of the elements perform the same function as they did in the prior art?

Mr. Boettcher: I object to that.

The Court: Sustained. [181]

Mr. Russell: You may cross-examine, Mr. Boettcher.

Mr. Boettcher: I don't think I can possibly complete the cross examination of this witness in what I would regard as a reasonable time to keep the court.

The Court: Well, what do you want to do about it?

Mr. Boettcher: May I discuss it with my colleagues?

The Court: Yes.

Mr. Boettcher: Would it be fair for me to ask how long the court would care to sit? My idea was to get through by 5:00, and I think that is pretty short time.

The Court: That was my idea, too. However, I can sit a little longer. I can stay a little later, and if it is necessary I can convene tomorrow. I had hoped to spray my roses, but I suppose they can take a few more aphids.

Mr. Boettcher: I dislike to interfere with that pleasure. Supposing I go ahead and see where I—

The Court: Go ahead and see what you can do. Perhaps by 5:30 you can finish.

(Testimony of Robert C. Comstock.)

Cross Examination

Q. (By Mr. Boettcher): Look at the Van Saun patent, 2,392,959. A. Yes, I have it.

Q. Now, you tell me where the groove is that you regard as corresponding to the peripheral recess in the Pool patent in suit. [182]

A. The groove would be the space between the second disc, I believe he calls it, and the wall of the lid. I think that is 29; I will have to check that.

The disc is 25, and one edge of that would be one side of your recess and the other——

Q. Now, looking at Figure 1, you regard the disc, that the space, the angular space between the disc 25 and the internal wall of the downwardly extending portion of the cover as being the groove, do you? A. That is right.

Q. Now, what is that disc for, that disc 25?

A. It is for that purpose, as I understand it. It is for the purpose of providing a fit between the cover and the container.

Q. You say it is for the purpose of making a groove? A. Yes.

Q. Suppose I were to suggest it is for the purpose of reinforcing the top, would that be right or wrong?

Mr. Russell: I believe that is objectionable, your Honor. It is argumentative.

The Court: Overruled.

The Witness: If you fasten the disc, it certainly would reinforce. I don't see anything in the patent

(Testimony of Robert C. Comstock.)

now, glancing at it rapidly, that states that it is for the purpose of reinforcement. [183]

The Court: Don't we have to take what the patent teaches?

Mr. Boettcher: Pardon me?

The Court: Don't we have to take what the patent teaches?

Mr. Boettcher: Yes. And I am taking what the patent teaches.

The Court: It appeared from the question you were probing into what this man's interpretation is.

Q. (By Mr. Boettcher): Well, what good does the groove do, Mr. Comstock?

A. Well, it provides the space there to accommodate the top of the container.

Q. Well, you mean that the disc is put into that cover, in order to form a space?

A. That is right.

Q. Well, so as to make clear the line of my cross examination, my idea is that the disc is put there for the purposes of the disc, and the groove is something that results from that and with no purpose at all, except to make room for the circular wall that is coming up there. Isn't that right?

A. No.

Mr. Russell: I will object, your Honor please. Although this is very informative, I believe the patent will speak for itself in that regard. [184]

The Court: The objection is sustained.

Q. (By Mr. Boettcher): Does that reference character 30 indicate the groove?

(Testimony of Robert C. Comstock.)

A. Yes, it does. 30 is defined as a recess.

Q. All right. Now, the wall, the circular wall that extends into the groove doesn't touch the disc at all, does it?

A. As shown in Figure 1 it does not touch.

Q. Does it show anywhere?

A. No, but the patent states, not with regard to that, but with regard to one of the other recesses, that the recess is shown slightly larger than it actually would be for the purpose of clarity, so I assume that would apply equally well to Figure 1.

Q. How deep is that groove?

A. It is rather shallow.

Q. The groove is as deep as the disc is thick, and that is all? That is correct, isn't it?

A. That is all, that is right.

Q. Is there any possible wedging action there caused by the circumference of the disc?

A. Well, yes, the specification states on page 2 in the second column, about lines 29 and 30, in referring to the disc action at the bottom of the container:

"the lower edge of the body member is intended to fit [185] rather snugly."

Since it refers to that structure as being similar to that at the top, I assume that the tight fit was meant at the top as well.

Q. Well, that doesn't mean a wedging action, does it? That doesn't mean any kind of a compression of the wall, the circular wall, does it?

A. He states "fit rather snugly."



(Testimony of Robert C. Comstock.)

Q. Now, refer to Claim 9 of the Van Saun patent to which you referred. Is there any possibility of that Claim 9 apply to the disclosure of the Poole patent in suit?

A. If you mean a question of infringement, there is no question of infringement. Poole would not infringe it if—I am not sure what you mean by “applying to the disclosure.”

Q. Your point is that Mr. Van Saun was trying to claim the making of a space for the overlap? He——

Mr. Russell: Now, your Honor,—Excuse me, counsel.

Q. (By Mr. Boettcher): He was doing that only in respect of Claim 9. It is a dependent claim on Claim 9, isn't it?

A. That is right. Claim 13 is dependent on Claim 9.

Q. Claim 9 wouldn't have anything to do with the Poole patent, would it?

A. Oh, I wouldn't say that. There are similarities, but there would be—the structure that is set forth there, a great deal of the structure that is set forth in Claim 9 is [186] not found in Poole.

Q. Let's look at the Moore patent, 2,381,508.

You spoke about a peripheral groove there, did you not? A. Yes.

Q. Where is it?

A. That would extend between the two walls again. I will have to check those numbers. I believe that 27 is one of them.

(Testimony of Robert C. Comstock.)

You see, the flange is 27, and 28 are the outer flanges. I think 25 and 26 are the inner flanges. So that the groove would be the part between those flanges.

Q. Well, that is not a peripheral groove that you describe there, is it? It is two parallel grooves at opposite ends of a cross piece, isn't that right?

A. Well, when the cross pieces are put together here you have a cover with a groove extending around the periphery of it.

Q. In other words, you have two sides that are on one cross piece and the other two sides are on the other cross piece?

A. Before assembly, that is correct.

Q. So it isn't a one-piece affair at all, is it?

A. That is correct.

Q. What was it you said about the first claim of the Poole patent not applying to Exhibit 20 and 21? [187]

A. Yes, I said that in my opinion Claim 1 of the Poole patent did not cover the structure shown in Exhibits 20 and 21.

Q. You said the same about Claim 2, didn't you?

A. That is correct.

Q. How about Claim 3?

A. Yes, the same answer.

Q. What is there about Claim 3 that does not apply to this combination of Plaintiff's Exhibits 20 and 21?

A. Well, one thing, the Claim 3 states:  
"said recess being of uniform width for the major

(Testimony of Robert C. Comstock.)

portion of its extent and of increased width at a corner of said corner to accommodate said lap joint."

Now, here we have one, a recess which is not of uniform width because there are four points at which it has increased width. So it is not of uniform width, with the exception of a corner as described in the claim.

Q. Well, it is of uniform width except for the four corners, isn't it?

A. Except for four corners, yes.

Q. Right. And the four corners includes one corner, doesn't it? I just want to get your idea, of how you read these claims.

A. Well, when you—I think you have to construe the claims in the light of the specification and drawing, and when the specification and drawing show a structure in which you [188] have a lap joint and a recess at one corner, then that claim—you can't say that four corners includes one corner, because you have changed the structure considerably.

Q. You are construing the claim, is that right?

A. In the light of the specification and claims, yes, it has to be.

Q. It is in the nature of a legal opinion, is that right?

A. If you want to call it that. I think any answer I would give would necessarily be a legal opinion.

(Testimony of Robert C. Comstock.)

Q. Have you considered Claims 4, 5 and 6 in the same way as you just explained about Claim 3?

A. Yes, the answer would be the same. The difference would be the same.

Q. Refer now, if you will, please, to that Rutkowski patent, 2,155,002. A. Yes.

Q. In that body, with reference to character 1, that body is made up of thin paper, wrapped, isn't that right?

A. It states that the body is in the nature of a paper tube. I believe it is a matter of past experience that I have seen tubes formed wrapped. I don't see anything in here right immediately that states that it is wrapped.

Q. In any event, there is no lap joint there?

A. There is no lap joint, that is right. [189]

Mr. Bottcher: I am pleased to say that is all the cross examination I have.

The Court: All right: Judge Harrison, who sits in the next courtroom, doesn't like to have these patent attorneys called as experts and you have a hard time getting one on, because he says it is only an advocate making a legal argument. I think a sequel to that view, which might be said to be well taken, would be that attorneys in making arguments may make the same kind of comments that are made by witnesses in the position of the witness on the stand here.

From my viewpoint here, as a trier of fact, you just can't try a patent case without this kind of thing. But I am inviting you to treat it as fully

in your brief as your opponent has treated it by expert testimony.

Mr. Boettcher: Thank you very much.

Mr. Russell: That is all, Mr. Comstock.

(Witness excused.)

Mr. Boettcher: The defendant rests?

Mr. Russell: The defendant rests, your Honor.

Mr. Boettcher: Plaintiff has no rebuttal.

The Court: What is your pleasure about briefing the case?

Mr. Russell: Let us have Mr. Boettcher's pleasure.

You are leaving tomorrow for Chicago, I presume?

Mr. Boettcher: In the present circumstances, yes, assuming we can postpone the oral argument.

The Court: Oh, yes, you can postpone it until after briefs. I do hope you will put in some briefs. I would like to be briefed a bit upon this question of the Van Saun file wrapper and file history there.

My present feeling is that we will probably find that, according to the law, it is admissible, but I don't know that.

I have rather provisionally admitted it, and I am not going to look at it until I am sure about it.

Mr. Russell: We shall treat it rather well, your Honor.

Mr. Boettcher: We will struggle with it. And also, I think that it would be true also of the Hill patent. I have an axe to grind as to that one.

The Court: Yes. I think the questions regard-

ing the Hill patent as prior art are very serious. In fact, there are so many very serious questions in the case, I am hopeful something will happen I don't have to decide it.

Mr. Boettcher: We prepared briefs before opposing each other, and we can do it again.

Mr. Russell: Very well. What is your pleasure, Mr. Boettcher, in the submission of briefs?

Mr. Boettcher: Let me say this: I like to prepare a brief after the transcript is written up. I mean, a great deal of time is saved.

The Court: Then we will have the time for briefs begin to run upon the reporter advising me that the transcript has [191] been sent to you.

Mr. Boettcher: That is fine. And then, say, 20 days for the plaintiff's opening brief?

The Court: Let's make it 30. 30 days after the delivery of transcript.

I suppose you want it delivered to your local counsel, or do you want it mailed to you?

Mr. Boettcher: We can arrange that. When it is mailed it can be assumed to be delivered to me.

The Court: All right. 30 days thereafter for your opening brief.

How much time do you want then to reply?

Mr. Russell: I would like to have the opportunity of the 30 days as well, your Honor, because I believe the amount of research and briefing on the particular Van Saun issue and the Hill issue will perhaps be greater than the rest of the brief.

The Court: All right. 30 days then from the

mailing date to you of the plaintiff's brief for your reply brief.

Mr. Russell: Very well, sir.

The Court: And I should think after all that time that the reply brief, if any, would come in rather shortly.

Mr. Boettcher: Right.

The Court: How long do you want?

Mr. Boettcher: 15 days.

The Court: All right. So ordered. Then after they are [192] in, you can correspond with each other and find an agreeable date for oral argument, or determine whether you wish to submit the matter entirely on briefs and transcript.

Mr. Russell: Very well, your Honor.

Mr. Boettcher: I think that will be very satisfactory. We can do that. I can communicate with Mr. Brown, and he can see you and make any arrangements that meet with the mutual convenience.

Mr. Russell: Very well. What is your suggestion, your Honor, as to the means for having oral argument before your Honor?

The Court: It depends upon how much time you want. If you are going to argue for upwards of an hour apiece, I would like to set the oral argument for some Friday. Then if we are in mid-trial, and a long trial, we will just recess that trial for the day and hear you on a Friday. If you are only going to talk a few minutes we can have it on a Monday afternoon, that being motion day.

Mr. Russell: Very well, sir.

Mr. Boettcher: That can be arranged by Mr. Russell and Mr. Brown with your Honor.

The Court: Yes.

Mr. Russell: Fine. Thank you kindly, sir.

The Court: When you have come to some understanding and have some alternate dates in mind and know what you plan with [193] respect to time, Mr. Russell and your correspondent here can come in and see me and we will arrange a time.

The cause will then stand submitted.

Thank you. It has been a pleasant trial.

Mr. Russell: Thank you, your Honor.

Mr. Boettcher: I desire to thank your Honor for the attentive hearing.

The Court: I am sorry you had to wait so long to get to it.

Mr. Boettcher: It wasn't unpleasant. It was very pleasant.

Mr. Russell: It is my understanding Mr. Boettcher desires to return to Chicago.

The Court: A pleasant journey back.

Mr. Boettcher: Thank you so much.

The Court: Adjourned.

(Whereupon, at 5:00 o'clock p.m., Friday, May 4, 1956, the case was submitted.)

[Endorsed]: Filed June 20, 1956. [194]



[Endorsed]: No. 15433. United States Court of Appeals for the Ninth Circuit. Container Corporation of America, a corporation, Appellant, vs. M. C. S. Corporation, Appellee. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed: February 11, 1957.

/s/ PAUL P. O'BRIEN,

Clerk of the United States Court of Appeals for the Ninth Circuit.

In The United States Court of Appeals for the  
Ninth Circuit

No. 15433

CONTAINER CORPORATION OF AMERICA,  
Plaintiff-Appellant,

v.

M C S CORPORATION, Defendant-Appellee.

NOTICE OF WITHDRAWAL AS ATTORNEYS  
FOR THE DEFENDANT-APPELLEE

Please take notice that Harris, Kiech, Foster & Harris, Donald C. Russell, Esq., Warren L. Kern, Esq., and Walton Eugene Tinsley, Esq., hereby withdraw as attorneys for M C S Corporation, Defendant-Appellee in the above action.

Dated: January 31, 1957.

HARRIS, KIECH, FOSTER AND  
HARRIS,  
DONALD C. RUSSELL,  
WARREN L. KERN,  
WALTON EUGENE TINSLEY,

/s/ By WARREN L. KERN,  
Attorneys for Defendant-Appellee.

Affidavit of Service by Mail Attached.

[Endorsed]: Filed February 1, 1957. Paul P. O'Brien, Clerk.

[Title of Court of Appeals and Cause.]

STATEMENT OF POINTS AND DESIGNA-  
TION OF RECORD TO BE PRINTED

Appellant hereby adopts its Statement of Points, filed in the District Court, dated January 2, 1957, appearing on page 300 of the typed record, as its Statement of Points under the provisions of Rule 17(6) of the Rules of the Court of Appeals.

Appellant hereby adopts its Designation of Contents of Record of Appeal, filed in the District Court, dated January 2, 1957, appearing on page 302 of the typed record, excluding the exhibits, items 10 and 11, as its designation of the record to be printed on appeal, as provided for by Rule 17(6) of the Rules of the Court of Appeals.

/s/ J. CALVIN BROWN,  
Attorney for Plaintiff-Appellant.

Affidavit of Service by Mail Attached.

[Endorsed]: Filed February 20, 1957. Paul P. O'Brien, Clerk.

